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# INTERLOCUTORY MOTIONS

IN THE

# UNITED STATES PATENT OFFICE

NOTES TO  
RULES 96-97, 109, 122, 123,  
130 and 153.

BY  
E. J. STODDARD  
<sup>11</sup>  
(Detroit Bar)

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## PREFACE.

These notes have been made for my own use during the last fifteen or twenty years. It is intended to render readily accessible as much existing material as possible on questions of daily practice.

Of the weight or authority of a *dictum*, or the correctness of a decision or its applicability to present practice, one must judge in each case. As bearing upon this point I have prepared a brief historical introduction.

The notes are themselves in the nature of an index, but I have prepared a short supplementary index, *con nomine*, which will be of use.

It has been very difficult to get the time required in preparing for publication. The surprising accuracy and efficiency of the printers, Messrs. Eby & Stubbs, have prevented many errors which would otherwise have occurred.

ELLIOTT J. STODDARD.

Previous experience in this line of publication makes me expect a small deficit. The advantages I hope for are to increase my acquaintance among Patent Lawyers outside of Michigan, and to increase my business as an expert. See Title, "Expert Testimony," in the back of this Volume.

## DATA.

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Born at Seymour, Conn., 1859.

Educated in the Mechanical Engineering Course of the Sheffield Scientific School of Yale College and Law School of Columbia College in New York City (Class of 1881).

Earned my living for a year or two as a Mechanical Draughtsman, thus becoming familiar with the details of machinery.

Engaged in shop work as a Consulting and Superintending Engineer for about six years, largely in experimental work, involving mechanics, electricity and chemistry.

Have written a good deal for publication, and my writings have been favorably received. See "Press Notices" in back of this volume.

Have been instructor in a local lodge of the National Association of Stationary Engineers for a number of years, and for two years a member, or Chairman, of the National Educational Committee of that excellent organization, to which Professor Perry wrote from England in terms of the highest encouragement.

About twenty years' experience in Patent Soliciting. For a number of years I have been frequently employed as an expert in Patent cases. See "Letters" at the end of this volume.

Member of the Jury of Awards on Automobiles at the St. Louis World's Fair, Gas Engine Expert to the Marine Jury and afterwards Chairman of the latter.

## INTRODUCTION

Since the general revision of the Rules of December, 1879, all amendments have been published in the Official Gazette; and the changes in the various editions are noted in the front of the Rules as now published.

### RULE 96.

A part of Rule 51 of 1878 reads as follows:

“Where a party who is required to put his case in proper shape for the purposes of an interference delays doing so beyond a reasonable time specified, the interference will at once proceed. After final judgment of priority the application of such party will be held for revision and restriction, subject to interferences with other applications or new références.”

Only verbal changes were made in 1879.

The present form of the rule had its origin in the case of Hammond vs. Hart, decided April 25, 1898. (1898 C. D. 52.)

The correctness of this decision has been called in question in a pamphlet by Mr. J. H. Whitaker published by the Patent Law Association of Washington, D. C.

The edition of the Rules of July 18, 1899, reads:

“Whenever two or more applications disclose the same invention, and one of said applications is ready for allowance and contains a claim to said invention, the primary examiner will notify the other applicant of such fact, furnish him with a copy of the patentable claim, and require him to make such claim and put his case in condition for allowance within a specified time, so that an interference can be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed

unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of such party will be held for revision and restriction, subject to interference with other applications."

(See Rule 94 of 1879 quoted below as to suggestion of claims.)

In *Wolfenden vs. Price*, 1898 C. D. 87, Commissioner Duell said:

"In deciding the case of *Hammond vs. Hart* it was my intention to bring about a practice in the Office that would result in making the issue of an interference both definite and clear, and to that end to cause the parties to the proposed interference to claim substantially the same patentable invention so as to obviate the many motions and appeals that have unnecessarily arisen in the Office."

### RULE 97.

Previous to the Revision of December, 1879, the Primary Examiner was required to notify the parties, and in the Rules of 1878 he was required to "briefly and concisely define the interfering subject matter." In the revision of December, 1879, this rule reads:

"97. When an interference is found to exist and the applications are prepared therefor, the principal examiner will forward to the examiner of interferences notices of interference for all the parties as specified in Rule 102, which will disclose the name and residence of each party, and that of his attorney, the date of the filing of his application, and, if his case be a patent, its date and number, the date of its application, the ordinals of conflicting claims, and the invention claimed, which shall be clearly and concisely defined in so many counts or branches as may be necessary in order to include all interfering claims."

**RULE 109.**

Rule 94 of 1879 reads as follows:

“When two or more pending applications show, but only one claims, an invention, the information provided for in Rule 97, so far as it may be applicable to the case, will be sent to each applicant not claiming the invention; and if any such applicant shall within the time limited by the examiner, file an amendment of his application duly claiming the invention, he will be made a party to an interference to be declared, but not otherwise. Whenever an interference is found to exist, under Rule 93, between two or more parties claiming an invention, applicants having pending applications showing, but not claiming, the invention, will be furnished with the information provided for in Rules 97 and 101, and if such applicants shall, within the time fixed for filing the preliminary statements, file amendments of their applications, duly claiming the invention, together with such statements, they will be made parties to the interference, but not otherwise. When a patent shows without claiming, an invention claimed in a pending application, and the requirements of Rule 74 have been complied with, the patentee will be furnished with the information provided for in Rule 97; and if he shall, within the time limited by the examiner, file a reissue application duly claiming the invention, he will be made a party to an interference to be declared; but otherwise he will be excluded therefrom, without prejudice to his right of reissue; but if an interference is found to exist between other parties, he will be furnished with the information provided for by Rules 97 and 101, and if he shall file his preliminary statement, together with a reissue application claiming the invention, within the time limited for filing such statements, he will be made a party to the interference, but not otherwise. (See Rules 74 and 171.)”

**RULES 122 AND 124.**

The Revision of December 1, 1879, reads as follows:

“116. Motions to dissolve an interference which deny the patentability of an applicant’s claim, or his right to make the claim, will be submitted to the examiner of interferences before the day fixed for filing the statements provided for in Rules 97 and 102, and will be transmitted by him, with the files and papers, to the primary examiner, who will take jurisdiction of the case for the determination of such motions, and will return the files and papers to the examiner of interferences, with his decision, at the expiration of the time limited for appeal, if no appeal shall have been taken, or sooner if the party entitled to appeal shall file a waiver in writing of his right of appeal; and such decision will be binding on the examiner of interferences unless reversed or modified on appeal. From a decision of the primary examiner on such motion denying the patentability of a claim or the right of an applicant to make it, an appeal may be taken *ex parte* to the examiners-in-chief; but from his decision affirming its patentability or the applicant’s right no appeal can be taken.”

“118. Appeal may be taken directly to the commissioner from decisions on all motions, except motions to dissolve interferences denying the patentability of applicant’s claims, or their right to make the claims, and other lawful motions involving the merits of the case, which, when appealable may be appealed to the board of the examiners-in-chief. (See Rule 116.)”

See Allen, Commissioner of Patents, vs. The United States of America, ex rel. Lowry and Planters Compress Company, 1905 C. D. 643—116 O. G. 2253 (May 24, 1895).

**RULE 123.**

See case cited under Rules 122-124 above.

Rule 117 of 1879 reads:

“Motions to dissolve an interference upon the ground that no interference in fact exists, or that

there has been such irregularity in declaring the same as will preclude the proper determination of the question of priority between the parties, and all other lawful motions except those mentioned in Rule 116, will be made before the tribunal having jurisdiction at the time. Such motions should, if practicable, be made before the taking of testimony, and it must always appear that they are made in good faith, and immediately after the discovery of the grounds on which they are based. If grounds for such a motion are discovered at a time when it cannot be properly made, they may on due notice be urged at the hearing before, and will be disposed of by, the tribunal considering the case, as provided in Rule 120."

Rule 59 of 1878 reads in part as follows:

"59. After the declaration of the interference and before the time for filing the preliminary statements; has expired, motions to dissolve the same on the grounds of lack of novelty, or that no interference in fact exists, or that there has been such other irregularity in declaring the same as will preclude the proper determination of the question of right between the parties, must be made before the examiner by whom the interference was instituted. After the declaration of interference such motion must be made before the tribunal having jurisdiction at the time. Appeal may be taken to the commissioner in person; but if the examiner should decide that the subject-matter is not patentable in view of the state of the art the interference will be dissolved, and the matter decided upon can be proceeded with *ex parte*.

#### RULE 126.

Rule 120 of 1879 reads:

"120. In their decision of the question of priority, or before such decision, the examiner of interferences and the examiners-in-chief will direct the attention of the commissioner to any fact not relating to priority which may have been brought to their notice (by motion or otherwise), and

which in their opinion, amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference.

The commissioner may, before judgment on the question of priority of invention, suspend the interference, and remand the case to the primary examiner for the consideration of the statutory bar so suggested, subject to appeal to the examiners-in-chief, as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider and determine the same, unless it shall have been previously disposed of by the commissioner."

Rule 59 of 1878 reads in part as follows:

"In their decision of the question of priority, or before such decision, the examiner of interferences, or the examiners-in-chief, as the case may be, will direct the attention of the commissioner to any fact not relating to priority which may have come to their attention (by motion or otherwise), and which, in their opinion, amounts to a statutory bar to the grant of a patent to either or both parties. After final judgment the primary examiner will consider and determine any such matter not previously disposed of by the commissioner."

I find no provision in the Rules of September 1, 1873.

### RULE 130.

See Podlesak and Podlesak vs. McInnerney, 1906 C. D. 558; 120 O. G. 2127 and cases referring to it, especially United States of America ex rel. The Newcomb Motor Company v. Moore, Commissioner of Patents, 133 O. G. 1680.

### RULE 153.

Rules of December 1, 1879:

#### "MOTIONS."

"149. In contested cases reasonable notice of all motions and copies of motion papers and affidavits, must be served as provided for in Rule 150 (2). Proof of such service must be made before the motion will be entertained by the Office; and motions will not be heard in the absence of either

party except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending; but an appeal from the decision rendered may be taken on questions involving the merits of the case to the board of examiners-in-chief; on other questions, directly to the commissioner. In original hearings, on motions, the moving parties shall have the right to make the opening and closing arguments. In contested cases the practice on points to which the rules shall not be applicable will conform, as nearly as possible, to that of the United States courts in equity proceedings."

In 1869 Rule 50 read in part as follows:

"In contested cases no motion will be heard in the absence of the other party, except upon default after due notice; nor will a case be taken up for oral argument after the day of hearing except by consent of both parties. If the engagements of the tribunal before whom the case is pending are such as to prevent it from being taken up on the day of hearing, a new assignment will be made, or the case will be continued from day to day until heard."

And Rule 57 of 1869 reads:

"57. If either party wishes the time for taking his testimony, or for the hearing, postponed, he must make application for such postponement, and must show sufficient reason for it by affidavit filed before the time previously appointed has elapsed, if practicable; and must also furnish his opponent with copies of his affidavits, and with seasonable notice of the time of hearing his application."

In 1870 the following rule was added:

#### **"MOTIONS."**

"50. Reasonable notice of all motions and copies of the motion papers and affidavits, must be served upon the opposite party or his attorney."

In 1871 the rules read:

**"MOTIONS IN CONTESTED CASES."**

"50. In contested cases reasonable notice of all motions and copies of the motion papers and affidavits must be served upon the opposite party or his attorney. Proof of such service must be made before the motion will be entertained by the Office; and motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending; but an appeal from the decision rendered may be taken to the commissioner in person."

## INTERLOCUTORY MOTIONS.

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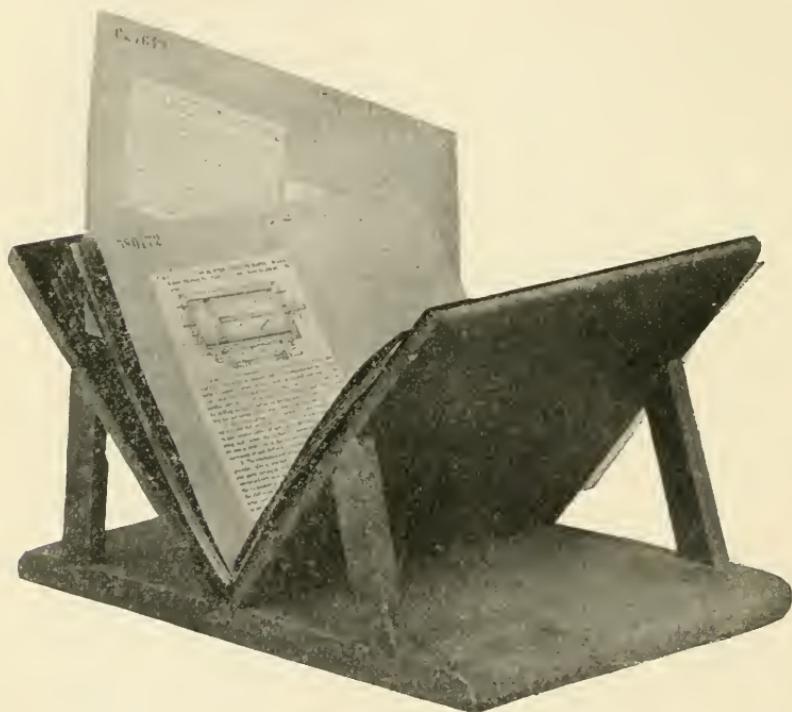
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## VALIDITY SEARCHES.

I have the use of a *Digest of U. S. Patents*, which consists of the illustration and claims of each patent, cut from the Gazette or Reports, and pasted upon a  $5\frac{3}{4} \times 7$  inch card; these cards being arranged in classes and sub-classes according to the *Patent Office* classification. The half-tone shows a single sub-class upon the support in which the cards are placed to be looked over. This digest forms an incomparably excellent index, and much ground can be covered in a short time, and a great degree of thoroughness attained.

I am frequently in Washington, where a search may be continued in the Patent Office if thought desirable.



I have copies of all U. S. patents on Gas Engines and Automobiles. I have access, also, to complete sets of monthly volumes of U. S. Patents, and a complete digest of British Patents.

I have had frequent occasion to translate German patents in making searches for use in German courts, and French and German patents cited as references.

MONEY PAID ME FOR VALIDITY SEARCHES WILL BE CREDITED, IF DESIRED, UPON MY RETAINER UP TO THE AMOUNT OF THE LATTER.

# INTERLOCUTORY MOTIONS IN THE UNITED STATES PATENT OFFICE.

## RULE 96.

96. Whenever the claims of two or more applications differ in phraseology, but cover substantially the same patentable subject-matter, the examiner, when one of the applications is ready for allowance, will suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner will send copies of the letter suggesting claims to the applicant and to the assignees, as well as to the attorney of record in each case. The parties to whom the claims are suggested will be required to make such claims and put the applications in condition for allowance within a specified time in order that an interference may be declared. Upon the failure of any applicant to make the claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim, and the issue of the patent to the applicant whose application is in condition for allowance will not be delayed unless the time for making the claim and putting the application in condition for allowance be extended upon a proper showing. If a party make the claim without putting his application in condition for allowance, the declaration of the interference will not be delayed, but after judgment of priority the application of such party will be held for revision and restriction, subject to interference with other applications.

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## RULE IN GENERAL—PURPOSE AND MEANING OF RULE.

1. An action under this rule establishes a date, from which the one year limited for action by the applicant runs. *Coulson v. Callendar, etc.*, 101 O. G. 1607, 1902 C. D. 395.

2. Rule 109 contemplates the possibility of the allowance by the Examiner upon argument of claims which were for some reason not suggested under Rule 96.  
Davis v. Ocumpaugh v. Garrett, 103 O. G. 1679.

3. The procedure of this rule is applicable where it is proposed to place an application into interference with a patent. Card & Card, 112 O. G. 499.

4. The requirement as to the form of a claim is not for the purpose of bringing about a conflict, but to define the conflicting subject-matter in the same words, so as to avoid confusion and to prevent disputes.

Card & Card, 112 O. G. 499-500.

5. Claims taken from a patent were refused entry because involving new matter.

Dilg, 112 O. G. 953.

6. The purpose of Rule 96 is to bring about uniformity in the wording of the claims. The practice is a good one. No reason appearing why the claims of R. and B. should not be brought to correspond in phraseology, the interference should have been dissolved on the ground of irregularity in the declaration.

Reichert v. Brown, 124 O. G. 2903.

### WHEN SUGGESTION PROPER.

7. An examination of the record of the patent makes it clear that the invention of this issue was not disclosed in the original specification and drawings. This omission coupled with the fact that he failed to disclose the same until it was admittedly disclosed to him—is almost sufficient of itself to warrant the conclusion that McKnight never independently invented the invention of the issue.

McKnight v. Pohle & Croasdale, 105 O. G. 495.

8. The question as to the right of Brown to make the claims is one relating to the merits of the case and depends upon the disclosure made by B. in his application. The Examiner has held that the disclosure in the Brown application is sufficient to support the claims corresponding to the issue, and from this affirmative decision there is no appeal. (Rule 124.)

Myers v. Brown, 112 O. G. 2093-4.

9. Where motion for dissolution is based upon the contention that the suggestion of the claim in interference to a party by the Examiner was improper because said party had not claimed substantially the same invention. HELD that the question raised involves no such irregularity in declaring the interference as might preclude proper determination of the question of priority of invention, and that no ground for dissolving the interference is presented.

Meden v. Curtis, 117 O. G. 1795.

10. An interference was decided on the record. In view of the fact that the new claims were made by the successful party, that they differ from the issue in other respects than in scope, and that the defeated party already has an allowable claim relating to the same subject-matter, it is held that the Examiner may properly suggest the new claims to the party under Rule 96.

Cramer & Hoak, 118 O. G. 1068.

11. Where an applicant appealed from the refusal of an Examiner to inform him of the subject-matter of the issue in a proposed interference in order that he might amend so as to include the issue in his claims. HELD that it is not the practice of the Office to suggest claims to an applicant in order to create possible interferences. Weeden, 1892 C. D. 195.

12. Where a party shows a certain structure and claims it broadly, and his claims are all rejected, and another party claims the same structure more narrowly and such claims are allowed and suggested to the other party. HELD no error in so suggesting such claims, as both parties were attempting to claim the same invention within the meaning of Rule 96.

Templin v. Sergent, 119 O. G. 961.

13. Claims should be suggested only when parties are attempting to claim the same thing.

Myers v. Brown, 112 O. G. 2093.

Templin v. Sergent, 119 O. G. 961.

Bryant, Wolcott & Davidson, 121 O. G. 2663.

In the case at bar, however, the tension controller of the Quest and Hogan application was specifically different from the tension controller of the Ostrom application. The practice announced in Hammond v. Hart,

therefore, would not have warranted the Examiner in suggesting the Quest and Hogan claims to Ostrom.

Quest v. Ostrom, 106 O. G. 1502.

### CONSTRUCTION AND EFFECT OF CLAIMS.

14. Where there are two applications each making a specific claim and no generic claim to an invention that might be included in one generic claim, in the absence of any means of avoiding the possible question as to equivalents, the Examiner will suggest a generic claim to the applicants.

Thompson, 98 O. G. 227, 1902 C. D. 6.

15. The question whether those claims can be made by Costello and are suggested to him under Rule 96, cannot be considered as affecting Hicks' rights unless and until Costello makes them.

Hicks v. Costello, 103 O. G. 1164.

16. The question of identity of invention is in general one which should be settled by the experts of the Office.

Luger v. Browning, 104 O. G. 1123.

17. The Hammond v. Hart decision, 83 O. G. 743, (1898 C. D. 52) did not make it mandatory on Examiners to suggest claims, but merely stated that under certain conditions, no good reason appearing for not doing so; the only condition expressly referred to was where two applicants disclosed the same specific structure and one of the applicants had specific claim to the structure and the other a generic claim thereto.

Quest v. Ostrom, 106 O. G. 1501.

18. There seems to be no reason why the Examiner should enter into a discussion or argument with these applicants as to the patentability of suggested claims.

Sutton & Steele, 107 O. G. 541.

19. The claims were suggested to appellant under the provisions of Rule 96. When appellant accepted the claims and included them in his application, he laid claim to the possession of the invention which they define.

If now the appellant wishes to withdraw the claim to the possession of the invention disclosed in the issue, he may properly do so by conceding priority or abandoning the invention.

Miller v. Perham, 123 O. G. 2667.

20. Where claims are copied from a patent they are to be construed in light of such patent.

Bourn v. Hill, Jr., 123 O. G. 1284.

21. Each of the two applicants for patent has made a claim in identical language. The claim reads without violence to the proper natural meaning of its terms upon the devices disclosed by each party; but the patentable invention which this claim is supposed to represent is found only in the device of one of the parties; clearly under these circumstances the claim fails to define the invention. Podlesak & Podlesak v. McInnerney, 123 O. G. 1989.

#### **NEGLECT AND REFUSAL TO MAKE CLAIM— TIME LIMIT.**

22. See example of unsettled claim in Farnsworth v. Andrews, 1876 C. D. 3, 9 O. G. 195.

23. Where a party unreasonably delays to put his application in such form that an interference may be declared, a patent will be issued to his opponent.

Lombard, 43 O. G. 1347, 1888 C. D. 56.

24. The Office and not the applicant is the judge of the reasonableness of the time.

Lombard, 43 O. G. 1347, 1888 C. D. 56.

25. Claim proposed by Examiner but not accepted for 10 years and until after an interference on broader claim. Gray, 1889 C. D. 91, 46 O. G. 1277.

26. The time at which the request is made, whether the request and accompanying showing be within the time limited or not, may affect the character of the showing, but it does not affect the jurisdiction of the Examiner. Curtis, 97 O. G. 189, 1901 C. D. 147.

27. In this case there is an allowable claim under consideration, and a party who can make it and will not do so within a specified time.

Furman v. Dean, 111 O. G. 1366-68.

28. Where applicant seeks to enter the suggested claim after the expiration of the time limited, the claim should be entered and then rejected.

Swift, 111 O. G. 2494.

29. Where an amendment is filed under the provisions of Rule 96, after the limit of time specified by the Examiner has expired and the Examiner rejects the claims in accordance with the Rule, the rejection relates to the merits and is not reviewable by the Commissioner upon petition, but should be considered on appeal in the first instance by the Examiners-in-Chief.

Ex parte Haug, 97 O. G. 192.

30. Applicant refused to put his claims in proper shape insisting upon his right to amend any time within one year. HELD that the Examiner should suggest claims to both parties, and proceed with the interference leaving any question of estoppel for future consideration. If applicant refuses to make claims suggested he should be held to have abandoned their subject-matter.

Ferris, 114 O. G. 541.

31. Where an applicant is a resident of a foreign country, the Examiner should grant the attorney's petition for a sufficient extension of time to consult his client. Schulze, 114 O. G. 1550.

31a. Rule 96 contemplates that the issue shall be in the terms of the claims actually made by both parties, or at least that both parties should have had an opportunity to make such claims. If neither party has made a claim which can be made by the other party by reason of the inclusion of elements which are not of the essence of the invention, then as pointed out in *ex parte Thompson* (98 O. G. 227), the Examiner should suggest a claim to each which will cover the real invention common to the two cases, omitting such limitation.

McBride v. Kroder, 133 O. G. 1680.

### ADDITIONAL CASES.

Klepko, 126 O. G. 387.

Harvey, 102 O. G. 621-22.

Holland, 99 O. G. 2548, 1902 C. D. 199.

Haug, 97 O. G. 192, 1901 C. D. 153.

Tizley, 89 O. G. 2259.

Hildreth, 97 O. G. 1374, 1899 C. D. 248, 1901 C. D. 186.

Van Auken v. Osborne v. Harrison v. Canfield & Van Auken, 119 O. G. 1584.

- Egly v. Schulze, 117 O. G. 2366.  
Blackwood v. Wilder, 124 O. G. 319.  
Anderson v. Vrooman, 123 O. G. 2975.  
Weidemann, 1897 C. D. 194, 87 O. G. 2245.

**RULE 97.**

97. When an interference is found to exist and the applications are prepared therefor, the primary examiner will forward to the examiner of interferences the files and drawings; notices of interference for all the parties (as specified in Rule 103) disclosing the name and residence of each party and that of his attorney, and of any assignee, and, if any party be a patentee, the date and number of the patent; the ordinals of the conflicting claims and the title of the invention claimed; and the issue, which shall be clearly and concisely defined in so many counts or branches as may be necessary in order to include all interfering claims. Where the issue is stated in more than one count the respective claims involved in each count should be specified. The primary examiner shall also forward to the examiner of interferences for his use a statement disclosing the applications involved in interference, fully identified, the name and residence of any assignee, and the names and residences of all attorneys, both principal and associate, and arranged in the inverse chronological order of their filing as completed applications, and also disclosing the issue or issues and the ordinals of the conflicting claims.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney, the examiner will notify each of said principal parties, and also the attorney, of this fact.

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**ISSUE AND NOTICES.**

32. Where the only claims are too broad in view of the state of the art.

Kafer & Gould v. Dennison, 1869 C. D. 14.

33. The devices in interference should so resemble each other that a patentable form of claim could be framed which should include both devices.

Sargent v. Burge, 11 O. G. 1055.

34. Notice should contain a brief summary of the contested subject-matter, and should specify the conflicting claims.

Stephen v. Bailey, 13 O. G. 45.

35. The parties have no right to be heard as to what shall and what shall not be included in the interference.  
White v. Demarest, 41 O. G. 1161.

36. The practice of appropriating literally the claim of a later inventor, which is drawn with reference to the employment of terms found in the preceding specification, and then applying the claims so appropriated to a specification of older date which does not contain words and expressions suitable to lead up to the language of the appropriated claim, condemned.

Rogers v. Winssinger, 1891 C. D. 111.

37. The test of an interference resides in the claims and not in mere disclosures in the application, and Office Rules must be construed in connection with this settled principle of law.

Van Depoele v. Daft, 1892, C. D. 15.

Searle v. Frumveller v. Sessions, 1892, C. D. 27.

Dodd v. Reading, 1892, C. D. 49.

38. It is improper in declaring an interference, to include a broad claim in a narrow issue. The issue should be as broad as the broadest claim involved therein.

Short v. Sprague, 1891, C. D. 166.

39. The question whether an interference in fact exists depends not merely upon the language employed in the respective claims, but upon the question whether in addition to similarity in phraseology there is an interference between the subject-matter of the respective claims.

Rogers v. Winssinger, 1891, C. D. 111.

40. It is a cardinal principle that in declaring an interference the issue must be as broad as the broadest claim included therein.

Morgan v. Hanson, 77 O. G. 154.

41. The correct solution of the question depends upon whether the two things disclosed by the respective parties have been clearly claimed and with the same limitations. Essex v. Wood, 89 O. G. 353.

42. While it is unfortunate that there should be differences of opinion as to the meaning of the issue, such differences alone do not justify a dissolution of the interference. Amund v. Spalckhaver, 97 O. G. 2083.

43. In an interference between a patent and an application, the issue is to be defined by reference to the patent. *Feder v. Poyet*, 89 O. G. 1343-4.

44. Rule 97 contains nothing to authorize the disclosure of a caveat which may have been referred to during the *ex parte* consideration of a case.

*In re Lowry*, 90 O. G. 445.

*Holland*, 99 O. G. 2548.

45. The requirement of Rule 97 that "The invention claimed" be disclosed, means that the invention claimed should be disclosed by title.

*Hoffstetter v. Kahn*, 99 O. G. 1624.

46. The Office must define the issue and the testimony must be confined to this issue.

*Brill & Adams v. Uebelacker*, 99 O. G. 2966.

47. The Primary Examiner should arrange the parties in the inverse chronological order in which they filed their applications directly involved in the interference. He should call attention to any earlier application and leave the question of its effect for the determination of the Examiner of Interferences.

*Raulet & Nicholson v. Adams*, 114 O. G. 1827.

48. Without further delay of which there has been too much in this proceeding.

*Normand v. Krimmelbein*, 115 O. G. 249.

49. Though the applicant is the original inventor of the rotating baking surface he has presented no convincing evidence tending to prove originality of the combination claims, and priority upon these claims is awarded to the patentee. *Cherney v. Clauss*, 115 O. G. 2137.

50. Remedy for failure to comply with this rule is by motion under Rule 122.

*Cazin v. Von Welsbach*, 119 O. G. 650.

51. Clerical error may be corrected by a letter from the Primary Examiner.

*Gully v. Burton*, 120 O. G. 325.

52. The terms of a claim should be given broadest construction.

*Podlesak & Podelsak v. McInnerney*, 120 O. G. 2127.

53. When a claim is taken from a patent to form an issue, that issue must be construed in reference to the specification of the patent.

*Andrews v. Nilson*, 123 O. G. 1667.

54. The senior party who has a patent may not be heard to ask that his claim be rewritten so that he may prevail in an interference.

*Andrews v. Nelson*, 123 O. G. 1667.

55. I am of the opinion that these terms are too vague and indefinite to point out with certainty any particular structure in either device, and that the interference should be dissolved as to this count on the ground of irregularity in declaration.

*Anderson v. Vrooman*, 123 O. G. 2975.

56. Care should be exercised in forming the issue that the terms used by the parties have a clear, definite, and common meaning in each application.

*Anderson v. Vrooman*, 123 O. G. 2975.

57. New references discovered "The Primary Examiner is directed to withdraw the notice of hearing which has been sent out and to determine whether the interference should continue without the aid of argument by either party."

*Behrend v. Lamme v. Tingley*, 124 O. G. 2536.

58. Less than half this number of counts should have sufficed. *Kempshall v. Royce*, 129 O. G. 3162.

59. It is to the interest of the interfering parties, the public and the Office that the counts of the interference should properly cover the patentable invention which is common to the applications involved and that second interferences should be avoided.

*Becker v. Otis*, 129 O. G. 1267.

60. The Office is no more competent than the Courts to say that an element which an applicant has put into his claim is an immaterial one.

*Streat v. Freckleton*, 87 O. G. 695.

*Collom v. Thurman*, 131 O. G. 359.

61. In general while applications are pending in the Office the claims thereof will be construed as broadly as

the ordinary meaning of the language will permit, for reasons stated in my decisions in Cuter, 123 O. G. 655.

Briggs v. Cooke v. Jones & Taylor, 116 O. G. 871.

Podlesak & Podlesak v. McInnerney, 123 O. G.  
1989.

Lovejoy v. Cady, 123 O. G. 654.

Junge v. Harrington, 131 O. G. 691.

Jenne v. Brown v. Booth, 1892 C. D. 78.

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**RULE 109.**

109. An applicant involved in an interference may, at any time within thirty days after the preliminary statements (referred to in Rule 110) of the parties have been received and approved, on motion duly made, as provided by Rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties. Such motion must be accompanied by the proposed amendment, and when in proper form will be transmitted by the examiner of interferences to the primary examiner for his determination. On the admission of such amendment, and the adoption of the claims by the other parties within a time specified by the examiner, as in Rule 96, the interference will be redeclared, or other interferences will be declared to include the same as may be necessary. New preliminary statements will be received as to the added claims, but motions for dissolution will not be transmitted in regard thereto where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference, without the consent of the Commissioner, except as provided herein, and in Rules 106 and 107.

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**INSERTION OF CLAIMS.**

62. It is contemplated by Rule 94 that the claims made in either application may be introduced into the other application by amendment, and included in the interference upon motion made in accordance with that rule. Wheeler, 23 O. G. 1031.

63. It is within the judicial discretion of the Examiner of Interferences to extend the time for motion.  
House v. Butler, 1893 C. D. 14.

64. May not introduce matter not warranted by application as originally filed.

Grinnell v. Buell, 89 O. G. 1863.

Smith v. Carmichael, 93 O. G. 1123.

65. A person making a specific claim only cannot insert a generic claim when in the meantime another applicant has applied for another species.

Beechman v. Wood, 89 O. G. 2459-62.

See however McBerty v. Cook, 90 O. G. 2295.

66. Contemplates the possibility of an allowance by the Examiner upon argument of claims which were for some reason not suggested under Rule 96.

Davis v. Ocumpaugh v. Garett, 103 O. G. 1679.

67. Matters under this rule must come in the first instance before the Examiner of Interferences.

If no claim is sought to be inserted the motion is unauthorized.

Only matter contemplated by Rules 106 and 107 and 109 may be included in an amendment during the continuance of an interference.

Smith v. Carmichael, 93 O. G. 1123.

68. It is not within the province of the Examiner of Interferences to consider the patentability or non-patentability of the claims. This is so even if the proposed claims have been once rejected by the Primary Examiner. Applicant has a right to appeal.

The purpose of this rule is to have counts added on motion of applicant if proper.

Reece v. Fenwick, 97 O. G. 188.

69. This rule does not provide for the insertion of claims suggested by counsel for both parties after consultation before filing a preliminary statement or taking testimony. Case remanded to Primary Examiner for the purpose of consideration of such an amendment under the general supervisory power of the Commissioner. Rule 213. Reese v. Fenwick, 99 O. G. 669.

70. It is held that where a party promptly presents claims as proposed additional counts to the interference issue they should be considered by the Primary Examiner. The claims should be accompanied by a motion similar to that ordinarily presented under Rule 109 and by a motion before the Primary Examiner to transmit. Practice indicated.

Churchward v. Douglas, 106 O. G. 2016.

71. Tyden presented a claim in an amendment which was properly a second species which could not on that

account be entered. This decision of the Examiner should only have been made after notice to the other party.

Tyden's divisional application should be considered and if there is interfering subject-matter, an interference should be declared accordingly.

Myers v. Tyden, 108 O. G. 287.

72. Claims contained in a year old patent to one of the parties refused admission in view of the fact that the testimony was nearly complete.

Newell v. Hubbard, 108 O. G. 1053.

73. Practice prescribed where one of two interfering applicants wishes to file an amendment purporting to put the application in shape for another interference.

Moore v. Hewitt v. Potter, 115 O. G. 509.

74. Where a party considers that a claim of his opponent could be made by him under Rule 109, but believes that the claim is so vague and indefinite that proper determination of the question of priority could not be based thereon,—HELD that the party should not ask the Office to make this claim an issue but should suggest some issue which would properly describe the invention.

Wickers & Furlong v. Weinman, 118 O. G. 1797.

75. P. offers no new claim at this time though it would seem that from the inspection of these applications he might readily have formulated and presented by motion in analogy to motion under Rule 109 the broader allowable and interfering claims, which should, in his opinion, be included in the issue, if any such claim could be drawn.

Phelps v. Warmley v. McCullough, 118 O. G. 1069.

76. A motion to amend the issue of an interference under Rule 109 was properly refused transmission where it contained a proviso that the claims shall be added “without prejudice to the right to contest such claims under the provisions of Rule 122.”

Wheeler v. Palmros, 133 O. G. 230.

**RULE 122.**

122. Motions to dissolve an interference (1) upon the ground that there has been such informality in declaring the same as will preclude a proper determination of the question of priority of invention, or (2) which deny the patentability of an applicant's claim, or (3) which deny his right to make the claim, or (4) which allege that counts of the issue have different meanings in the cases of different parties should contain a full statement of the grounds relied upon, and should, if possible, be made not later than the thirtieth day after the statements of the parties have been received and approved. Such motions, and all motions of a similar character, should be accompanied by a motion to transmit the same to the primary examiner, and such motion to transmit should be noticed for hearing upon a day certain before the examiner of interferences. When in proper form the motion presented will be transmitted by the examiner of interferences, with the files and papers, to the proper primary examiner for his determination, who will thereupon fix a day certain when the said motion will be heard before him upon the merits, and give notice thereof to all the parties. If a stay of proceedings be desired, a motion therefor should accompany the motion for transmission.

When the motion has been decided by the primary examiner the files and papers, with his decision, will be sent at once to the docket clerk.

Motions to shift the burden of proof should be made before, and will be determined by, the examiner of interferences. No appeal from the decision on such motions will be entertained, but the matter may be reviewed on appeal from the final decision upon the question of priority of invention.

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**HISTORY.**

77. The practice under the present rule is to render judgment upon the opening of the preliminary statements, without an order to show cause why such award should not be made, leaving the party failing to prevail to bring any of the motions permitted by the rules within the time limited for appeal.

Kendall v. Frasch, 1891 C. D. 36.

78. It is contended by B. that under long standing practice he should be permitted to give notice of other references five days before the hearing of the motion. The reasons for this practice which was followed in the past, but which has not been permitted for some time, do not now exist. Since the date of the decisions under which an applicant was permitted to give notice five days before the hearing, of additional reasons for dissolving the interferences, Rule 122 has been amended and the time within which motions may be made extended from 20 to 30 days. It has also been amended to require that a motion for dissolution must contain a full statement of the grounds relied upon.

Papendell v. Bunnell v. Reizenstein v. Gaisman, v. Gillett, 131 O. G. 362.

#### GENERAL POLICY AND MEANING OF RULE.

79. The practice of the Office contemplates that the question of the patentability of the subject-matter of an interference should be decided before an interference is declared. But if it has not been, then it must be before the interference can go on.

Lynch & Raff v. Dryden & Underwood, 73 C. D. 73.

80. There is nothing in the rules that limits the question to be discussed upon a motion to dissolve to those which have not previously been considered by the Primary Examiner.

Law v. Woolf, 55 O. G. 1527.

81. One object of motion is to enable the Examiner to decide *inter partes* what he had previously decided without a hearing.

Law v. Woolf, 1891 C. D. 91; 55 O. G. 1527.

82. Motions must be made after the declaration of interference. Seevert v. Shuman, 76 O. G. 1714.

83. When an interference has been dissolved as to a part of the counts, a new preliminary statement will not be admitted as to the remainder.

Seaman v. Brooks, 100 O. G. 685.

84. The absurdity of a declaration of interference with a reservation at the same time of the question of patent-

ability for future adjudication, would be, so far at least as this count is concerned, too glaring to be tolerated.

Such questions should be referred for determination.

Oliver v. Felbel, 100 O. G. 2384.

85. If a motion to dissolve for want of interference in fact is not made, the decision of the interference is not conclusive on this point, and the defeated party may raise the question when his competitors' patent is cited as a reference. Schupphaus, 100 O. G. 2775.

86. There may be an interference in fact notwithstanding the devices are intended for different purposes.

Blue v. Power v. Owen, 101 O. G. 2076.

87. If a motion to dissolve because one applicant is not entitled to make the claim is not filed, the question cannot be considered on the final adjudication.

Woods v. Waddell, 106 O. G. 2017.

88. As stated in Maxwell v. Bryon v. Henry, 98 O. G 1968, an interference should not continue between two parties as to certain counts and between three parties as to the other counts.

Dow v. Benson, 107 O. G. 1378.

89. The differences in structure referred to, however, are not included in the claims, and are, therefore, immaterial. Auerbach & Gubing & Wiswell, 108 O. G. 289-290.

90. Dissolution is necessary only where the irregularity is such as will preclude a proper determination of the question of priority. It is not necessary in all cases of irregularity. For instance, the fact that one applicant inserted a second specific claim in order to secure an interference is not material.

Hoefer, Hoefer & Hoefer v. Barnes, 108 O. G. 560.

91. Where the claims of interfering parties are in identical language and each party has a construction responding in function to the broad terms thereof, there is an interference in fact, although the constructions are specifically different.

Gordon v. Wentworth, 120 O. G. 1165.

92. Action should not be taken by the Office without sufficient reason where an adverse determination upon the merits of the patent may result; but where reasons for action exist the Office is not to be deterred therefrom

because, as an incident thereto, a cloud may be cast upon a patent. *Griffith v. Dodgson*, 122 O. G. 2064.

93. The Office has found by experience that in order to properly transact business the questions which are sought to be raised by applicants appearing before it must be presented according to certain procedure. While it is not desired to be too technical, yet applicants must be required to follow the simple and well-known procedure laid down in the Office rules and in a long line of decisions. *Filbel v. Fox*, 130 O. G. 2375.

### SUBJECT MATTER OF MOTION.

94. An interference should be dissolved when the interference claim is improperly introduced into a reissue application by one of the parties.

*Evans, Bussel & Vose*, 1873 C. D. 36.

95. An interference should be dissolved when the interference claims are not legitimate combinations.

*Pearl & Sawyer*, 1874 C. D. 58.

*Lynch & Roff v. Dryden & Underwood*, 1873 C. D. 73.

96. A motion to dissolve the interference on the ground of lack of patentable invention in the claim involved allowed.

*Dunton v. Young & McFarren*, 10 O. G. 243.

*Chambers & Mendham v. Tucker et al.*, 11 O. G. 1009.

97. Motion to dissolve for non-interference in fact, only involves all inquiries which assume patentability of the claims. *Zeidler v. Leech*, 1891 C. D. 9.

98. If the applicant does not choose to restrict his application in the manner pointed out in Rule 104, but thinks the claims do not interfere, he may move to dissolve the interference under this rule.

*Drawbaugh v. Blake*, 23 O. G. 1221.

99. If one party is a joint applicant and is not a joint inventor, the opposite party may move to dissolve the interference on the ground that his opponent has no right to make the claim. (Authorities reviewed.)

*Hicks & Keating v. Purvis & Bilgram*, 40 O. G. 348.

100. After the time limit has expired it is discretionary with the Examiner of Interferences whether or not he will transmit the motion.

Scribner & Warner v. Childs v. Balsby, 1892 C. D. 104.

101. Motion to dissolve on the ground that the affidavit under Rule 75 was insufficient.

Schmertz v. Appert, 77 O. G. 1784.

102. Any or all motions provided for in Rule 122 may be brought in connection with claims introduced under Rule 109 or the issue including the same, even though such motion were brought and the question raised thereby decided, under the interference as originally declared.

Jenne v. Brown v. Booth, 1892 C. D. 78.

103. Failure to make a motion to dissolve upon a ground that an accepted amendment to one of the applications involved is for new matter amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter.

Croskey v. Atterbury, 1896 C. D. 437.

104. The contention that the issue is devoid of patentable novelty is not a proper one for consideration, since it is *ex parte* in character.

Benjamin v. Searle, 59 O. G. 630.

105. The question of operativeness may best be determined when the witnesses are called and each party given a chance to make such tests as may be deemed desirable.

The question as to whether one applicant has the right to make the claim and whether he did in fact make it, are not properly appealable.

Eastman v. Houston, 87 O. G. 1871.

106. Trade-Mark. If the issue in respect to the class of goods is narrower than the class of goods upon which the other party uses the mark, there has been such irregularity in declaring the interference that it should be dissolved. Banigan Co. v. Bloomingdale, 89 O. G. 1670.

107. It is well settled that motions to dissolve an interference cannot properly be based on matter outside of the record. Bundy v. Rumbarger, 92 O. G. 2002.

108. These motions must be solely based on the applications. Felbel v. Oliver, 92 O. G. 2339.

109. It is well settled that the bar to a party's right which is contemplated by the rule,—must exist independent of the interference.

Horton v. Summer, 93 O. G. 2339.

110. One party discovered that his opponent's device did not act as described in the application on cross examination of the party,—Not matter coming within this rule. Sullivan v. Thomson, 94 O. G. 585.

111. The fact that applicant asserts that his application is a division of a former one does not constitute an irregularity under this rule.

Meyer v. Sarfert, 96 O. G. 1037.

112. The question of public use is not a proper foundation for a motion under this rule, but the question of anticipation by patents is.

Davis v. Swift, 96 O. G. 2409.

113. It is the settled practice of this Office that nothing can be considered by the Primary Examiner on a motion to dissolve on interference which is not contained in the record of the case, unless timely notice of such matter as may be urged in support of the motion which is not of record, is served upon the opposing party before the time set for hearing.

Summers v. Hart, 98 O. G. 2585.

114. The motion to the Examiner of Interferences should be accompanied by a motion to transmit. If not made within 20 days excuse should be made.

This is not the proper way to try the question of joint or sole ownership.

Frederick v. Frederick & Frederick, 99 O. G. 1865.

115. Where W. had two applications pending in either of which the claims in controversy could be made and he elected to make them in the later case, held that he is entitled to the date of his earlier case as his record date, even if the earlier application should have been included. In the absence of some substantial contention the interference will not be dissolved for this reason after judgment. Holland, 99 O. G. 2548.

116. The question as to whether it was a serious error for the Examiner to have declared the interference

without formally allowing the claim is one which should be raised under this rule.

Luger v. Browning, 100 O. G. 231.

117. Facts which are alleged to be established by the testimony are to be determined on final hearing and not on motion for dissolution.

Shallenberger v. Andrews, 100 O. G. 3013.

118. A protest against the declaration of an interference. Such motions should be determined under this rule. It is contrary to the settled practice of the Office for the Commissioner to consider in advance the propriety of the proposed action of a lower tribunal.

Sarfert, 102 O. G. 1049.

119. The question of operativeness of invention should be determined by a motion under this rule.

Osborn v. Hotsapillar, 102 O. G. 1296.

120. A petition asking that the action setting aside a default resulting in abandonment, dismissed for lack of equity. Gerand v. Abbott, Grand & McGirr, 103 O. G. 662.

121. A motion upon alleged anticipatory matter should be made under this rule in due time and not under Rule 126. Dittgen v. Parmenter, 103 O. G. 1164.

122. Questions as to new matter must be brought up under this rule and not by motion to shift the burden of proof under Rule 116.

Tripp v. Wolff v. Jones, 103 O. G. 2171.

123. The case will not be transmitted under this rule to the Primary Examiner to investigate the question of public use. Shrum v. Baumgarten, 104 O. G. 577.

124. Whether or not the junior party materially altered his application after filing it, is a question not to be considered by a motion under this rule.

Hopkins v. Scott (See Rowe & Brickmann, 133 O. G. 515), 105 O. G. 1263.

125. Two interferences declared between the same parties. That these two issues are not patentably distinct is not ground for dissolution under this rule.

Dorr v. Ames & Rearson, 106 O. G. 263.

126. If the matter of the propriety of suggested claims under Rule 96 is to be discussed it should be by motion under Rule 122.

Sutton v. Steele, 107 O. G. 541.

127. No appeal from the refusal of the Examiners in Chief to direct the attention of the Commissioner to certain patents alleged by one of the contestants to constitute a statutory bar.

Schmedl v. Walden, 1891 C. D. 150.

128. The question whether or not a supplemental oath should be furnished is an *ex parte* question. The absence of such an oath even where it should have been furnished is not such irregularity as will preclude the proper determination of the question of priority.

Auerbach & Gubing v. Wiswell, 108 O. G. 289.

129. Patentability of opponent's claims must be presented under this rule and not by appeal against award of priority. Kempshall v. Sieberling, 110 O. G. 1427.

130. Joint or sole inventor. Interference not suspended to determine.

Hull v. Hallberry, 110 O. G. 1428.

132. Failure to make a motion to dissolve upon a ground that an accepted amendment to one of the applications involved is for new matter amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter. Croskey v. Afterbury, 1896 C. D. 437.

133. If it were true that the counts of the interference covered two specific forms not to be included in one application, still this would be no ground for dissolution.

Atherton & Happ v. Cheney, 111 O. G. 1040.

134. It is well settled that the question as to whether the original application contains the invention should be raised by a motion to dissolve. It will not be considered upon an appeal upon the question of priority of invention. Seeberger v. Dodge, 113 O. G. 1415.

135. Question of joint inventorship relates to a statutory bar and not to priority of invention, and therefore such an inquiry in an interference proceeding is not proper. Robin v. Muller & Bonnett, 113 O. G. 2506.

136. Facts outside of the record should be stated in the motion to receive consideration.

Law v. Woolf, 1891 C. D. 91, 55 O. G. 1527.

137. The Examiner decides nothing but the question raised by the motion and appeal brings up nothing but the decision and the motion decided.

Zeidler v. Leech, 1891 C. D. 9.

138. As held in the case of Jenne v. Brown v. Booth, 59 O. G. 157; C. D. 1892-78, any or all motions provided for in Rule 122 may be brought in connection with the new claims included in the interference under the provisions of Rule 109, and therefore P's motion as to the new counts was a proper one.

Pfingst v. Anderson, 114 O. G. 264.

139. It is the general policy of this Office to have all questions which may be brought in issue between the parties settled in one interference.

Normand v. Krimmelbein, 115 O. G. 249.

141. Where a motion for dissolution rests only on limitations into the claims by the moving party and not stated in such claims. HELD that the motion was properly denied. Votey v. Tally, 119 O. G. 339.

142. Error in suggesting a claim under Rule 96, is not considered such an irregularity in the declaration as will preclude a proper determination of the questions of priority, and is not therefore a sufficient warrant for dissolving the same.

Templin v. Sergeant, 119 O. G. 961.

143. The presumptive is that the Office did its duty in notifying the caveators of the filing of the interfering application, and the burden is upon them to establish their allegation of no notice by adequate proof.

Killeher & Grimm v. Mayhew, 72 O. G. 895.

144. A person is not estopped from moving to dissolve because he made the claim constituting the issue and filed a preliminary statement relating thereto.

Van Auken v. Osborne v. Harrison v. Canfield & Van Auken, 119 O. G. 1584.

145. The improper issuing of a patent to one's opponent is not a ground for dissolution.

Dunker v. Reist, 119 O. G. 1925.

146. Non-interference in fact was placed in the rules as a ground for dissolution of interference at a time when parties were put in interference proceedings who had not made the same claims; it can only occur now where the same terms, though properly used in the application of each party, have distinctly different meanings in the respective cases. *Blackmore v. Hall*, 119 O. G. 2523. See *Townsend v. Copeland v. Robinson*, 119 O. G. 2533.

147. Upon a petition that the Examiner be directed to hear a party upon his opponent's motion to amend on the question his opponent's right to make proposed claims. HELD, that petitioner may present his arguments upon motion for dissolution in case the proposed claims are admitted.

*Moore v. Curtis*, 120 O. G. 324.

148. Unsubstantial and clerical errors do not form proper basis for dissolution.

*Gally v. Burton*, 120 O. G. 325.

149. Matters which may be considered in determining the question of priority should not be transmitted to the Primary Examiner. Such as effect of prior applications.

*Struble v. Young*, 121 O. G. 339.

150. Lack of Notarial Seal not a sufficient reason for dissolving interference.

*Scott v. Hayes & Berger*, 121 O. G. 2326.

151. The right of the moving party to make the claims corresponding to the issue cannot properly be raised on a motion to dissolve the interference, and if such party does not wish to contest the interference, because he is of the opinion that he has no right to make the claims, he should take action in accordance with the provisions of Rule 125, concerning priority or abandoning the invention. *Miller v. Perham*, 121 O. G. 2667.

*Bellows v. King*, 106 O. G. 997.

*Robinson v. Titus*, 110 O. G. 310.

*Martin v. Mullen*, 127 O. G. 3216.

*Balzley v. Seiberger*, 115 O. G. 1329.

*Griffith v. Dodgson*, 116 O. G. 1731.

*Garnall v. Pope*, 115 O. G. 1329.

*Potter v. McIntosh*, 127 O. G. 1995.

152. Where two interferences are declared, one between application of S. and a divisional application of

P., and the other between the same application of S. and the parent case of P., the fact that the issue involving the parent case could as well have been included in the interference involving the divisional application does not constitute such an irregularity as will prevent a proper determination of the question of priority.

Phillips v. Sensenich, 122 O. G. 1047.

153. So long as the parties are claiming common features of the invention it is not of consequence which is superior, and the alleged superiority of one over the other is no ground for a dissolution of the interference.

Kolb v. Hemingway v. Curtis, 122 O. G. 1397.

154. If it is decided that one party has no right to make the claims, the question of interference in fact will not be considered after decision becomes final.

Warner v. Mead, 122 O. G. 2061.

155. The motion for dissolution in this case seems to have been based upon the ground of non-interference in fact, in addition to that of a lack of right of a party to make claims, in order that the same facts of reason may be urged in connection with either or both grounds; but this is exactly what a party should not be permitted to do, in view of the labor and delay attending such double consideration both before the Primary Examiner and on Appeals. Booth, Booth & Flynt v. Hanan & Gates v. Marshall, 123 O. G. 319.

156. Where the interference is generic the first inventor of a species is entitled to judgment.

Lovejoy v. Cady, 123 O. G. 654.

157. If a party has no reasons to allege in his motion to transmit which would support dissolution upon appealable grounds, he would not be permitted to waste the time and labor of his opponents and of the Office with appeals which can have no other object than to obtain a review of an unappealable decision.

Pym v. Hadaway, 123 O. G. 1283.

158. Interference and patentability considered by the Primary Examiner a careful examination nevertheless made to determine whether there is anything in the record of this case, as there was in the case of Podlesak and Podlesak v. McInnerney (Court of Appeals Jan. 4, 1906)

necessitating limitations of the claims in the respective applications to specific non-interfering features.

Bechman v. Southgate, 123 O. G. 2309.

Cites

119 O. G. 1922, Sobey v. Holsclaw.

120 O. G. 1823, Potter v. McIntosh.

89 O. G. 2459, Bechman v. Wood.

89 O. G. 2462, Bechman v. Wood.

159. The failure to include the claims did not constitute an irregularity.

Locke v. Crebbin, 124 O. G. 317.

160. It is to be noted that the question involved in the contention of Blackford relates to the patentability of the present issue over the subject matter of the issue of the former interference, and not of the right of Wilder to make the claim by reason of the nature of the disclosure. The question is therefore not in the class indicated in my decisions as subject to consideration in determining the award of priority.

Blackford v. Wilder, 124 O. G. 319.

161. Question of *res adjudicata* properly raised under this rule.

Blackford v. Wilder, 124 O. G. 319.

This case cites:

Blackford v. Wilder, 104 O. G. 578.

Potter v. McIntosh, 122 O. G. 1721.

Sobey v. Holsclaw, 119 O. G. 1922.

Pohle v. McKnight, 119 O. G. 2519.

Kilbourne v. Hirner, 122 O. G. 729.

Podlesak v. McInnerney, 120 O. G. 2127.

162. So far as now appears there is nothing in the statute or rules requiring the defects in Turner's oath to be corrected before the same is accepted as a complete application. Such being the case the correction of these defects is an *ex parte* matter which may be attended to after termination of interference.

Dukesmith v. Carrington v. Turner, 125 O. G. 348.

163. A motion to require a supplementary oath and to shift filing date to the date of such oath should be presented as a motion to dissolve.

Dukesmith v. Corrington v. Turner, 125 O. G. 348.

164. Appeal on motion to shift the burden of proof dismissed.

Dukesmith v. Carrington v. Turner, 125 O. G. 348.

165. It is the general policy of this Office to have all questions which may be brought in issue between the parties settled in one interference. (99 O. G. 669.)

Normand v. Krimmelbein, 115 O. G. 249.

166. Interlocutory motions are not permitted upon questions requiring the taking of proof such as originality and public use. (44 O. G. 945; 87 O. G. 180; 96 O. G. 2409; 103 O. G. 1164; 104 O. G. 577).

Cory, Gilhart & Martin, Jr., v. Blakey, 115 O. G. 1328.

167. A motion under this rule is a proper reply to an order to show cause under Rule 114.

Filbel v. Fox, 130 O. G. 2375.

168. The real meaning of the words of the claims may not be apparent when viewed solely in the light of the disclosure of one party. It is believed therefore that the best practical results will be obtained by permitting a party when moving to dissolve an interference not only to raise the question of the right of the other party to make the claims of the issue, but also the question of the meaning of the claims when applied to the respective structures involved.

Eilerman v. McElroy, 130 O. G. 2721.

169. Motion denied transmission for the reason that the question of interference in fact is no longer a part of the grounds enumerated in Rule 122.

Eilerman v. McElroy, 130 O. G. 2721.

170. A motion to dissolve which alleges that the opposite party is not entitled to receive a patent on his reissue application, involving matters that should be considered on the *cx parte* reissue application should be transmitted.

Emmet v. Fullagar, 130 O. G. 2719.

171. A motion to dissolve on the ground of non-patentability of the issue is a proper reply to an order to show cause under Rule 114.

Field v. Colman, 131 O. G. 1686.

172. Vagueness and indefiniteness of the issue have uniformly been held a proper question to raise under informalities, or irregularity in the declaration of the interference, and it is thought properly so held.

Field v. Colman, 131 O. G. 1686.

173. It would seem that misrepresentation in a collateral matter would be sufficient for dissolution of a trademark interference.

L. W. Levy & Co. v. Uri, 131 O. G. 1687.

174. The redeclaration of an interference to include new counts does not relieve against negligence in making a motion as to original claims.

Murphy v. Borland, 132 O. G. 231.

175. Grounds 3, 4 and 5, allege the bar of prior knowledge and use based upon the affidavit of one Plumb. These grounds were properly refused transmission under the well-established practice set forth in 66 O. G. 1596; 96 O. G. 2409; 104 O. G. 577; 115 O. G. 1328. M. contends that because these decisions refer primarily to the bar of public use the practice set forth therein is not applicable. This contention however, is not well taken, since the bar of prior knowledge and use alleged in the Plumb affidavit would have to be proved in a manner similar to the bar of public use.

Murphy v. Borland, 132 O. G. 231.

176. Motion to dissolve upon the ground that public use was shown by the preliminary statement of the applicant. Transmission joint and sole invention.

Thomson & Unbehend v. Hisley, 66 O. G. 1596.

177. The question whether a third party not involved in the interference is the real inventor of the subject matter in issue is not pertinent to the question of priority of invention.

Hamm v. Black, 132 O. G. 841. (Cases cited.)

178. The question whether or not a supplemental oath should be required has been uniformly held by this Office to be an *ex parte* matter upon which the proper determination of priority is not dependent.

Auerback & Gubing v. Wiswell, 108 O. G. 289.

Silverman v. Hendrickson, 99 O. G. 445.

Kane v. Brill & Adams, 84 O. G. 1142.

Rennyson v. Merritt, 58 O. G. 1415.

Phelps v. Sensenich, 132 O. G. 677.

Rowe v. Brinkman, 133 O. G. 515.

In this last case however, it was directed that the interference be suspended to give applicant a chance to file a proper oath and that in default the interference should be dissolved.

179. The question whether the applicant will be permitted to amend his specification after such dissolution to incorporate the matter submitted or any other amendment is an *ex parte* question, which must be determined independently of any interference proceeding.

Wheeler v. Palmros, 133 O. G. 230.

179a. Facts which are alleged to be established by the testimony are to be determined on final hearing and not on motion to dissolve. Mead v. Brown, 48 O. G. 397; Campbell v. Brown, 56 O. G. 1565; Chase v. Ryder, 61 O. G. 885; Lotticem v. Force and Parenteau, 82 O. G. 185; Shiels v. Lawrence, 87 O. G. 180; Felbel v. Oliver, 92 O. G. 2339; Horton v. Summer, 92 O. G. 2339; Shellenberger v. Andrews, 100 O. G. 3013; Faure v. Bradley and Crocker v. Cowles and Cowles, 44 O. G. 945; Paget v. Bugg, 89 O. G. 1342; Sullivan v. Thomson, 94 O. G. 585; Frederick v. Frederick and Frederick, 99 O. G. 1865; Ritter v. Krakaw and Connor, 104 O. G. 1897; Thompson and Unbehend v. Hisley, 66 O. G. 1596; Hopkins v. Scott, 105 O. G. 1263; Winlon v. Jeffery, 112 O. G. 500; Cory, Gebhart and Martin, Jr., v. Blakey, 115 O. G. 1328; Struble v. Young, 121 O. G. 339.

## GROUND FOR DISSOLUTION.

180. In this case the Primary Examiner dissolved the interference on the affidavit of one of the Trauts as a sole inventor. This order was irregular; after the declaration of an interference it cannot be dissolved except by the Examiner of Interferences, or the Commissioner, or by the Board of Examiners, or Commissioner on appeal.

Traut & Traut v. Disston & Morse, 70 O. G. 99.

181. Where applicant's preliminary statement shows two years' public use.

Schenck v. Rider, 1870 C. D. 135.

182. Where the proof shows that neither party made the invention, the question of priority is at an end, and there can be no further interference. Interference dissolved.

A sole inventor is not a party to an interference between third party and himself and another as joint inventor. *Pugh v. Hamilton*, 1871 C. D. 116.

*Walters et al. v. Yost et al.*, 1875 C. D. 59.

183. Where the specifications disclose compositions that are essentially different both as to proportions and the character of the ingredients used and the process of using the composition, the interference should be dissolved. *Jackson v. Nichols*, 1871 C. D. 278.

184. An interference should be dissolved when the interfering claim is to elements which are not shown to be capable of use by themselves.

*Jackson v. Nichols*, 1871 C. D. 278.

185. The interference dissolved by the Examiners-in-Chief on the ground that the two applications did not interfere, on an appeal from the final judgment of the Examiner of Interferences.

*Frick*, 1872 C. D. 124.

186. An interference should be dissolved when the two inventions are radically different and designed for entirely different purposes.

*Pearl & Sawyer*, 1874 C. D. 58.

*Dod v. Cobb* (1876 C. D. 232) 10 O. G. 826.

187. An interference dissolved because the claim was too broad in view of the state of the art.

*Scott v. Ford*, 14 O. G. 413.

188. If the claims are substantially the same the interference should not be dissolved.

*Drawbaugh v. Blake*, 23 O. G. 1221.

189. A motion to dissolve an interference on the ground that the oath to one of the applications was not taken before a proper officer considered, and the Commissioner says:

“Judgment as to the application of A and B has been admitted to examination, notwithstanding the effect under consideration, the examination will not be suspended.”

But no patent should issue until the mistake was rectified. *Warnant v. Warnant*, 17 O. G. 265.

190. When an interference is sent back to the Primary Examiner on a motion to dissolve or suspend the interference, or by direction of the Commissioner upon the allegation that there exists a statutory bar to the claim, or that the claim is not patentable, or that the applicant has no right to make the claim (Rule 116-120), which motion is granted by the Examiner, the interference is *pro hac vice* dissolved, and the application involved becomes *ex parte*.

Faure v. Bradley v. Cowles & Cowles, 40 O. G. 243.

191. Interference dissolved to permit Primary Examiner to require an oath applying to date of completion of the application.

Miller v. Lambert, 72 O. G. 1903.

192. Motion to dissolve interference upon the ground of estoppel by oath of applicant to a preliminary statement and by the testimony of his witnesses in a previous interference wherein he was one of two applicants.

Mead & Brown, 48 O. G. 397.

193. Where foreign patent expired because of non-payment of tax and applicant summoned to show cause why interference should not be dissolved for want of right to make the claim. His failure to respond construed an admission.

Armstrong, 71 O. G. 1615.

194. A motion to dissolve because opponents were estopped from having this interference in view of a prior interference transmitted.

Foglesing v. Hutt & Phillips, 61 O. G. 151.

195. Interference dissolved because of non-patentability of issue, claims were limited and new interferences declared; motion to dissolve because patentability was *res adjudicata* refused.

Kitsee v. Robertson, 97 O. G. 2306.

196. In that case (121 O. G. 1978) the existence of interference in fact was regarded as doubtful, and it was in view of the doubt that the consent of the parties was permitted to turn the decision in favor of dissolution. I have no doubt as to the existence of interference in fact in the present case. The interference must accordingly continue. (Trade-Mark.)

Hirsch & Co. v. Jennen v. Hilbert & Sons v. Sample & Co., 122 O. G. 1724.

197. A motion for dissolution bases upon the ground that the moving party has no right to make the claim to the subject-matter in issue should not be transmitted.

Martin v. Mullin, 127 O. G. 3216.

Miller v. Perham, 121 O. G. 2667.

Bellows v. King, 106 O. G. 997.

Robins, Jr., v. Titus, 110 O. G. 310.

#### PATENTEE—APPLICANT.

198. Transmission refused to examine into the question of public use alleged to be shown by preliminary statement of an applicant on motion of a patentee. Cases reviewed.

Thomson & Unbehend v. Hisley, 66 O. G. 1596.

199. Where a patentee claiming specifically would be entitled to all his claims, even if he were an applicant, in spite of a judgment of priority in favor of his opponent, the fact that his opponent's claim would dominate his own is no sufficient reason for declaring or continuing an interference. Rule 75 provides for precisely such a case.

Reed v. Landman, 1891 C. D. 73.

199a. Where a party's opponent is a patentee said party cannot move to dissolve on the ground that he has no right to make the claims adopted by him when suggested under Rule 96, otherwise if opponent is an applicant.

Hernsdorf v. Driggs v. Schneider, 133 O. G. 1189.

200. An applicant for reissue moved to dissolve the interference on the grounds that the issue was not patentable. HELD, such motion should not be considered.

Bellows v. King, 106 O. G. 997.

201. Where R., an applicant, moved to dissolve on the ground that the issue was not patentable, it was said:

"The only question to be determined in the interference is whether a patent should issue to R., since he is the only applicant claiming the invention, and since he admits by his motion that he is not entitled to the claims there seems to be no reason why the Office should consume time in considering the matter."

Robins, Jr., v. Titus and Titus, 110 O. G. 310.

202. A patentee is clearly entitled to make a motion upon any of the grounds specified.

Fickinger & Balke v. Hulett, 110 O. G. 859.

203. An applicant may move to dissolve interference on the ground that a patentee had no right to make the claims. *Hull v. Hallberg*, 110 O. G. 1428.

204. Where one of the parties to an interference is a patentee and the applicant brings a motion to dissolve on the ground that the issue is not patentable, held that the interference will be dissolved, and the applicant will be thereafter regarded as estopped from insisting upon the claims. *Weissenthanner v. Goldstein*, 111 O. G. 810.

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205. A patentee may move to dissolve an interference on the ground that the claims are not patentable.

*Baltzley v. Seiberger*, 115 O. G. 1329.

206. Where an applicant is in interference with a patentee and moves for a dissolution of the interference on the ground of non-patentability of the issue, the interference should be dissolved even where patent has been inadvertently issued during pending of application.

*Griffith v. Dodgson*, 116 O. G. 1731.

*Garnell v. Pope*, 115 O. G. 2136.

207. The statute does not specifically provide for the consideration of motions, and Rule 122 both in the letter and reason limits the fight to such consideration to those cases where the opponent of the moving party is an applicant. *Griffith v. Dodgson*, 116 O. G. 1731.

208. In *Hisey v. Peters* (6 App. D. C. 68) this court said an applicant who claims an alleged patentable invention is not to be heard to urge non-patentability of his claim after it has been placed in interference with other claims. *Potter v. McIntosh*, 127 O. G. 1995.

### FORM OF MOTION.

(See "Transmission of Motion.")

*Winter v. Slick v. Wollkommer*, 97 O. G. 1837.

209. An objection to the patentability of a claim should be made by a motion to dissolve the interference and not by an attempt to restrict the issue.

*Hockhausen v. Weston*, 18 O. G. 857.

210. For form and practice under this rule see *Green v. Siemens v. Hall v. Field*, 37 O. G. 1475.

211. Irregularity in declaring an interference has reference to a case where, in consequence of some defect, some misdescription, some error in describing the thing alleged to be the subject of the interference, or something of that character, a proper solution of the question of priority cannot be reached. It does not refer to what are irregularities in consequence of a violation of the provisions of Rules 121 and 122.

Edison & Gilliland v. Phelps, 38 O. G. 539.

213. The decision must be confined to the question presented. Zeidler v. Leech, 1891 C. D. 9.

214. If facts are relied upon other than those disclosed by the record, they should be stated in order to receive consideration.

Law v. Woolf, 1891 C. D. 91, 55 O. G. 1527.

215. Patentability is not in question in a motion to dissolve for non-interference in fact.

Forslund v. Matthews, 1891 C. D. 237.

216. On the granting of a motion to dissolve the interference after judgment on the record the Examiner of Interferences will vacate the judgment of priority.

Garrison v. Hubner, 1891 C. D. 59.

217. Failure to make a motion to dissolve, upon a ground that an accepted amendment to one of the applications involved is for new matter, amounts to an acquiescence in such acceptance and in the decision of the Office that such amendment does not involve new matter.

Croskey v. Atterbury, 1896 C. D. 437.

218. Moving to dissolve an interference upon any of the grounds stated in Rule 122 before the preliminary statements are opened and approved is a practice not to be encouraged.

King v. Babendrier v. Libby, 89 O. G. 2653.

219. A motion to vacate judgment is not an alternative remedy with a motion to dissolve.

Patten v. Weisenfeld, 98 O. G. 2589.

220. In a decision the four reasons for dissolution should be kept distinct.

Woodward v. Newton, 86 O. G. 490.

221. The case remanded to have a decision having regard to the distinctions pointed out above.

Owens v. Richardson, Jr., 111 O. G. 1038.

222. A motion to extend time for filing an appeal should be accompanied by appeal.

Greuter v. Matthew, 112 O. G. 253.

223. That the counts are vague and indefinite is such an irregularity in the declaration of an interference as to preclude a proper determination of the question of priority. Dinkel v. D'Olier, 113 O. G. 2507.

224. If the motion is for the purpose of including "allowable claims" in another pending application which has been filed by applicant, the motion should be accompanied by a copy of such claims.

Normand v. Krimmelbein, 115 O. G. 249.

225. The motion to extend the time for filing motions was properly denied by the Examiner, who stated that the reasons set forth might justify the excuse for delay should a motion be made.

Egly v. Schulze, 117 O. G. 276.

226. A motion to dissolve for non-interference which does not specify which of two opponents does not interfere is irregular and should not be transmitted.

Vreeland v. Fessenden v. Schloemilch, 117 O. G. 2633.

227. The four grounds for dissolving interferences relate respectively to very different matters and should not be confused with one another.

The question raised by the contention of non-interference in fact is whether the claims as found in the cases of the respective parties define one and the same invention, and the question is independent of the patentability of the claims, the right of the parties to make them or any irregularity in the declaration of the interference.

Kaczander v. Hodges & Hodges, 118 O. G. 836.

228. As pointed out in the cases of Woodward v. Newton, 86 O. G. 490, and Owens v. Richardson, 111 O. G. 1037, the four grounds for dissolution given in Rule 122 have distinct meanings which should not be confused.

Pfingst v. Anderson, 118 O. G. 1067.

229. A motion for dissolution should give the opposing party a reasonably definite idea of the points to be considered when the hearing is had.

The counts of the issue against which non-interference is alleged should be specified.

Vreeland v. Fessenden v. Schloemilch, 119 O. G. 1259.

230. In a motion to dissolve the bare allegation that there is no interference in fact is insufficient.

The point or points to be argued should be specified with great particularity. Not only the count or counts, but the particular element or elements which are to be brought into question should be specified.

Dunker v. Reist, 119 O. G. 1925.

231. Dissolution for non-interference in fact must be based only on those facts and reasons which show that the counts of the issue have such different meanings that they might properly be allowed to both parties.

Townsend v. Copeland v. Robinson, 119 O. G. 2523.

232. In setting forth facts in motions for dissolutions the distinction between the general grounds of dissolution which have been pointed out in Woodward v. Newton, 86 O. G. 490, Owen v. Richardson, 111 O. G. 1037, and Kaezander v. Hodges & Hodges, 118 O. G. 836, must be carefully observed. The observance of these distinctions is necessary to the logical presentation of the question raised and to the avoidance of confusion in the matter of appeals. Klepetko v. Becker, 120 O. G. 658.

233. It is to be noted that the motion does not specify the element or elements of the counts which cannot be read on the two devices with the same meaning and gives no information to the opposing parties of the points to be argued.

Therefore the motion was not in proper form and should not have been transmitted.

Miller v. Mann, 122 O. G. 730.

234. A motion to transmit because opponents' application did not originally contain the subject matter of a combination claim must specify what element or elements of the combination were wanting.

Latour v. Lundell, 122 O. G. 1046.

235. A motion to dissolve alleging non-patentability of the opposing parties' claims in view of certain specified patents is not indefinite simply because the patents are enough to anticipate the claims of both parties.

Latour v. Lundell, 122 O. G. 1046.

236. The recently established practice requiring definiteness requires that motions shall distinctly and definitely set forth the points to be argued, but not arguments themselves.

Garcia v. Pons, 122 O. G. 1396.

237. The right of the appellant to allege and urge that there is no interference in fact is recognized, but under the present practice of the Office he is required to make clear upon what point he intends to base his arguments. Dickinson v. Hildreth, 122 O. G. 1397.

238. In a motion to dissolve because of indefiniteness of the counts the moving party should point out wherein the supposed indefiniteness lies, so that the opposing party will know the character of the arguments that he will be called on to meet.

Berry, Kane & Stengard v. Hildreth, 122 O. G. 1722.

239. Where matter is set forth in a motion for dissolution as basis for one ground thereof which should only be considered in connection with another and different ground, the motion is not in proper form and should not be transmitted.

Corey v. Eisman & Misar, 122 O. G. 2063.

241. The statement contains no positive allegation that certain terms appearing in the issue have such distinct meaning when read as claims in the different applications that different inventions are represented thereby in the respective cases.

Motions to dissolve on this ground are not in proper form unless they contain specific allegation of the kind mentioned.

Booth, Booth & Flynt v. Hanan & Gates v. Marshall, 123 O. G. 319.

242. The only contentions and arguments which are in order in support of motions to dissolve interferences for non-interference in fact where the parties have made the same claims are those tending to show that the claims have different meanings in the case of the respective parties notwithstanding a perfect right upon the part of each party to make the claims.

Goodwin v. Smith, 123 O. G. 998.

243. The objection urged to ground C is that non-patentability of the issue is alleged therein, not generally but to Hadaway. The objection is not a valid one as it is conceivable that the claims might have such different meanings in the cases of the respective parties as to represent patentable subject matter in one case and non-patentable subject matter in the other.

Pym v. Hadaway, 123 O. G. 1283.

244. It is urged that if the claims are literally construed they are not patentable in view of a certain specified patent, and for this reason they must be limited by construction to the specific device shown by the respective parties and that as so limited there is no interference in fact.

The question of patentability cannot be thus raised on a motion to dissolve alleging non-interference in fact.

Klepetko v. Becker, 124 O. G. 908.

245. Grounds must be specific. If it is alleged that new matter has been improperly introduced the new matter should be pointed out.

Lizotte v. Newberth, 1240 G. 1842.

246. Robinson's motion to amend the issue does not come within the provisions of Rule 109. The proposed claims are claims not made by either of the opposing parties and were asserted for the first time in this motion. Besides there was too much delay in bringing the motion.

Townsend-Copeland v. Robinson, 124 O. G. 1845.

247. In inaugurating the practice of requiring definiteness in motions to dissolve it was not the intention to require the parties to give the arguments, but it was the intention that the opposite party should be given reasonable notice of the points to be argued.

If the moving party is of the opinion that each of the references is a substantial anticipation of each of the claims it should be so stated; if not the motion should enumerate the reference in connection with the claims to which they will be applied in the argument.

Heyne, Haywood and McCarthy v. De Vibbness, Jr., 125 O. G. 669.

250. Where a motion is made before the Examiner of Interferences to set times for taking testimony as to

operativeness, a showing of reasons which do not apply to applicants' own case must be made.

Clement v. Browne v. Stroud, 125 O. G. 992.

251. Where a party makes a reasonable showing before the Examiner of Interferences tending to show that his opponent has no right to make a claim, and that showing does not extend to his own structure, he may be permitted to take testimony provided that the proposed testimony is of a character to justify such action.

Pym v. Hadaway, 125 O. G. 1702.

252. Townsend's argument that it is useless for him to appeal on the question of his right to make the claim until it is settled that the claims are patentable is not sound. As well might he argue that it would be useless for him to contest the patentability of the claims as long as it was held he had no right to make the claims.

Townsend v. Ehret, 125 O. G. 2051.

253. The distinction between the several grounds for dissolution—refused to exercise supervisory power upon question of patentability under the circumstances.

Daggett v. Kaufmann, 127 O. G. 3641.

254. M. moved to dissolve as to one set of counts if the other set were found unpatentable on T's motion. Transmission refused because it was alternative and bad in form. Turner v. Macloskie, 128 O. G. 2835.

255. The statement that this count "does not involve patentable invention over each of the following letters patent" after which certain patents are specified, is a sufficient compliance with the practice of the Office as set forth in Heyne et. al. v. De Vilbiss, 125 O. G. 1292.

256. Nothing is alleged in this case in support of the motion to dissolve because the counts have different meanings in the two applications, which may not be fully accounted for by lack of right of one or the other of the parties to make the claim, or which indicates that any other reason exists for dissolving the interference; under these circumstances the refusal to transmit the motion was right. Cushman v. Edwards, 128 O. G. 457.

257. It is not pointed out in the motion what meaning may be given to counts 4 and 5 in one case that would justify the allowance of these claims to each party with-

out regard to which was the prior inventor. Such a statement is essential for transmission on the ground of different meanings.

*Cushman v. Edwards*, 128 O. G. 456.

258. Where claims have been suggested to an applicant and he makes the same under protest, accompanying the protest with a statement that he does not believe that he has a right to make them, giving his reasons for that statement, and where after inspecting the other parties' application he still contends that he has no right to make them, he should be permitted to argue the question before the Primary Examiner. The practice announced in *Miller v. Perhan*, 121 O. G. 2667, is modified to this extent.

*Eichelberger & Hibner v. Dillon*, 129 O. G. 3161.

*Hermsdorf v. Driggs v. Schneider*, 133 O. G. 1189.

259. Fifteen patents were cited but their pertinency was not explained. Should not be transmitted. (Same case.) *Eichelberger & Hibner v. Dillon*, 129 O. G. 3161.

260. The reasons given are general and do not point out the specific portions of the claims which are alleged to have different meanings in the two applications, and is too indefinite to be transmitted.

*Eichelberger & Hibner v. Dillon*, 129 O. G. 3161.

261. Where the reasons for delay appear clearly upon the record it is unnecessary to call attention to them in the motion to transmit.

*Cutler v. Carichoff*, 130 O. G. 656.

262. If a machine is alleged as an anticipation it should be stated where it can be found.

*Brown v. Inwood & Lavenberg*, 130 O. G. 978.

263. The ground of the motion based upon the prior art is entirely too indefinite to satisfy the requirements of the present practice. It gives the opponent no information as to what patents are to be urged against the respective counts or how applicant proposes the use or combine them to anticipate the inventions of the counts.

*Brown v. Inwood & Lavenberg*, 130 O. G. 978.

264. It is stated in the motion that each of the counts from 1 to 9 inclusive is unpatentable in view of the eight cited patents, and it is said:

"Each of the counts is also met in each of the above patents, singly or in combination."

This statement is clearly alternative and therefore the motion in that particular instead of being clear and specific, which was the end desired to be accomplished by inaugurating the present practice, is vague and indefinite. *Thullen v. Townsend*, 130 O. G. 1312.

*Phillips v. Scott*, 130 O. G. 1312.

265. Where a motion is brought which in accordance with the practice cannot be transmitted, it is no excuse for the delay in bringing the motion in proper form that numerous appeals and petitions have been taken in an attempt to have the original motion transmitted.

*Brantingham v. Draver & Draver*, 130 O. G. 2720.

266. The first ground of the motion is insufficiently stated, for the reason that it is not pointed out in what respect the claims of the issue comprise aggregations and not combinations.

*Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett*, 131 O. G. 362.

267. The second ground is insufficiently stated since the difference in the meanings of the claims are not pointed out.

*Papendell v. Bunnell v. Reinzenstein v. Gaisman v. Gillett*, 131 O. G. 362.

268. A motion to dissolve because the issue is anticipated, must specify the anticipation.

The practice of allowing additional references to be cited five days before the hearing has been discontinued.

*Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett*, 131 O. G. 362.

269. The refusal of the Examiner to dissolve the interference on the ground that there is no interference in fact was correct, notwithstanding affidavits which have been filed alleging that no confusion has resulted from the use of the marks referred to (Trade Mark).

*Philadelphia Watch Case Co. v. The Dueber Watch Case Co. v. etc.*, 122 O. G. 1725.

270. Dow cannot be permitted to establish the fact that he made the invention and its date by *cx parte* affidavits. *Dow v. Converse*, 106 O. G. 2291.

271. Motion to dissolve an interference, affidavits as

to operativeness received. Motion to remove from files refused. D. v. T. v. H. 99 O. G. 2550.

1902 C. D. 202.

Dickinson v. Thibodeau v. Hildrett.

272. The allegations is in the alternative that the counts are "anticipated or necessarily limited", but the motion does not state which counts he intends to urge as being anticipated and which limited, nor does it state which of the patents cited he relies upon as showing anticipation and which for restriction of the counts.

Murphy v. Borland, 132 O. G. 231.

273. It is not intended to follow the technical rules of the Court, but merely to require that motions shall clearly and definitely set forth the points to be urged.

Murphy v. Borland, 132 O. G. 231.

274. Ground 11 does not state what grounds it is alleged against, and for that reason is indefinite and should not be transmitted. (125 O. G. 669.)

Murphy v. Borland, 132 O. G. 231.

275. A motion alleging that the opposing party has no right to make the claims on account of informality of his specification is too indefinite. If petitioner meant that new matter had been improperly introduced into his opponent's specification he should have said so definitely. Roe v. Brinkmann, 133 O. G. 515.

## TRANSMISSION OF MOTION.

(See "Form of Motion.")

276. It is no reason for refusing to transmit a motion, that the question has been considered *ex parte*.

Reynolds v. Haberman, 49 O. G. 130.

277. When motion in proper form and made within the former. For these reasons grounds 7, and 9, should the time limit the Ex. of Interferences cannot refuse to transmit it. Cammet v. Hallett, 93 O. G. 939.

278. Motion to transmit in order to consider the question of shifting the burden of proof. Ex. of Interf. only decides if it is in proper form.

Sheppard v. Webb, 94 O. G. 1577.

279. These motions should not be transmitted previous to the approval of the preliminary statements.

Whipple v. Sharp, 96 O. G. 2229.

280. If the motion is made within the twenty day limit the Examiner of Interferences seems to have no discretion but to transmit the motion. If made after that time it is a matter of discretion and will not be disturbed except when there has been an abuse of this discretion.

The specific facts upon which a motion to dissolve is based need not be stated when the only facts relied upon are disclosed in the record.

Winter v. Slick v. Vollkommer, 97 O. G. 1837.

281. Ritter's motion to dissolve was based upon the testimony taken and was properly refused transmission.

Ritter v. Kralkaw & Connor, 104 O. G. 1897.

282. In the absence of an explanation of the delay the motion will not be transmitted, or when the cause for dissolution arises out of the testimony.

Hopkins v. Scott, 105 O. G. 1263.

283. A motion to transmit an amendment canceling claims before statements filed will not be transmitted under this rule.

Colley v. Copenhaver, 107 O. G. 268.

284. One party appealed to the Board on the question of patentability but recommended changes.

The motion to transmit for reformation and dissolution should be denied as it appears that no good purpose would be served thereby.

Brown, Lindmark, 109 O. G. 1071.

285. It is not ground for a motion to transmit because the Examiner has requested such a course in another case.

Parkin & Parkin v. Riotte, 109 O. G. 1335.

286. As a general rule motions to dissolve an interference are not transmitted when the reasons for bringing the same arise out of the testimony. (Felbel v. Oliver, 92 O. G. 2339.)

Winton v. Jeffrey, 112 O. G. 500.

287. When an applicant has had ample opportunity to present such claims as he wished and had presented several sets, a motion to transmit the interference in order to permit the Examiner to consider another set of claims was properly denied.

Scott v. Emmet & Hewlett, 116 O. G. 1184.

289. Where a motion for dissolution is brought long after the time fixed by the rules and is based upon patents discovered six months before the motion was made, the motion should not be transmitted to the Examiner for consideration.

Wilcox v. Newton, 116 O. G. 1452.

290. A motion to dissolve should not be transmitted when the Commissioner has ruled upon the point involved. Egly v. Schulze.

291. A decision of the Examiner of Interferences refusing to transmit will not be disturbed unless it is shown that it was clearly erroneous.

Dann v. Halliday, 119 O. G. 2236.

292. The Examiner of Interferences properly refused to transmit to the Primary Examiner motions which the Primary Examiner has no authority to decide.

Becker & Patiz v. Edwards, 123 O. G. 1990.

293. A motion to transmit for inserting claims that: it appears from a decision of the Primary Examiner in the case cannot be made by the party, should be refused.

Townsend v. Copeland v. Robinson, 124 O. G. 623.

294. Where no testimony has been taken and there is no objection by the other parties who have made similar motions—a motion to transmit to reform the issue should be granted.

Townsend v. Copeland v. Robinson, 124 O. G. 623.  
(But see same case 124 O. G. 1845).

295. The transmission of a motion filed outside of the regular time is a matter resting largely within the discretion of the Examiner of Interferences (cases).

Bastian v. Champ, 126 O. G. 2837.

296. A motion to amend the specification involved in an interference for the purpose of curing an alleged error therein should not be transmitted.

Wheeler v. Palmros, 133 O. G. 230.  
(See also note to 109).

297. A motion based on defective oath should not be transmitted. Rowe v. Brinkmann, 133 O. G. 515.

298. An indefinite motion should not be transmitted. Rowe v. Brinkmann, 133 O. G. 515.

**PETITION TO EXTEND TIME.**

299. A petition to extend the limit of appeal to include an appeal filed after the expiration thereof must be supported by verified showing in excuse for the delay.

Kletzker & Goesel v. Dodson, 109 O. G. 1336.

Autenrith & Rane v. Soresen, 120 O. G. 2126.

300. When an appeal is filed after the time limited it should be accompanied by a motion to restore jurisdiction. Greuter v. Mathieu, 112 O. G. 253.

301. As the present motion is not accompanied by affidavits showing why appeal has not been taken to the Examiner-in-Chief within the limit of appeal originally set, it has no standing and must be dismissed from further consideration.

Kletzker & Goesel v. Dodson, 109 O. G. 1336.  
110 O. G. 305-308.

302. Although the date of a reference relied upon in a motion to dissolve alleging anticipation of the issue is later than the date of conception set in the preliminary statement of the opposing party, the motion may nevertheless be transmitted in order that the Primary Examiner may consider the pertinency of the reference and permit the filing of an affidavit alleging the facts required by Rule 75, outside of those contained in such preliminary statement.

Martin v. Goodman v. Dyson v. Suttig & Goodrum, 130 O. G. 1485.

(See note in subject matter.)

303. No reasons being given in support of the reasons for dissolution, transmission was properly refused.

Miller v. Wallace, 131 O. G. 1689.

304. The original counts, 1 and 2, stand so related to the added counts that whatever conclusion the Examiner reaches regarding the dissolution of the interference as to the latter counts would probably be applicable to be transmitted as to all counts.

Murphy v. Borland, 132 O. G. 231.

305. A motion alleging informality showing that the real grounds relate to the right of a party to make the claim should not be transmitted.

Danquard v. Courville, 131 O. G. 2421.

306. Where a party acting in good faith files a motion which is held to be indefinite and an amended motion covering the informality is promptly filed within the limit of appeal set from the prior decision, the Examiner of Interferences should transmit the second or amended motion. He cannot, however, be permitted to present his case experimentally. The first motion having been denied because not sufficiently definite and decisions cited, the second motion should have cured the defect, a third motion refused transmission.

Gold v. Gold, 131 O. G. 1422.

Rockstroh v. Warnick, 131 O. G. 234.

Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillette, 132 O. G. 1837.

### EVIDENCE—AFFIDAVITS.

307. Affidavits received on both sides as to public use.  
Young v. Hoard, 1870 C. D. 59.

308. Affidavits received as to utility of device.  
Munger, 1869 C. D. 3.  
Cheesbrough, 1869 C. D. 18,  
backed by affidavits of others.

Harris, 1870 C. D. 62.

Phillips, 1871 C. D. 273.

Richardson, 1872 C. D. 144.

309. As to the former practice of invention.  
William Thie, 1870 C. D. 61.  
The affidavits of experts.

310. *Ex parte* affidavits are not competent to establish the statutory bar of two years' public use.  
Wicks & Wyman v. Knowles, 11 O. G. 196.  
Anson v. Woodbury, 12 O. G. 1.

311. It is not enough for the applicant to charge fraud, which is never presumed, but must always be strictly proved, and then to demand that he be relieved from the burden of proof which the law has imposed upon him. Such a course will not shift the burden of proof. Hansen v. Davis, 1891 C. D. 72.

312. If the operativeness of the device is denied, whether on a motion to dissolve the interference, or in any other proceeding, the applicant has a right, under Rule

31 (76) to submit affidavits in proof of the operativeness of his invention.

An applicant cannot by indirection be deprived of the benefit of this rule.

Fuller v. Brush, 79 C. D. 328, 16 O. G. 1188.

313. This rule (76) is in accordance with law.

Hidges v. Daniels, 1880 C. D. 64.

314. The Commissioner is not authorized to reject an application on the ground of more than two years' public use and sale, on *ex parte* affidavits, without giving the applicant an opportunity to cross-examine the affiants. The proof should conform to the fundamental canons of the law of evidence.

Alteneck, 23 O. G. 269.

Decision by the Supreme Court of the District of Columbia.

315. Public use and sale asserted, and affidavits tending to establish such facts filed, an order that all files be forwarded to the Commissioner. Upon examining the affidavits and files, an order issued requiring applicant to show cause, at a certain date, assigned, why an order directing an inquiry, into the question of public use and sale, should not be made. A copy of order directed to be served on applicant.

Berricklo, 37 O. G. 672.

See also Barricklo, 38 O. G. 417.

316. The oaths of the applicant that he is the first and original inventor and does not know and does not believe that the same was ever before known or used, and that letters patent for the same invention for the United Kingdom of Great Britain and Ireland have been granted to Charles William Siemens, as a communication from abroad bearing date the 5th of June, 1873, etc., is sufficient to identify the applicant with the British patentee, so as to defeat a motion to dissolve the interference on the ground that the same invention was described in said previous British patent.

Van Alteneck v. Thompson, 17 O. G. 57.

317. Where on final hearing before the Commissioner an interference is suspended and the case remanded to the Primary Examiner for consideration of the question of operativeness, this question will not be considered *inter partes* but will be determined by the Examiner,

subject to the regular course of appeal in *cx parte* proceedings. Archer, 1891 C. D. 191.

57 O. G. 696.

318. The affidavit of a party that the device was operative is questionable in view of the fact that the testimony of others, who were not produced, was accessible.

Kelly v. Flynn, 92 O. G. 1237.

319. Affidavit of Expert received and considered as to identity of invention.

Felbel v. Oliver, 92 O. G. 2339.

320. Motion to dissolve an interference, affidavits as to operativeness received. Motion to remove from files refused. Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550. 1902 C. D. 202.

321. Dow cannot be permitted to establish the fact that he made the invention and its date by *cx parte* affidavits. Dow v. Converse, 106 O. G. 2291.

322. Affidavits as to interference in fact and as to scope of claims in support of motion under Rule 122 refused. Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550.

Summers v. Hart, 98 O. G. 2585.

323. Where certain patents and publications are referred to on a motion to dissolve, and opposing party states on the record that he has no objection to their consideration, although five days' notice has not been given, the reference should be considered.

Lake v. Cahill, 110 O. G. 2235.

324. A party's rights are not limited by proceedings had in another interference between different parties.

Gray v. McKenzie v. McElroy, 113 O. G. 1968.

325. Where there were two attorneys of record the sickness of one is not sufficient excuse for neglect to look up evidence.

Ingoldsby v. Bellows, 113 O. G. 2214.

326. If the Examiner when the case is reached for action rejects claims on the ground of non-invention the applicant may undoubtedly present in response to such rejection and have admitted affidavits which include so much of the present affidavits as relate to the merits and efficiency of his device, but which omit the irrelevant

statements made in the affidavits concerning the devices of others. Robinson, 115 O. G. 1584.

327. The refusal of the Examiner to dissolve the interference on the ground that there is no interference in fact was correct, notwithstanding affidavits which have been filed alleging that no confusion has resulted from the use of the marks referred to. (Trade Mark.)

Philadelphia Watch Case Co. v. The Dueber Watch Case Co. v. etc., 122 O. G. 1725.

328. I am of the opinion that testimony upon the operativeness of the device disclosed by the senior party should be accepted and considered in determining who is the prior inventor in this case, provided a *prima facie* case of imperativeness is made out and a satisfactory showing is presented that the proposed evidence is of a character to justify opening the case for taking testimony.

Whether testimony may be taken in this case should be determined in the first instance by the Examiner of Interferences. Lowry & Cowley v. Spoon, 122 O. G. 2687.

329. Consideration of affidavits upon motions to dissolve is not a right which the parties are entitled to demand. The rights of parties on such motions extend no further than is expressly provided by rules of practice. Usually will extend no further than testimony and rebuttal.

Browne v. Stroud, 122 O. G. 2689.

330. Affidavits as to inoperativeness of opponent's device in interference cases proper for making a *prima facie* case. Lowry & Cowley v. Spoon, 124 O. G. 1846.

331. Affidavits as to operativeness of opponent's device in an interference proceeding.

Clement v. Brown v. Stroud, 125 O. G. 992.

332. *Ex parte* affidavits as to intervening rights in interference cases.

Donning v. Fisher, 125 O. G. 2765.

333. No testimony as to inoperativeness or public use previous to motion to dissolve.

Barber v. Wood, 127 O. G. 1991.

334. Public use is considered in the practice of this Office as a separate question, requiring an investigation independent of the question of priority of invention in-

volved in an interference proceeding. No testimony has been taken, and there is nothing in the case upon which the Primary Examiner at the present time can intelligently consider the bar of public use. No error is found in the refusal to transmit on this ground.

Davis v. Swift, 96 O. G. 2409.

Shrum v. Baumgarten, 104 O. G. 577.

335. An *ex parte* affidavit is not enough to carry a party's filing date back to that of a foreign application and change the burden of proof.

Raulett & Nicholson v. Adams, 114 O. G. 827.

336. These affidavits as to operativeness of invention may be filed notwithstanding an internee has been dissolved because of the inoperativeness of the device.

Mark, 117 O. G. 2636.

337. An affidavit refused consideration on the ground that certain testimony referred to therein was not properly authenticated as to officer taking it.

Brown v. Inwood & Savenberg, 131 O. G. 1423.

338. The matter at issue in an interference proceeding and a public use proceeding are different, and it is for this reason that testimony taken on the question of priority in an interference is not used on the issue of public use without further proceedings, in which the party adversely affected is given an opportunity to cross-examine the witnesses with that issue framed and to produce witnesses to explain the evidence. (Weber, 101 O. G. 2570.) For the same reason testimony taken in the public use proceeding cannot be held conclusive of the question of priority of invention, and should not be used against Gilman without the institution of a second interference.

*Ex parte* Menzelman & Overholt, 132 O. G. 232.

339. Where both parties are applicants and under the head of informality in declaring the interference it is alleged in a motion to dissolve that the claims do not apply to the structure of either party. HELD that this is not such an admission as to justify a decision on priority adverse to the moving party. The case of Lipe v. Miller, 109 O. G. 1608, distinguished.

Danquard v. Courville, 131 O. G. 2421.

**DELAY IN BRINGING MOTION, ETC.—EXCUSE FOR SECOND MOTION.**

340. A motion made and judgment passed upon it *res adjudicata* and cannot be entertained a second time upon the same state of facts.

Little v. Little, Pillard & Sargent, 10 O. G. 543.

341. The rules contemplate that a motion to dissolve the interference on the ground of non-patentability of the subject matter when the facts on which it is based are known should be made at the outset.

Such a motion by a defeated party refused after judgment because of the delay.

Blinn v. Gale, 16 O. G. 459.

342. A motion to dissolve an interference based on non-interference or an irregularity in the declaration may be heard and decided at any time before final judgment, subject to appeal to the Commissioner.

Banks v. Snediker, 16 O. G. 1096.

343. It is not an abuse of discretion for the Examiner of Interference to grant a motion to transmit, after the 20 day limit, provided the status of the case has not changed. Reynolds v. Haberman, 97 O. G. 1837.

344. It is not a sufficient excuse that one party did not discover that his opponent's application did not interfere until testimony was taken.

Felbel v. Oliver, 92 O. G. 2339.

345. The motion to dissolve should not be granted in view of the delay, etc.

Annand v. Spalackhaver, 93 O. G. 753.

346. When a motion to dissolve is not made within the time fixed by Rule 122, it is permissible to consider the probability of the grant of the motion, etc.

Annand v. Spalekhaver, 93 O. G. 753.

347. The 20 days having elapsed a motion to restore jurisdiction to the Examiner of Interference for the purpose of moving to dissolve should be accompanied by the motion to dissolve.

If such latter motion cannot be made within the time limit it should be made as soon thereafter as possible.

Niedermeyer v. Walton, 97 O. G. 2306.

348. In case of discovering new facts after granting the motion to transmit to the Primary Examiner, he may consider such facts provided due and timely notice thereof be given to the party opposing the motion. A petition to amend is unnecessary.

*Kurz v. Jackson & Pierce*, 98 O. G. 2586.

349. Whether a delay beyond the time limited shall be excused lies somewhat within the discretion of the Examiner. 99 O. G. 1383.

350. When a second motion to transmit is made on the ground of newly discovered evidence it is proper for the Examiner of Interferences to consider the question of due diligence.

*Whitlock & Huson*, 99 O. G. 1385.

351. A motion pending under this rule is not a bar to a motion under Rule 109, nor does it excuse delay.

*Perrussel v. Wiedmann*, 99 O. G. 2970.

352. If a motion is not made within the 20 days limited, the burden is upon the mover to show that it could not have been sooner.

*Niedringhaus v. Marquard v. McConnell*, 101 O. G. 1610.

353. Delay in making motion excused in view of the cost of obtaining a copy of opposite party's application, the difficulty of getting the money for the same, and the complicated nature of the case.

In the above case the delay was also due in part to the Office. *Kletzer & Goesel v. Dodson*, 101 O. G. 2822.

354. Under the circumstances of this case even admitting that Miller did not appreciate the pertinency of the patents referred to till April 21, 1903, a delay of over a month in bringing his motion after this date was not exercising due diligence.

The affidavit accompanying witness' motion is defective in that it does not appear therefrom that the patents on which he relies to anticipate the issue could not have been obtained earlier by the exercise of reasonable diligence.

*Lipe v. Miller*, 105 O. G. 1532.

355. As the applicant has made no satisfactory showing that the references could not have been found before, and the motion presented earlier to grant his appeal

would, in effect nullify the clause in Rule 122 requiring such motions to be made within 20 days following the approval of the preliminary statement.

Sturgis & Hopewell, 109 O. G. 1067.

356. When no testimony has been taken and the delay is slight, the motion may be entertained.

Harrison v. Shoemaker, 109 O. G. 2170.

357. A second motion to transmit considered as a motion for a new trial and no limit of appeal set.

Goodfellow v. Jolly, 110 O. G. 602.

358. It appears, therefore, that the real reason for bringing the motion at this time is a change of purpose, arising from the fact that the applicant has appointed a new attorney. Such reason is not sufficient excuse for the delay. Rayburn v. Strain, 110 O. G. 603.

359. Where parties have not seen each other's statements a slight delay may be excused.

Doble v. Eckhart v. Henry, 110 O. G. 604.

360. After 20 days the burden of proof is upon applicant to show diligence. In the absence of such showing a refusal to transmit is proper. The pendency of a motion to shift the burden of proof is no excuse.

McArthur & Gilbert, 111 O. G. 1624.

361. The fact that an alleged anticipating patent was not discovered until the expiration of the time limit not considered sufficient excuse.

Schirmer v. Lindemann & Stock, 111 O. G. 2222.

362. The pendency of a motion for dissolution is no good reason for delay in bringing a motion to shift the burden of proof. (See McArthur v. Gilbert, 111 O. G. 1624.) Harvey v. Lubbers v. Raspillaire, 112 O. G. 1215.

363. A second motion for dissolution will not be entertained unless there is good showing why new reasons advanced were not presented at the time of the first motion. Hedlund v. Curtis, 113 O. G. 1419.

364. The pendency of a motion to dissolve by one party does not excuse delay in making such a motion by another party.

Jackson v. Cuntz, 115 O. G. 510.

365. The excuse for delay in bringing motion was the non-discovery of a German patent.

Some of the grounds alleged had nothing to do with the German patent and therefore that was no excuse for delaying the motions on these grounds. No reason why the German patent was not discovered earlier was given and no sufficient excuse was given for the delay of more than two months after such discovery.

"The pendency of an appeal upon the first motion, which had been decided against him is no excuse."

Pfingst v. Anderson, 117 O. G. 597.

366. A mere change of opinion after retention of new counsel will not justify transmission of the motion for dissolution long after (two months) the time when it should have been brought.

Carver v. McCanna, 117 O. G. 599.

377. It is against the policy of the Office to permit piecemeal motions in interference cases.

Egly v. Schulze, 117 O. G. 276.

378. Unexcused delay in bringing motion.

Carney v. Latimer, 119 O. G. 6522.

379. That one was not able to get copies of papers within the 20 days' limit received as an excuse. It was however unnecessary to allege the papers were furnished by the Office. Steinmetz v. Thomas, 119 O. G. 1260.

380. If the excuse for delay in bringing a motion does not cover the entire time the motion should not be transmitted. McKee v. Baker, 120 O. G. 657.

381. The provisions of Rule 122 requiring motions to be brought **if possible** within a time fixed is conducive to orderly procedure and must be enforced. The Examiner of Interference was right in refusing to transmit a motion not made in time and unaccompanied by a proper excuse. Townsend v. Copeland v. Robinson, 124 O. G. 1210.

382. Where an amendment to a motion was filed after the time limit had expired, the original motion having been filed in time and no delay being occasioned, held that the time of filing the amendment was no objection.

Smith v. Fox, 130 O. G. 1312.

383. Motions on ground of inoperativeness are not favored and it is incumbent upon one bringing them to do so promptly.

Joslyn v. Hulse, 130 O. G. 1689.

384. In response to an order to show cause under Rule 114 applicant moved to dissolve for non-patentability of issue, but was not sufficiently specific in applying references, amendment filed seven days after limit.

In view of this attempt to apply the references, the promptness with which the second motion was filed, and the fact that refusal of the motion will be fatal to appellant's case, it is thought that the last motion to dissolve should be transmitted to the Primary Examiner.

Anser v. Pierce, Jr., 131 O. G. 359.

385. A junior party, cited to show cause why judgment should not be rendered against him on the record, may move to dissolve for non-patentability of the issue.

Papendell v. Bunnell v. Reizenstein v. Gaisman v. Gillett, 131 O. G. 362.

386. The bringing of motions or the taking of petitions to the Commissioner will not stay the running of the limit of appeals from a decision on priority.

Pym v. Hadaway, 131 O. G. 692.

387. As to claims involved in a second interference between the same parties which could have been made in the first interference, HELD that a final decision in the first interference on the question of priority renders that question *res adjudicata*.

Hopkins v. Newman, 131 O. G. 1161.

388. It is well settled that piece-meal action cannot be permitted, but where a party acting in good faith files a motion which is held to be indefinite, and an amended motion curing the informalities is promptly filed within the limit of appeal set from the previous decision, the amended motion should be transmitted.

Gold v. Gold, 131 O. G. 1422.

See, however, Rockstroh v. Warnock, 132 O. G. 234.

389. A second interference between the same parties upon the same subject-matter should not be instituted.

Wenzelman & Overholt, 132 O. G. 232.

390. Delay not relieved against by re-declaration to include additional counts.

Murphy v. Borland, 132 O. G. 231.

391. Transmission of motion to dissolve refused in view of the fact that the excuse for delay was insuffi-

cient in that it alleged that business of great importance prevented him from consulting his attorney in time, but did not show why the matter could not be attended to by correspondence.

Blackmore v. Hall, 132 O. G. 1387.

392. The pendency of a motion to shift the burden of proof is no excuse for the delay in bringing a motion to dissolve. Price v. Blackmore, 133 O. G. 514.

McArthur v. Gilbert, 111 O. G. 1624.

392a. In the absence of positive written law excluding Sundays from the period of time prescribed for any purpose, they are counted, even though the period ends on Sunday. (Lewis Southerland Statutory Construction, Vol. I, p. 335.) The same rule is applicable to holidays. (Trade mark.)

Robert A. Keasley Company v. Portland Cement Fabrik Hemmor, 133 O. G. 1936.

#### EXPEDITING PROCEEDINGS. EXAMINER'S ACTIONS—TIME LIMIT.

393. Motions under this rule formerly required to be noticed for hearing within the time limited for appeal, so that the jurisdiction should not be lost.

Meyrose v. Jahn, 56 O. G. 1417, 1891 C. D. 145.

394. The decision must be confined to the question presented. Zeidler v. Leech, 1891 C. D. 9.

395. The time limited for the making of motions runs from the day the original statements are received and approved; and a subsequent amendment of a preliminary statement does not of itself operate to extend this time.

Scribner & Warner v. Childs v. Balsley, 1892 C. D. 104.

396. Upon a motion to dissolve an interference upon the ground of irregularity in declaring the same the Primary Examiner is not at liberty to decide the question of patentability.

Hutt & Phillips v. Foglesong, 1892 C. D. 190.

397. On hearing nothing should be considered by the Primary Examiner outside of the fact disclosed by the record unless a showing of such additional facts accompanies the motion to transmit, but that where moving

parties rely upon the record it is unnecessary for them to state in the motion the facts upon which the motion for dissolution is based.

In the case of the discovery of new facts after granting the motion to transmit, the Primary Examiner may consider such facts provided due and timely notice thereof be given to the opposite party.

*Wells v. Packer*, 90 O. G. 1947.

398. When motions to dissolve are brought upon the grounds specified in Rule 122, the Examiner should decide the motion on all grounds, and if this decision is of such a nature that appeals therefrom may be taken he should fix a limit of appeal.

*Hingley v. Parker*, 97 O. G. 2742.

399. The Examiner should decide the motion upon all the grounds presented.

*Oldham & Padbury v. P. v. C. v. R.*, 99 O. G. 670.

400. If the Examiner is of the opinion that part of the claims are unpatentable he should dissolve the interference as to these claims and continue it as to the remainder. If the remaining claims are sufficient to base a conclusive decision upon, the interference should not be dissolved to present new claims in place of those held unpatentable. A motion to amend may be granted conditioned on the filing of an affidavit under Rule 75.

*Hillard v. Eckert*, 101 O. G. 1831.

401. When a motion is made on all the grounds specified in Rule 122, it is the duty of the Examiner to consider and determine all these grounds and assign limits of appeal to all that are appealable.

*Cutler v. Riddell*, 100 O. G. 763.

See also *Hopfelt v. Read*, 106 O. G. 767 and cases cited.

402. Where time is limited in which to take action after the rendering of a decision, the date of the decision and not the date of the receipt of notice thereof governs.

*Greuter v. Mathieu*, 112 O. G. 254.

403. If there is a broad invention common to the respective inventions, it would seem that this fact could be determined by the respective parties and the claims included in the issue, so that this interference can pro-

ceed on its merits without further delay, of which there has been too much in this case.

Normand v. Krimmelbein, 115 O. G. 249.

\* 404. The time limit fixed in the rules for motions means actual time, and Sundays and holidays are not excluded in computing it.

Dickinson v. Norris, 116 O. G. 593.

405. Where an interference is transmitted to the Primary Examiner for the purpose of determining the right of one of the parties to make the claim, and the Examiner also decides the question of interference in facts—HELD that the Examiner exceeds his jurisdiction.

Podlesak & Podlesak v. McInerney, 118 O. G. 835.

See next case also, 118 O. G. 836.

406. The time limited for appeal begins to run when the case is returned to the Examiner of Interferences and formal resumption of proceedings is noted.

Hewitt v. Steinmetz, 122 O. G. 1396.

407. Where the questions involved are patentability and the right of party to make claim, the motion should not be granted on the ground of non-interference in fact.

Thullen v. Young & Townsend, 118 O. G. 2251.

409. Successive motions discouraged.

Scott v. Emmet & Hewlett, 119 O. G. 2233.

410. Prior *ex parte* decision by appellate tribunal not binding on Primary Examiner in *inter partes* consideration. Felsing v. Nelson, 120 O. G. 2445.

411. The Examiner may upon a motion for dissolution of an interference where a party has filed a certified copy, determine whether or not it is necessary for the other party to see other parts or the whole of the original application. Fagan v. Graybill, 121 O. G. 1013.

412. It is well settled that where an interference is transmitted to the Primary Examiner for the consideration of one question, he is without jurisdiction to consider an entirely independent question.

Moore v. Curtis, 121 O. G. 2325.

413. Where the Examiner finds on motion to dissolve an interference that the subject matter in issue is not patentable, he should take such action in the applications

subsequent to his decisions as will put them in condition for statutory appeal, so that the appeal may be continued directly to the Court of Appeals without the necessity of a second course of appeal through the Patent Office.

Newcomb v. Thomson, 122 O. G. 3013.

414. No good reason appears for holding that a tribunal may not properly render a decision on a motion for a rehearing made within the time limited for an appeal but noticed beyond such limit.

Naulty v. Cutler, 126 O. G. 389.

415. If a motion is made before the expiration of the 30 days, the balance of the time is waived.

Rockstroh v. Warnick, 132 O. G. 234.

416. No limit of appeal should be set on a decision refusing to expunge testimony.

Green, Tweed & Co. v. Manufacturers' Belt Hook Co., 132 O. G. 680.

417. Where an Examiner rejects claims presented by a party for interference under Rule 109, he should set a limit of appeal from his decision whether the claims had been allowed to the other party or had been made for the first time by the moving party.

Mattice v. Langworthy, 132 O. G. 1073.

### GROUNDS OF APPEAL.

418. When it appears upon the face of the paper that the real grounds of a motion to dissolve relates to the merits, the Commissioner will not take jurisdiction either by appeal or petition.

Manny v. Easley v. Greenwood, Jr., 48 O. G. 538, 86 O. G. 490-491, 98 O. G. 415, 97 O. G. 1172, 110 O. G. 6036, 107 O. G. 1098, 88 O. G. 2409, 96 O. G. 844, 86 O. G. 1636, 89 O. G. 1862, 78 O. G. 1904.

419. It thus appears that the Court of Appeals will not entertain an appeal from a decision on a motion to dissolve an interference, even where the decision is adverse to the right of a party to make the claim. This latter question may be settled *ex parte* in the usual way after the interference.

The whole proceeding relating to motion for dissolu-

tion is one of office procedure provided for by the authority of R. S. Sec. 483, Newcomb v. Lemp, 112 O. G. 1216. But see U. S. ex rel. The Newcomb Motor Co. v. Moore Com., 133 O. G. 1680.

420. Examiner required to set a limit for appeal upon the question of irregularity and interference in fact. If these grounds are mere pretenses to get the question not appealable under Rule 124 reviewed the appeal will be dismissed. Duryea & White v. Rice, 115 O. G. 803.

421. It having been finally determined that Struble has no right to make claims corresponding to the counts of the issue, the question raised by the appeal, namely, the question of interference in fact, becomes moot and will not, therefore, be decided.

Coleman v. Struble, 114 O. G. 973.

422. All the reasons given where alleged but the case was not appealed **solely** upon the ground of non-patentability of his opponent's claim. The Examiner properly set a limit of appeal, as he is not the judge of the propriety of the appeal.

Harnisch v. Gueniffet Benvit & Nicault, 117 O. G. 1492.

423. A decision that a claim has not been abandoned by failure to prosecute is appealable under this rule.

Meden v. Curtis, 117 O. G. 1795.

424. Where the claims of the interfering party are in identical language there is an interference in fact, although there may be specific differences in the two constructions, such specific differences not being specified in the claims.

Gordon v. Wentworth.

425. It is not a question whether the issue applies to both structures and means the same thing in both cases, but whether giving it to its natural and ordinary meaning the issue is patentable. The Examiner's decision on patentability being favorable the motion to dismiss this appeal is granted.

White v. Thomson, 101 O. G. 1371 and 2825.

426. On appeal matters not urged before the Examiner will not be considered.

Pfingst v. Anderson, 118 O. G. 1067.

427. In trade-mark cases on an appeal as to priority, identity of subject-matter will not be considered.

Horne v. Somers & Co., 129 O. G. 1609.

428. Whether or not the application discloses the subject-matter of the interference, and, therefore, whether or not the interference is properly declared, is a question ordinarily to be determined by the Patent Office. (See Ostergen v. Tripler, 17 App. D. C. 558; Herman v. Fullman, 23 App. D. C. 264-265.) However, this Court has held that in extreme cases where palpable error has been committed, the decision of the Patent Office holding identity of invention between the devices of the parties to the interference may be reversed. (See Podlesak & Podlesak v. McInerney, 26 App. D. C. 399.)

McMulken v. Bollee, 130 O. G. 1691.

### SHIFTING BURDEN OF PROOF.

429. Burden of proof when originality denied.

Wherry v. Heck, 49 O. G. 559.

430. It is not enough for the applicant to charge fraud, which is never presumed, but must always be strictly proved, and then to demand that he be relieved from the burden of proof, which the law has imposed upon him. Such a course will not shift the burden of proof. Hansen v. Davis, 1891 C. D. 72.

431. The burden of proof in an interference is upon the contestant who fails to make a claim to the improvement in controversy or a statement equivalent thereto until the same was claimed by the other party to the interference. Reichenbach v. Goodwin, 1893 C. D. 50.

432. A formal abandonment of the earlier application does not shift the burden of proof, if there is a clear continuity of action between it and the second application, where the two applications are filed by the same applicant and cover substantially the same subject-matter. Parmly v. Hockhausen, 1891 C. D. 180.

433. The presumption is that the Office did its duty in notifying the caveators of the filing of the interfering application, and the burden is upon them to establish their allegation of no notice by adequate proof.

Killeher & Grimm v. Mayhew, 72 O. G. 895.

434. A resissue has the same standing as to burden of proof as the original patent.

Hansen v. Davis, 1891 C. D. 72.

435. Motion to shift need not set up facts unless they are outside the record.

Sheppard v. Webb, 94 O. G. 1577.

436. A motion to shift the burden of proof may be founded upon matters outside of the record.

Bundy v. Rumbarger, 92 O. G. 2001-2.

437. If one wishes to establish the date of filing of an earlier application he should do so by a motion to shift the burden of proof, in which case the decision of the Primary Examiner as to the admission of claims will be final. If such earlier application is brought in the course of taking the testimony it will be considered like other testimony by all the tribunals having jurisdiction.

Robinson v. Copeland, 102 O. G. 466.

438. A motion to shift the burden of proof because the invention in issue was introduced by amendment is improper. The remedy is by motion to dissolve under rule 122. Tripp v. Wolff v. Jones, 103 O. G. 2171.

439. When an error is discovered by the Examiner of Interferences which would amount to such an irregularity as would preclude proper determination of the question of priority, such as the improper placing of the burden of proof, the interference should be forwarded to the Primary Examiner with a statement of facts, that he may correct his letter forwarded to the Examiner of Interferences under Rule 97.

Lutz v. Lewis, 110 O. G. 2014. (Sup.)

440. F's patent does not make him the senior party in the proceeding; as D. was the first to file an application, he is the senior party in this proceeding, and it is incumbent upon F. in order to prevail to establish his case by a preponderance of evidence.

Furman v. Dean, 111 O. G. 1366.

441. The pendency of a motion for dissolution is no good reason for delay in bringing a motion to shift the burden of proof (See McArthur v. Gilbert, 111 O. G. 1624.) Harvey v. Lubbers v. Raspillaire, 112 O. G. 1215.

442. Motions to shift the burden of proof are brought under the provisions of Rule 116. In a proper case the burden of proof can be shifted without dissolving and redeclaring the interference.

443. Said by Commissioner on Appeal—Before the interference proceeds further it should be positively determined whether or not these new reference anticipate the issue. Wright & Stebbens v. Hansen, 114 O. G. 761.

444. An *cx parte* affidavit is not sufficient to change the burden of proof by carrying back a party filing date to that of a foreign application.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

445. Motions to shift the burden of proof should be made before the Examiner of Interferences within the twenty days after the approval of the preliminary statement allowed for motions. This case withdraws jurisdiction from the Primary Examiner in this class of cases.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

446. A previous application which does not show all the elements of the issue cannot avail to shift the burden of proof.

Norden v. Spaulding, 114 O. G. 1828.

447. As held in the case of Raulet & Nicholson v. Adams (114 O. G. 1827) no appeal will be entertained upon interlocutory motion relating to the burden of proof, but that matter may be brought up with the final decision as to priority of invention. Such motions should be made before the Examiner of Interferences.

Osborne v. Armstrong, 114 O. G. 2091.

448. Claimed that the invention was not shown in original application but was introduced by amendment subsequent to the filing of opponent's application.

If well founded this would entitle S., who was the first to conceive, to the benefit, also, of the earlier reduction to practice, and an inquiry into the question of diligence would be unnecessary.

Seeberzer v. Dodge, 114 O. G. 2382.

449. As a general rule the burden of proof rests on the party against whom judgment would be rendered if no evidence were adduced on either side. This question involving the taking of testimony, should be considered

by the Examiner of Interferences, and there is no appeal from his decision prior to the final appeal.

Fennell v. Brown v. Borsch, 115 O. G. 1328.

450. Where an appeal was taken from the action of the Primary Examiner denying motion to shift burden of proof, the appeal not considered and case remanded to Examiner of Interferences. Head note to Fisher v. Daigherly, 118 O. G. 1681. Opinion does not seem to bear out head note.

451. The alleged improper placing of the burden of proof forms no proper basis for motion for dissolution, and that question should be presented by separate motion to shift the burden of proof.

Blackmore v. Hall, 118 O. G. 2538.

452. The question of shifting the burden of proof is a matter within the jurisdiction of the Examiner of Interferences and not the Primary Examiner, and there is no appeal from this decision prior to final judgment.

Raulet & Nicholson v. Adams, 114 O. G. 1827.

Scott v. Southgate, 121 O. G. 689.

## MISCELLANEOUS.

Allen, Com., etc., v. U. S. ex rel. Lowry et al., 116 O. G. 2253.

Eschinger v. Drummond & Lieberknecht, 121 O. G. 1348. See note to Rule 124.

Ingoldsly v. Bellows, 116 O. G. 2532. See note to Rule 128.

Wallace, 118 O. G. 1686. See note to Rule 145.

Cazen v. Von Welsbach, 119 O. G. 650. See note to Rule 153.

Sobey v. Holsclaw, 119 O. G. 1922.

Park v. Lewis, 120 O. G. 323. See note to Rule 124.

Felsing v. Nelson, 121 O. G. 1347. See note to Rule 124.

Garnall v. Pope, 115 O. G. 2136. See note to Rule 126.

Miller, 116 O. G. 2532. See note to Rule 66.

Hicks v. Costello, 103 O. G. 1163.

Sibley Soap Co. v. Lambert Pharmacal Co., 103 O. G. 2172.

Dickinson v. Thibodeau v. Hildreth, 99 O. G. 2550. See Rule 76.

Fessenden v. Potter, 101 O. G. 2823.

- Votey v. Weist, Jr., v. Donovan, 111 O. G. 1627.  
Macey v. Tobey v. Laning, 97 O. G. 1172.  
Potter v. Van Vleck v. Thomson, 95 O. G. 2484.  
Valiquet v. Johnson, 92 O. G. 1795.  
Banks v. Snediker, 17 O. G. 508.  
Carroll v. Stahlberg, 111 O. G. 1937.  
Fickinger & Blake v. Hulett, 111 O. G. 2492.  
Wilkinson v. Junggren, 112 O. G. 252.  
In re Lowry, 90 O. G. 445. See note 1, Rule 15.  
Philadelphia Watch Case Company.  
The Dueber Watch Case Manufacturing Co.  
The Keystone Watch Case Company v. Byron L. Strasburger & Company, 122 O. G. 1725. See note to Rule 76.  
Kugele v. Blair, 127 O. G. 1253.  
Hewitt v. Weintraub v. Hewitt v. Rogers, 128 O. G. 1689. See note under Rule 130.  
U. S. A. ex rel. The Newcomb Motor Co. v. Allen (Moore) Commissioner.  
See note to 124-130, O. G. 302.

**RULE 123.**

123. All lawful motions, except those mentioned in Rule 122, will be made before and determined by the tribunal having jurisdiction at the time. The filing of motions will not operate as a stay of proceedings in any case. To effect this, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion.

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**STAY OF PROCEEDINGS.**

453. A motion to operate as a stay of proceedings should be accompanied by a petition to that effect. An order should then be entered at or before the hearing of said motion granting or refusing the petition.

Dubois v. McCloskey, 17 O. G. 1158.

454. A motion for a rehearing—even if filed within the limit would not operate as a stay.

Carmichael v. Fox, 104 O. G. 1656.

455. When Alexander's motion to re-open was filed on March 11, only three days remained to him for the time limited for appeal. The suspension of proceedings at that time did not have the effect of setting aside and nullifying the order fixing 30 days as the limit of appeal, but merely stopped the running of the time until the question raised could be finally disposed of. As soon as that question was disposed of by the decision of May 13, the time for appeal again began to run.

A limit of appeal will not usually be extended.

Blackman v. Alexander, 105 O. G. 2059.

456. There is no necessity for a suspension of proceedings, as there is now no limit of appeal running against any of the parties.

Robinson v. Townsend v. Copeland, 106 O. G. 997.

457. A petition under Rule 145 is not good ground for asking a suspension of the interference.

Churchward v. Douglas v. Cutler, 106 O. G. 2016-17.

458. It is deemed better in the interest of uniform practice to require that motions be filed as provided in Rules 122 and 123 should a suspension of proceedings be desired pending the determination of any lawful motion. *Hoegh v. Gordon*, 108 O. G. 797.

459. It is no ground for the suspension of an interference that an infringement suit is pending.

*McBride v. Kemp*, 109 O. G. 1070.

*Kletzker & Goesel v. Dodson*, 109 O. G. 1336.

460. If it is difficult to obtain testimony and a party elects to take his chances without it, he cannot have the case reopened to introduce such evidence.

*Grenter v. Matthew*, 111 O. G. 583.

461. When a suspension has been granted the time commences to run immediately on the expiration of the time of suspension, or upon the determination of the motion. *Grenter v. Matthew*, 112 O. G. 253.

462. A motion for rehearing does not operate as a stay of the running of the time in which an appeal from that decision should be taken.

*Cole v. Zarbock v. Greene*, 116 O. G. 1451.

463. Cases in the Office will not be suspended to await the final decision of the Courts upon another case where similar questions are raised.

*Potter v. McIntosh*, 116 O. G. 1451.

464. A stay will not be granted to await the determination in an *ex parte* consideration of an application not involved in the interference.

*Mark v. Greenwalt*, 118 O. G. 1068.

465. The pendency of one motion is no excuse for the failure to bring other motions, and a suspension of proceedings as to one motion does not extend the period of time for bringing other motions. (Cases cited.)

*Moore v. Curtis*, 121 O. G. 2325.

*Naully v. Cutler*, 126 O. G. 389.

## JURISDICTION.

466. It is a matter wholly within the discretion of the Commissioner what questions or whether all questions arising out of interference cases shall be decided

in the first instance, by the Examiner of Interferences or some other Primary Examiner.

Weitling v. Cabell, 72 C. D. 185.

See also 22 O. G. 22-33.

467. To what tribunal they (questions arising in an interference proceeding) may be appealed may be determined altogether by the nature of the questions themselves, and the law relating to them.

Weitling et al. v. Cabell, 1872 C. D. 187, 185.

468. Questions of patentable combinations remanded to the Primary Examiner for consideration.

Lynch & Raff v. Dryden & Underwood, 1873 C. D. 73.

470. If in the judgment of the Examiner of Interferences neither party is entitled to a patent for want of novelty, he must send the question back to the Primary Examiner for determination. He cannot decide it himself. Neuboeker v. Schafhaus, 1873 C. D. 138.

471. The practice indicated by this Rule approved by McArthur J., but Judge Wylie said "I have no idea that it was the intention of the law makers that in questions of interference the Office should go into the question of abandonment, and he did not think the Commissioner had a right to establish a rule permitting it."

Bigelow v. The Commissioner of Pats., 7 O. G. 606.

472. The Examiner of Interferences is the tribunal before whom an interference is originally to be heard. It is irregular to present the question to the Board of Examiners in the first instance.

Farnsworth v. Andrews, 9 O. G. 195.

473. The question of two years' public use as a statutory bar receives consideration from the Examiner of Interferences. He overlooks in this connection, the question of sale. This appears to be a very important point. This case was remanded by the acting Commissioner to the Primary Examiner to consider the question of sale more than two years before application.

Keller & Olmesdahl v. Felder, 10 O. G. 944.

474. The Examiner of Interferences has no jurisdiction over questions of patentability. Such questions should go to the Primary Examiner as they are appeal-

able to the Supreme Court of the District, and matters within the jurisdiction of the Examiner of Interferences cannot be appealed from the Decision of the Commissioner. *Little v. Little et al.*, 10 O. G. 543.

475. Facts establishing two years' public use before application for a patent developed in an interference cannot afterward be explained away by *ex parte* affidavits. Case remanded to the Primary Examiner to consider such question.

*Stearns v. Prescott*, 13 O. G. 121.

476. Questions of statutory bar of public use referred to the Primary Examiner by the Commissioner without an appeal from the decision of the Examiner of Interferences. *Quimby v. Randall*, 14 O. G. 748.

477. The Examiner of Interferences has no jurisdiction over of two years public use as a bar to a patent.

*Little v. Little et al.*, 76 C. D. 207.

*Ansen v. Woodbury*, 77 C. D. 4.

478. The Examiner of Interferences cannot dissolve an interference in view of *ex parte* affidavits setting forth public use as a bar to the application. The question should be remanded to the Primary Examiner.

*Hedges v. Daniels*, 17 O. G. 152.

479. After the declaration of an interference a motion to dissolve should be made to the Examiner of Interferences. *Barney v. Kellogg*, 17 O. G. 1096.

480. The Examiner of Interferences has jurisdiction to hear and determine the fact of joint or sole invention in an interference between joint patentees and a sole applicant who is one of said patentees.

*Lourien v. Banister*, 18 O. G. 299.

*Ex parte Bruker, M. S.*

481. If it is decided that there was no joint invention the sole applicant would be the prior inventor, as the entity, the joint inventors, never invented it at all.

*Kohler v. Kohler & Chambers*, 43 O. G. 247.

*See Harrison v. Hogan*, 18 O. G. 921.

482. Judgment of priority given by the Commissioner and the case remanded to the Primary Examiner to determine the question of a statutory bar by reason of public use. *Smith v. Dimond*, 20 O. G. 742.

483. The Examiner of Interferences is a proper person to hear and determine questions relative to abandonment.

Von Heffner v. Alteneck, 23 O. G. 2233.

484. The practice indicated by this rule (126?) seems to be that such reference by the Commissioner can only be made when the case is brought to him regularly on appeal. In a case where the testimony conclusively establishes the fact that the invention had been in public use for more than two years prior to the time when the application for a patent was filed, I do not know that it would be a violation of the Rule for the Commissioner to order that the question should be determined before any decision of priority is made. But as above stated such is not the practice under said Rule. Such reference will not be made if the testimony relating to public use is not conclusive. Finch v. Bailey & Talbot, 25 O. G. 191.

485. Motion for the dissolution of the interference on the ground that it was declared in violation of the provisions of Rules 121 and 123 should be determined by the Examiner of Interferences.

Edison & Gilliland v. Phelps, 38 O. G. 539.

486. Motion to re-open for the purpose of taking more testimony comes properly before the Examiner of Interferences. McCallum v. Bremer, 93 O. G. 1918.

Hildreth, 97 O. G. 1374.

487. The restoration of jurisdiction for one purpose does not restore it for all.

Benger v. Burson, 99 O. G. 1384.

488. After appeal it was refused to restore jurisdiction to the Examiner of Interferences in order to present a motion to dissolve.

Fessenden v. Potter, 101 O. G. 2823.

489. The fact that a similar question has been raised by another party furnishes no ground for a rehearing.

Davis v. Ocumpaugh v. Gerrett, 103 O. G. 227.

490. Motions to shift the burden of proof should be made before the Examiner of Interferences within the 20 days after the approval of the preliminary statements allowed for motions. (Changing jurisdiction from Primary Examiner to Examiner of Interferences.)

Raulet & Nicholson v. Adams, 114 O. G. 1827.

491. Jurisdiction restored to the Examiner of Interferences after time limited for appeal had expired.

The party should have a hearing upon the question whether the showing made by him is sufficient to warrant the reopening of the case.

Lipscomb v. Pfeiffer, 122 O. G. 351.

492. The only apparent questions for consideration on a motion to restore jurisdiction to the Examiner of Interferences are whether the motion is in proper form and whether so far as can be seen, without going into the merits of that motion, it is brought in good faith.

Newell v. Clifford v. Rose, 122 O. G. 730.

493. It is urged that the earlier application does not disclose the invention, and it is very clear that this is a matter which is to be considered and determined by the Examiner of Interferences and not the Primary Examiner. Dickinson v. Hildreth, 122 O. G. 1397.

494. Jurisdiction of Examiner of Interferences.

Lowry & Cowley v. Spoon, 122 O. G. 2687.

Behrend v. Lammer v. Tingley, 124 O. G. 2536.

Kugele v. Blair, 125 O. G. 1350.

**RULE 124.**

124. Where, on motion for dissolution, the Primary Examiner renders an adverse decision upon the merits of a party's case, as when he holds that the issue is not patentable or that a party has no right to make a claim or that the counts of the issue have different meanings in the cases of different parties, he shall fix a limit of appeal not less than twenty days from the date of his decision. Appeal lies to the Examiners-in-Chief in the first instance and will be heard *inter partes*. If the appeal is not taken within the time fixed, it will not be entertained except by permission of the Commissioner.

No appeal will be permitted from a decision rendered upon motion for dissolution affirming the patentability of a claim or the applicant's right to make the same or the identity of meaning of counts in the cases of different parties.

Appeals may be taken directly to the Commissioner, except in the cases provided for in the preceding portions of this rule, from decisions on such motions as, in his judgment, should be appealable.

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**HISTORY AND SUBJECT MATTER.**

495. This rule is not inconsistent with section 4909 of the Revised Statutes.

Lowry v. Spoon, 112 O. G. 732. (See 133 O. G. 1680).

496. Previous to 1880 an appeal seems to have been allowed from a decision affirming the patentability of a claim. The same result can now be attained by a protest under Rule 12.

Fowler v. Benton, 17 O. G. 266.

497. Propriety of rule discussed. (Consolidating Interferences.)

Klein v. Groebli, 110 O. G. 305-308.

498. The practice indicated by Rules 122-123-125 may not be the best, but as long as it is the established practice it should be observed. Brown v. La Dow, 18 O. G. 1049.

499. Determined means ended or decided. This rule should control Rules 116 and 120.

Hicks v. Keating & Bilgram v. Purvis, 40 O. G. 344.

500. The statutes do not provide for an appeal to the Examiners-in-Chief from a decision upon a motion to dissolve an interference.

Allen, Commissioner, v. U. S. ex rel. Lowry et al., 116 O. G. 2253.

501. The Commissioner has, however, supervisory authority over these matters.

Anderson & Dyer v. Lowry, 89 O. G. 1861.

502. It is more than doubtful whether a construction of Rule 124 which would deprive the Commissioner of jurisdiction would be a valid one.

Von Welsbach v. Lungen, 48 O. G. 537.

503. Questions arising under this rule are not reviewable by the Supreme Court of the District of Columbia on Appeal. Hulett v. Long, 89 O. G. 1141. See however

U. S. *ex rel.* The Newcomb Motor Co. v. Moore, Com., 133 O. G. 1680.

504. I know of no confusion in the practice at present existing as to the proper course of appeal upon the question of interference in fact. Rule 124 seems clear and unmistakable upon this point.

Allfree v. Sarver, 122 O. G. 2391.

506. The Rules cannot take away the right of an applicant to an appeal after two rejections by the Primary Examiner. See R. S. Sec. 4809.

U. S. *ex rel.* The Newcomb Motor Co. v. Allen (Moore) Commissioner, 130 O. G. 302.

507. Appeal denying motion to dissolve for non-interference in fact is to the Commissioner and not to the Board. Zeidler v. Leech, 1891 C. D. 9.

508. No appeal from the refusal of the Examiner-in-Chief to direct the attention of the Commissioner to certain patents alleged by one of the contestants to constitute a statutory bar.

Schmiede v. Walden, 1891 C. D. 150.

509. Where a party may not appeal from a motion he may not appeal from a determination upon the admissibility of affidavits filed with that motion.

Brown v. Inwood et al., 131 O. G. 142.

510. The same reasons for not permitting an appeal from a favorable decision exists in the case of a motion brought under Rule 109 as on a motion to dissolve. The practice on motions under Rule 109 should follow the practice under Rule 124.

Townsend v. Copeland v. Robinson, 126 O. G. 1355.

Josley v. Hulse, 132 O. G. 844.

511. No appeal from a decision denying a motion to suppress testimony or requiring a party to print exhibits. Deitsch Brothers v. Loonen, 131 O. G. 2146.

512. No appeal from a decision setting aside a record judgment and fixing a time for final hearing, as this is not a final determination of the rights of petitioner in the premises.

O'Brien v. Gale v. Limmer v. Calderwood, 133 O. G. 514.

513. A decision refusing to dissolve an interference on the ground of *res adjudicata* is a favorable decision on the merits and was not to be reviewed on appeal.

Degen v. Pfadt, 133 O. G. 514.

513a. A party to an interference has no right to a review by the Commissioner of a favorable decision by the Primary Examiner in a motion to dissolve alleging non-patentability of the issue either on direct appeal or upon petition for the exercise of his supervisory authority (R. S. 4904) urged to the contrary.

Hawkins v. Coleman v. Thullen, 133 O. G. 1187.

513b. An appeal from the Examiner's ruling raises only the question whether or not the Examiner was right in postponing the consideration of the question, which is a matter that will not be reviewed and reversed except in a clear case of abuse of discretion.

Royce v. Kempshall, 119 O. G. 338.

513c. The provision of the statute giving an applicant the right to have a claim twice rejected (Sects. 4903-4909) does not apply in *inter partes* cases.

Where a Primary Examiner, on motion to dissolve decides that one of the parties has no right to make the claims of an interference issue, and such party after filing an appeal from said decision fails to prosecute the same, and abandons it, such decision becomes final and binding

on the parties and precludes the subsequent *cx parte* consideration of the same question. U. S. ex rel. The Newcomb Motor Co. v. Moore, Commissioner of Patents, 133 O. G. 1680.

### ABANDONMENT, SHIFTING THE BURDEN OF PROOF, ETC.

514. Appeal allowed from decision of Examiner of Interferences fixing dates for taking testimony as to abandonment of opponent's application.

Kinsman v. Strohm, 125 O. G. 1699.

518. No appeal is permitted prior to final judgment on a motion to shift the burden of proof, and any supposed error in the decision thereon will be reviewed in connection with the decision upon the question of priority of invention.

McGill v. Adams, 119 O. G. 1259.

519. A decision that a claim is not abandoned is not one that is not appealable under the last paragraph of this rule, but is appealable under Rule 122.

Meden v. Curtis, 117 O. G. 1795.

520. A mandamus refused to compel the Commissioner to allow an appeal where the question of abandonment was decided in favor of the applicant.

Bigelow v. Commissioner of Patents, 7 O. G. 603.

524. Refusal to suppress testimony not reversible error. Kempshall v. Royce, 129 O. G. 3162.

525. An appeal should be allowed where permission to take testimony is refused.

Pym v. Hadaway, 128 O. G. 457.

526. It is believed that it will be to the interest of all parties concerned, if the Examiner of Interferences in granting motions for the extension of time for taking testimony should not set a limit of appeal from such motion. Goodfellow v. Jolly, 115 O. G. 1064.

527. Decisions of the Examiner of Interferences are final on motions to extend time for taking testimony, and no limit of appeal should be set.

Christensen v. McKenzie, 117 O. G. 277.

528. No appeal from a decision refusing to shift the burden of proof.

Miller v. Wallace, 131 O. G. 1689.

### RIGHT TO MAKE THE CLAIM.

529. When it was contended that one of the parties did not interfere because he did not show one element of the issue, the question was one of the right of the party to make the claim, and the question was not appealable.

Ball v. Rigo, 119 O. G. 1258.

530. *Res adjudicata* is a question of right to make the claim and will not be considered on petition from a favorable decision.

Eschinger v. Drummond & Lieberknecht, 121 O. G. 1348.

531. There is no appeal from a judgment of priority rendered in view of the admission of a party that he is not the inventor, and no limit of appeal need be set from such a decision.

Townsend v. Corey, 119 O. G. 2237.

532. Where both parties were agreed that the claim was unpatentable the appeal was entertained under the supervisory authority of the Commissioner.

Reichert v. Brown, 124 O. G. 2903.

533. Favorable decision as to right to make the claim not considered on appeal.

Blackford v. Wilder, 124 O. G. 319.

534. As the question of the operativeness of one of the devices now in interference is directly presented to us as an incident of the main question of priority, we hold that it is not one for our consideration. It is as we have before indicated a preliminary question determinable in the first instance in the case of every application for a patent, and when determined in favor of the applicant is not appealable. When determined in his favor, and an interference declared thereon with another similarly allowed application, the same rule applies.

Duryea & White v. Rice, Jr., 126 O. G. 1357.

535. Interferences are to determine priority. Though parties in these proceedings are permitted to secure reconsideration by the Primary Examiner of his *ex parte*

conclusions that their opponents, aside from the conflicting claims of priority, are entitled to patents, and though they are entitled to appear and oppose such reconsideration, their opponents' right to a patent, the interest of a party has never been considered such that he should be permitted to appeal from the Examiner's *inter partes* conclusion affirming his opponent's right to a patent.

Gueniffet, Benoit & Nicault v. Wictorsohn, 117 O. G. 1492.

536. The provisions of the last clause cannot be avoided by a petition to the Commissioner to exercise his supervisory authority.

Kempshall v. Sieberling, 104 O. G. 1395.

537. It is a well settled principle that a decision relating to sufficiency of disclosure will not be disturbed except for manifest error.

Auerbach & Gubing v. Wisweld, 108 O. G. 289.

538. No appeal from the decision of the Examiner that affidavit was sufficient to overcome the reference.

McChesley v. Kruger, 101 O. G. 219.

539. No appeal can be taken from the decision of the Primary Examiner allowing claims upon an affidavit under Rule 75, as this is a favorable decision.

Byron v. Maxwell, 105 O. G. 499.

540. Decision that a claim is a good combination and is not anticipated is not appealable.

Wickers & Furlong v. Weinwurm, 117 O. G. 1797.

541. Where a party requests an interference, and the Examiner rules that he is not entitled to make the interfering claim. . . . HELD that the matter will not be reviewed on interlocutory petition or appeal.

Hanson, 117 O. G. 2632.

542. Question of new matter is not one of regularity but one of right to make the claim, from which no appeal lies. Brooker v. Smith, 119 O. G. 652.

543. Matters urged as irregularities, but which relate to right to make the claim, will not be heard on appeal.

Pryor v. Ball v. Brand, 119 O. G. 653.

544. There is no appeal from an affirmative decision upon the right of a party to make a claim, and equivalent consideration is not to be obtained by presenting the contention in different form and under a different name.

As, for instance, whether the counts mean the same in reference to both applications.

Weintraub v. Hewitt, 124 O. G. 2534.

545. The contention that the opposing parties do not have a construction responding to a certain language in the issue is one relating to the right to make the claim and not to interference in fact—No appeal.

Carnell v. Glasgow v. Cook, 120 O. G. 901.

546. There is no appeal from the decision of the Primary Examiner affirming the opponent's right to make the claims or the identity of meaning of the claims in their respective applications.

Daggett v. Kaufmann, 127 O. G. 3641.

547. A petition to review a decision affirming patentability, or the right to make the claim, and identity of meaning of counts, in the exercise of supervisory authority, will be considered only in extraordinary cases.

Lipschutz v. Floyd, 130 O. G. 2718.

See note 513.

## AFFIRMING PATENTABILITY.

548. The Examiners-in-Chief having allowed a claim corresponding to count 5 to Strouble, there is consequently no appeal from that decision.

Coleman v. Bullard v. Strouble, 114 O. G. 973.

549. No appeal lies from the decisions of the Examiner-of-Trade-Marks adjudging that a party is entitled to the registration of a trade-mark.

Sibley Soap Co. v. Lambert Pharmacal Co., 103 O. G. 2172.

550. It would be only in a very clear case that the Examiner's decisions affirming patentability would be reviewed on appeal.

Rinsche v. Sandherr, 105 O. G. 1780.

551. There is no appeal from a decision of the Examiner holding that the issue is patentable when construed broadly enough.

Bachman v. Southgate, 111 O. G. 805.

552. An appeal does not lie from a decision affirming patentability. White v. Thomson, 101 O. G. 2825.

553. No appeal lies from the refusal of the Examiners-in-Chief to call attention to the question of patentability under Rule 126. So long as this rule stands it must be enforced, and it has been approved by the different Commissioners. *Benet & Mercie v. McClean*, 97 O. G. 1595.

554. The law makes no provision for an appeal from the favorable decision of the Examiners-in-Chief affirming patentability.

*Barney v. Kellogg*, 17 O. G. 1096.

555. Last clause affirmed.

*Faure v. Bradley v. Crocker v. Cowles & Cowles*, 40 O. G. 243.

556. The supervisory authority of the Commissioner will be exercised to review a favorable decision on patentability only in very exceptional cases.

*Read v. Scott*, 101 O. G. 449.

557. When the Examiner has decided in favor of the patentability of claims, it would seem that the right of the opposing party to raise this issue was at an end.

*Sobey v. Holselaw*, 119 O. G. 1922.

558. The validity of this rule, as to denying an appeal in decisions affirming patentability of a claim, affirmed by the Supreme Court of the United States, two justices dissenting.

*U. S. ex. rel. Lowry v. Allen, Com.*, 125 O. G. 2365.

## AMENDMENTS.

559. The fact that there has been a "final rejection" in the course of the interference should not be taken to mean, as the applicant seems to fear it may, that further amendments will not be permitted except as an act of grace or leniency.

*Sanders v. Hawthorne v. Hoyt*, 125 O. G. 1347.

560. This rule does not authorize amendment of the claims during the interference.

*Sanders v. Hawthorne v. Hoyt*, 125 O. G. 1347.

## ASSIGNMENT OF REASONS.

561. A question involving the right of an applicant to make the claim in interference will not be passed upon by the Commissioner on appeal from the decision of the Primary Examiner upon a motion to dissolve the interference.

Sweeney v. Jarvos, 1892 C. D. 97.

Pryor v. Ball v. Brand, 119 O. G. 653.

Weintraub v. Hewitt, 124 O. G. 2534.

562. Where no irregularity in declaring the interference independent of the allegation of non-interference in fact was presented, HELD that the appeal as to the ground of irregularity in declaration would be dismissed.

Walker v. Brunhoff, 118 O. G. 2537.

Blackmore v. Hall, 118 O. G. 2538.

563. Where the Examiner dissolves the interference because the issue is not patentable, HELD that an appeal relating to interference in fact involves a moot question and will not be determined.

Newell v. Hubbard, 115 O. G. 1847.

564. There is no appeal from the Examiner's action holding that the counts are patentable, and therefore the sole question to be determined is whether the counts in question are the same when applied to the structure of both parties.

Anderson v. Vrooman, 123 O. G. 2975.

565. Questions cannot be raised on appeal which have not been raised by the motion and passed on below.

Larkin Company v. Pacific Coast Borax Co., 132 O. G. 679.

566. Where it has been decided that one of the parties to the interference has no right to make the claims, the question of interference in fact is a moot question and will not be considered on appeal.

Selden v. Gerts & Palmer, 105 O. G. 1531.

567. Right to make claims and patentability will not be reviewed upon appeals on non-interference in fact, and irregularity in declaration.

Thullen v. Young & Townsend, 118 O. G. 2251.

568. On appeal on question on priority, patentability will not be considered.

Fairbanks & Sauer v. Karr, 119 O. G. 651.

569. Where on an appeal to the Commissioner on the question of interference in fact it appears from the opinion of the Primary Examiner and the brief of the appellant that the real question is one relating to the right to make the claims, the appeal will be dismissed.

Schofield v. McGovern v. Woods, 119 O. G. 1924.

570. Contentions which go to the right of a party to make claims can afford no proper basis for dissolution upon the ground of non-interference in fact. Appeal dismissed. Blackmore v. Hall, 119 O. G. 2523.

Blackmore v. Hall, 120 O. G. 1477.

571. The decision of Primary Examiner affirming patentability will not be reviewed in an appeal relating to other grounds permitted by Rule 122.

Wilkinson v. Junggren, 112 O. G. 252.

572. This appeal while nominally on appealable grounds is really for the purpose of getting a review of the Examiner's decision affirming patentability and applicant's right to make the claims. It is therefore dismissed. Forsyth v. Emery, 113 O. G. 2215.

573. An affirmative decision upon the right of the appellee to make the claim is not appealable and will not be considered in an appeal on other grounds.

Kinney v. Goodhue, 123 O. G. 1663.

574. A new appeal fee must be paid on the appeal denying the patentability of a claim in an *inter partes* matter notwithstanding an appeal has been once taken on that point on an *ex parte* matter.

Cheney v. Venn, 125 O. G. 1703.

575. Applicant's claims were involved in two interferences. A motion has been made in each on the ground of lack of patentability, which was granted. Held that one appeal fee was sufficient.

Miller v. Mann v. Bacon v. Torrance, 115 O. G. 1063.

576. Where an interference is dissolved by the Primary Examiner on motion, appeal cannot be taken by the

party bringing such motion, though granted on a part only of the grounds urged therein.

*Zeitinger v. Reynolds v. McIntire*, 1891 C. D. 212.  
*Ries v. Thomson*, 1891 C. D. 233.

577. No valid reason appears to exist for making an exception where the motion is appealable to the Examiners-in-Chief and in allowing only one party to the contested proceedings to appear and be heard.

*Duncan v. Westinghouse, Jr.*, 66 O. G. 1005.

578. When both parties move to dissolve the interference upon all grounds permitted by the rules and the motions are granted, HELD that an appeal will not be entertained since a party cannot appeal from a decision in his favor merely because he disagrees as to the reason.

*Scott v. Badeau*, 116 O. G. 2007.

579. Favorable decision not appealable.

*Potter v. McIntosh*, 116 O. G. 1451.

580. Where a review is requested by G. of Examiner's rulings upon the meaning of claims in his decision granting G.'s motion for dissolution, HELD that G. was not entitled to such review: his motion for dissolution as to counts embodying the substance of these claims having been granted.

*Votey v. Gally*, 119 O. G. 339.

581. Where a party made no motion for dissolution he cannot appeal from the refusal of a motion made by another party.

*Townsend v. Copeland v. Robinson*, 119 O. G. 2523.

582. The supervisory authority will not be exercised to review a favorable decision on the question of patentability except in a very clear case.

*Eschinger v. Drummond & Lieberknecht*, 121 O. G. 1348.

583. There is no reason, as was pointed out in *Miller v. Perham*, 121 O. G. 2627, why the Office, having once decided that a party is entitled to make certain claims, should reconsider the question on the party's own motion.

*Goodwin v. Smith*, 123 O. G. 998.

584. It is the substance of the decision which deter-

mines whether it is appealable to the Commissioner and not the reason given by the Examiner.

Von Welsbach v. Lungren, 48 O. G. 537.  
Cited, 85 O. G. 1738.

585. Only one injured may appeal.

Judd v. Campbell, 110 O. G. 2017.

586. No appeal from favorable decision.

Cazin v. Von Welsbach, 119 O. G. 650.

587. Last clause. A petition will not be entertained except in a clear case, to review a favorable decision. Denton et al. v. Riker, 98 O. G. 415.

588. Non-appeal lies from a refusal to declare an interference with an existing patent accompanied by an allowance of applicant's claims under the last clause.

Gibboney, 105 O. G. 976.

### **REHEARINGS.**

589. There is no appeal from a decision refusing a rehearing.

Carmichael v. Fox, 104 O. G. 1656.

Bryon v. Henry, 104 O. G. 1895.

Reynolds v. Bean, 101 O. G. 2821.

Roemer v. Neumann, 49 O. G. 1535.

Cole v. Zarbock v. Greene, 116 O. G. 1451.

### **DECISION OF THE COMMISSIONER.**

590. The judgment of the Examiner will not be controlled by an order made in advance.

Marks v. Greenawall, 118 O. G. 1967.

591. An appellant will not be heard to argue that an interference should be dissolved, upon the ground under

• Rule 122, not argued before the Examiner.

Pfingst v. Anderson, 118 O. G. 1067.

592. Last clause. This clause may not be avoided by considering the standing of the application as evidence.

Shupphaus v. Stevens, 95 O. G. 1452.

593. The Commissioners may, upon appeal upon points not involving the question, declare that there is no conflict in fact.

Schupphaus v. Stevens, 95 O. G. 1454.

594. Does not prevent the Com'r from considering any reason for dissolving an interference which may be brought to his attention or which he may discover. A petition will not be entertained when it seeks to obtain indirectly a review of an Examiner's decision from which no appeal lies, by merely misnaming the proceedings.

Goss v. Scott, 96 O. G. 844.

595. Decision of Primary Examiner. When a motion to dissolve is brought upon the grounds specified in Rule 122 the Examiner should decide the motion upon all grounds, and if the decision is of such a nature that appeal therefrom may be taken he should fix a limit of appeal. Duryea & White v. Rice, 115 O. G. 803.

596. If appealable grounds are presented an appeal may not be refused by an Examiner because he chooses to decide the motion upon unappealable grounds.

Silverman v. Hendrickson, 88 O. G. 1703.

#### TIME WHEN TAKEN—EXCUSE FOR DELAY—PETITION TO EXTEND TIME.

597. An appeal from a decision on a motion will not be entertained and considered *nunc pro tunc* after the limit of appeal has expired, because of a showing that it was the intention to appeal and the failure was due to a misunderstanding between attorneys.

Gerdon v. Ehrhardt, 116 O. G. 595.

598. Negligence or oversight of attorneys not sufficient excuse for not taking appeal within the time limited.

Brissenden v. Roesch, 118 O. G. 2253.

599. Since the defeated party failed to take his appeal within the limit set, he is not now entitled to have that decision reviewed by another tribunal.

Briggs v. Conley, 104 O. G. 1119.

600. A limit of appeal should be set in decisions denying a right to make a claim.

Judd v. Campbell, 110 O. G. 2016.

601. Where in an interference it is decided that one of the parties has no right to make the claim, it seems clear that it is not just to the other party to withhold indefinitely his application, which is ready to issue, merely

to await the pleasure of the other party. A limit of appeal should be set.

Hutin v. LeBlanc v. Steinmetz v. Scott v. Fairfax, 97 O. G. 2744.

602. No appeal from a decision of the Examiner extending time for taking testimony. It can only be modified by the exercise of the supervisory authority of the Commissioner, and this only in unusual cases.

Wickers & Furlong v. Weinwurm, 129 O. G. 2501.

See however, Kinsman v. Strohm, 125 O. G. 1699.

603. The bringing of motions or the taking of petitions to the Commissioner will not stay the running of the limit of appeal from a decision on priority.

Pym v. Hadaway, 131 O. G. 692.

### TO THE BOARD OR TO THE COMMISSIONER.

604. Appeal denying motion to dissolve for non-interference in fact is to the Commissioner and not to the Board. Zeidler v. Leech, 1891 C. D. 9.

605. A motion of one party to amend his application by inserting two claims taken from his opponent's application, not appealable directly to the Commissioner.

Berry v. Fitzsimmons, 99 O. G. 863.

606. Interference in fact appealable to Commissioner in person. Oldham & Padbury v. Peck v. Clement v. Richards, 99 O. G. 670.

607. Appeal, from decision dissolving interference because there is no right to make the claims, appealable to Examiners-in-Chief.

Story v. Criswell, 100 O. G. 683.

608. An appeal from an action holding that there is no such combination does not lie to the Commissioner.

Webber, 98 O. G. 2362.

### DECISIONS OF THE BOARD.

609. If the Examiners-in-Chief are equally divided the Primary Examiner is affirmed, and upon questions of patentability there is no appeal.

Porter v. McIntosh, 120 O. G. 1823.

610. The only question that can be presented to the Board, under the Statute, on an appeal in an interference case upon the merits, is priority of invention. The Board has no right to make the question of whether there is an interfering matter in the device a part of their decision.

Brown v. La Dow, 18 O. G. 1049.

611. No appeal from favorable decision of the Board on questions of right to make the claim.

Josley v. Hulse, 132 O. G. 844.

Coleman v. Bullard v. Struble, 114 O. G. 973.

### MISCELLANEOUS.

Bechman v. Southgate, 123 O. G. 2309.

Last clause.

In re Locke, 94 O. G. 432.

Myers v. Sarfert, 96 O. G. 1037.

Reece v. Fenwick, 97 O. G. 188.

Hinkley v. Barker, 97 O. G. 2742.

Sharer v. McHenry, 91 O. G. 1034.

Wheeler v. Seeberger, 125 O. G. 2363.

Hopfelt v. Read, 106 O. G. 767.

Myers v. Brown, 112 O. G. 2093-4.

Schubert v. Munro, 113 O. G. 284-3.

Gully v. Brand, 113 O. G. 852.

Last clause.

Harnisch v. Gueniffet, Benoit, & Nieault, 117 O. G. 1492-3.

Allen, Commissioner, v. U. S. ex rel. Lowry et al., 116 O. G. 2254-3.

Neth v. Tamplin v. Ohmer, 120 O. G. 323.

See note to 114.

Last paragraph.

Brewer, Tily, Rehfuss & Rehfuss v. Dement, 116 O. G. 2010.

Duryea & White v. Rice, 123 O. G. 2627.

Locke v. Baldwin, 124 O. G. 317.

Harnisch v. Gueniffet, Benoit & Nieault, 128 O. G. 355

**RULE 126.**

126. The examiner of interferences or the examiners-in-chief may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (Rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may, before judgment on the question of priority, suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment, consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

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**STATUTORY BAR SUGGESTED.**

611. If public use for more than two years is shown by preliminary statement the interference should be dissolved. Schenck v. Rider, 1870 C. D. 135.

612. The question of priority decided by the Commissioner and the case referred to the Primary Examiner to determine the question of novelty in view of newly discovered references.

Yost v. Heston, 1871 C. D. 226.

613. The question of novelty is always a proper one for consideration of the Office at any time prior to the grant of a patent. An interference case re-opened to admit testimony of that kind after the time for taking testimony had expired. The Examiner of Interferences directed to assign dates for taking such testimony.

Wood v. Morris, 1873 C. D. 39.

See Hovey v. Hufeland.

614. I believe it has been the custom of the Commissioners, although such matters are purely *ex parte*, to hear other parties, in order that he might be as fully informed as possible in relation to the merits of the case.

Com. Spear in Carter & Dwyer v. Perry & Dickey,  
1875 C. D. 111.

615. In the case of Ronse and Stoddard, 75 C. D. 33, the practice of sending letters of inquiry to the inventor who has filed and abandoned an application, calling for information in the form of affidavits as to public use of the invention, and informing the applicant that another application for the same invention is pending, was inaugurated; this practice was discontinued in the case of Casilear & McIntire, 1875 C. D. 117.

616. Nor can I think that an interference proceeding authorized by law for one specific purpose (i. e. to determine priority of invention) can be rightfully used by the Commissioner for any other purpose, and in my judgment, no part of the testimony taken and submitted in such case, if plainly outside the issue, is evidence at all against the right of the adverse party. This decision related to abandonment by public use apparently.

Smith v. Perry, 9 O. G. 688.

617. The law of 1836 provided that in connection with interference proceedings, like proceedings should be had to determine which, or whether either of the applicants is entitled to receive a patent as prayed for. But in the act of 1870 this provision was omitted.

Smith v. Perry, 9 O. G. 688.

618. When the Examiner of Interferences finds that neither party is the first and original inventor he should render his judgment accordingly. As this question relates to priority it should be appealed to the Board and not referred to the Commissioner under this rule.

Wood v. Eames, 17 O. G. 512.

619. The provisions of this rule must not be construed to provide an alternate remedy, but can only be availed of when motions relating to a statutory bar cannot be made as prescribed in the other rules.

Barney v. Kellogg, 17 O. G. 1096.

620. The joint patentees proving not to be joint inventors the interference was decided against them and

the case was remanded to the Primary Examiner to consider whether there was not a statutory bar existing to the grant of the patent by reason of the right of one of said joint patentees to obtain a patent.

Harrison v. Hogan, 18 O. G. 921.

621. If the question presents itself in the preliminary statement, applicant should be given a chance to avoid the objection by amendment; if he does not do so the preliminary statement should be approved if correct in other particulars, and in his decision of the question of priority the Examiner of Interferences should call the attention of the Commissioner to the existence of the statutory bar. Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

622. The question of statutory bar as contemplated in Rule 120 relates to matter that is purely a bar as contradistinguished from title, or whether applicants are joint inventors. Under the present rule a statutory bar to either one of the parties in interference may call into exercise the action authorized by it. Formerly it was only a statutory bar to both.

Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

623. The question as to what is the correct practice under this rule when joint applicants prove not to be joint inventors has presented itself in a variety of phases to the Commissioners, and their conclusions are by no means in harmony. During the period covered by these decisions the rule has been changed and modified, but this fact will not explain the conflict in them. Decisions reviewed. Hicks v. Keating v. Purvis & Bilgram, 40 O. G. 343.

624. Public use proceeding on motion of defeated party to an interference refused.

Beardslee v. Moeslein, 46 O. G. 1640.

625. When an allegation of public use comes up for consideration in connection with an application which is being considered *cx parte* after the termination of the interference proceedings, the proper practice is for the Examiners to pass upon the question whether or not a *prima facie* case of public use has been established, rejecting the claims in the case if he decided the question in the affirmative.

Unsworn statements do not make a *prima facie* case.  
Beatty, 56 O. G. 1563.

626. The interference should not be delayed by public use proceedings unless for extraordinary and amply sufficient reasons.

Campbell v. Brown, 56 O. G. 1565.

627. The invalidating two years' public use of the statute does not require the knowledge, allowance or consent of the inventor.

Drawbaugh, 57 O. G. 546.

628. The establishment of abandonment or of two years' public use requires proof so clear as to put the matter beyond all reasonable doubt.

Bury v. Thompson, 58 O. G. 1255.

629. With the small sum appropriated by Congress for conducting public use proceedings the Patent Office is not justified in instituting such proceedings unless a strong *prima facie* case is made.

Fay v. Conradson, 65 O. G. 75.

630. Where the structure of one of the parties to an interference is inoperative, priority of invention cannot be awarded to him.

Glidden v. Noble, 67 O. G. 676.

631. Bar of public use not avoided by caveat.  
Meucci, 51 O. G. 299.

632. Interference suspended to take testimony relative to public use proceedings, without a recommendation.

Sanford Mills v. Aveyard, 88 O. G. 129.

633. Bar arising should not be considered during the interference proceeding by subordinate tribunal, but referred to Commissioner.

Paget v. Bugg, 89 O. G. 1342.

634. In the public use proceeding a copy of an application involved refused protesting party.

National Phonograph Co., 89 O. G. 1669.

635. The Commissioner may take notice of these matters on his own motion.

Anderson & Dyer v. Lowry, 89 O. G. 1861.

Larter v. Jones, 92 O. G. 383.

636. The question of statutory bar considered by Commissioner upon appeal on question under Rule 122.

Valiquet v. Johnson, 92 O. G. 1795.

637. Whether or not the Board shall suggest statutory bar, etc., is optional with them and cannot be reviewed on appeal.

Walsh v. Hallbauer, 94 O. G. 223.

638. Primary Examiner and Board take different views. Thomson v. Weston, 94 O. G. 986.

Two years' public use in designs.

Fournier, 94 O. G. 2166.

639. If the Examiner be of the opinion that certain actions should be made in an application which is involved in an interference, and said actions relate to matters which do not in any way relate to or affect the interference then pending, the proper practice to follow is for the Examiner to file a request with the Commissioner that jurisdiction of the case be restored to him for the purpose of making such action.

Hildreth, 97 O. G. 1374.

Felbel v. Oliver, 100 O. G. 2175-6.

Read v. Scott, 101 O. G. 449.

640. The question as to whether one of the parties received knowledge of the invention from a third party will not be considered in an interference proceeding. Otherwise, if it is a question of originality between the parties. Trufant v. Prindle v. Brown, 101 O. G. 1608.

Public use proceedings instituted.

Weber, 101 O. G. 2570.

Snider v. Bunnell, 101 O. G. 2572.

Fessenden v. Potter, 101 O. G. 2823.

Osborn v. Hotsapillar, 102 O. G. 1296-7.

641. The Board thought that no interference in fact existed and that one of the parties had no right to make the claim. Case remanded to Primary Examiner, who held that an interference existed and the party had a right to make the claim. Case placed on Commissioner's docket for final decision. Snider v. Bunnell, 103 O. G. 890.

642. The rules properly provide that a favorable decision by the Examiner upon the merits is not appealable; but at the same time they provide for review of such a

decision in certain cases, not as a matter of right by the parties, but as a matter of public policy.

Snider v. Bunnell, 103 O. G. 890.

643. Motion to transmit to P. E. to consider question of two years' public use, noted by Examiner of Interferences, also asking to have a foreign patent considered as an anticipation. Refused. The evidence taken in an interference cannot without further proceedings be used as the basis for the rejection of claims on the ground of public sale of the invention. Questions relating to anticipatory matter should be raised by a motion to dissolve under Rule 122.

Dittgen v. Parmenter, 103 O. G. 1164.

644. It is the question not the evidence which is transmitted for consideration and determination. In passing upon a question so transmitted the Examiner may avail himself of any information which he may obtain throwing light upon the question. To prevent surprise due and timely notice should be given of any facts to be considered which are not disclosed by the record.

Greenwalt v. Mark, 103 O. G. 1913.

645. In public use proceedings the Patent Office alone represents the public and its approval is necessary to make any agreement affecting the merits of the case binding. Kephart, 103 O. G. 1914.

646. It is designed by the practice instituted in this case to avoid these complications in those cases where the recommendation of the Examiners-in-Chief covers matters considered and passed upon by the Primary Examiner in an *ex parte* decision by substituting at the outset the entry of a rejection *pro forma* by the Primary Examiner, putting the case at once in condition for a course of appeals which may be carried to the Court of Appeals.

Holz v. Hewitt, 127 O. G. 1992.

Greenawalt v. Mark, 103 O. G. 1913.

647. Claims cannot be rejected or held unpatentable upon such affidavits alone.

Shrum v. Baumgarten, 104 O. G. 577.

648. Such investigation, however, would not be made as a part of the interference, but as an independent proceeding. It would be made only upon motion for suspension for that purpose, accompanied by a satisfactory

showing of public use and an expression of a willingness on the part of the moving party to produce the witnesses for examination and to bear the expense of the proceeding, including the expense of an officer detailed from the Office to conduct the proceeding.

Shrum v. Baumgarten, 104 O. G. 577.

649. Public use proceedings not applicable to trademarks. Dietz, 104 O. G. 1852.

650. The Examiner of Interferences was of the opinion that one applicant had no right to make the claims. The matter referred to the Primary Examiner who thought applicant had such right. The matter was then referred to the Board who held that applicant had no such right. The Commissioner directed that a limit of time to appeal from the decision of the Board be set.

Robinson v. Copeland, 105 O. G. 263.

651. Under this rule, the Examiners-in-Chief may, if they deem it advisable, call the attention of the Commissioner to any matter not relating to priority which in their opinion establishes the fact that no interference exists or that there has been irregularity in declaring the same or which amounts to a statutory bar to the grant of a patent to either party for the claim in interference. This is not, however, compulsory upon them, and if they refuse to do so, no appeal lies.

Walsh v. Hallbauer, 94 O. G. 223.

Wilcomb v. Lasher, 105 O. G. 743.

652. Where he (the Primary Examiner) disagrees with the other tribunals, it is believed that the question should be regarded as unsettled and should be referred to a higher tribunal for decision.

Snider v. Bunnell, 103 O. G. 890.

Mills v. Torrence, 106 O. G. 544.

653. The Examiner's action or failure to act under this rule is not appealable. It is in effect a favorable decision as to the patentability of the claims.

Woods v. Waddell, 106 O. G. 2017.

Kempshall v. Sieberling, 107 O. G. 541.

Dittgen v. Parmenter, 107 O. G. 1098.

654. The question of public use is, furthermore, one which cannot properly be decided against Winter without

giving him an opportunity to take rebutting proofs, since that evidence was taken upon a different issue.

Weber, 101 O. G. 2570.

Winter v. Slick v. Volkammer, 107 O. G. 1659.

655. If both parties file an abandonment of the invention the Examiner of Interferences should call attention to this bar.

Krakaw v. Harding, 107 O. G. 1662.

656. The question of patentability is *ex parte* in character, and if it becomes necessary to take testimony upon that question the Office will investigate in a proceeding independent of the interference.

Steinmetz v. Hewitt, 107 O. G. 1972.

657. Where public use is shown by testimony regularly taken, its effect cannot be overcome by *ex parte* affidavits, but only by evidence regularly taken.

Tournier, 108 O. G. 798.

658. It is contrary to usual practice to suspend an interference between two applicants to investigate the question of public use.

Perrault v. Pierce, 108 O. G. 2146.

659. The rule provides sufficiently for the consideration by the Office on its own motion of matters which might have been made the basis of the motion mentioned in Rule 122, but which were not so presented; and the action of the Examiner refusing to transmit will not be disturbed except in a clear case.

Sturgis v. Hopewell, 109 O. G. 1008.

660. In an interference between an applicant and a patentee if the Examiner of Interferences is of the opinion that the applicant is not entitled to make the claims, the case should be transmitted to the Primary Examiner for immediate determination.

Hall v. Weber, 109 O. G. 1607.

661. Successful applicant did not think the invention patentable to him. Interference dissolved.

Lipe v. Miller, 109 O. G. 1608.

662. The question of public use may be determined *inter partes*.

Mills v. Torrence, 110 O. G. 857.

Judd v. Campbell, 110 O. G. 2017.

663. A mechanical application cannot effect the burden of proof in interference between designs.

McArthur v. Gilbert, 110 O. G. 2509.

664. It is held, therefore, that when the question upon which the Examiner and the Examiner of Interferences differ relates to the patentability of the claims or the right of one of the parties to make the claims, and thereby involves the merits of the invention, the interference should be referred to the Examiners in Chief; but when the difference of opinion is merely upon formal matters, such as interference in fact or irregularity in declaring the interference, the case should be referred to the Commissioner for final determination.

Weber v. Hall, 111 O. G. 809.

665. If an alleged anticipating patent is discovered too late for a motion under Rule 122, it may still be called to the attention of the Commissioner under this Rule. Schrimmer v. Lindemann & Stock, 111 O. G. 2222.

666. Originally there were two counts in the interference, but under the procedure set forth in Rule 126 one of these has been eliminated.

Spaulding v. Norden, 112 O. G. 2091.

667. Public use alleged against some of the counts but not all. Held that the question of public use if necessarily raised at all, should be after the conclusion of the interference. Moss v. Blaisdell, 113 O. G. 1703.

668. In the matter of trade-marks.

Frank & Gutmann v. Macwilliam, 114 O. G. 542.

669. Public use suggested by assignee of entire interest sufficient to warrant action by the Office.

Cummings, 114 O. G. 2090.

670. A case transmitted to consider patentability where one party was a patentee.

The Office will not waste time deciding a moot question simply to avoid casting cloud upon a patent.

Yarnell v. Pope, 115 O. G. 2136.

671. If an applicant in contest with a patentee admits a statutory bar to himself the interference should be dissolved. Griffith v. Dodgson, 116 O. G. 1731.

672. If Carver is of the opinion that there is no invention in fact, he is not without remedy. The provisions

of Rule 126 are available when this case comes on for final hearing.

Carver v. McCanna, 117 O. G. 599.

In re Mill, 117 O. G. 904.

673. The question of patentability and interference in fact were presented for consideration on motion but not pressed, and that they were argued before the Examiner of Interferences and the Examiners-in-Chief on final hearing and these tribunals asked to make a recommendation under Rule 126 and such recommendation was refused, these facts do not warrant a review by the Commissioner. Bell v. Flora, 117 O. G. 2362.

674. The Examiner referred the case to the Commissioner because he thought the first count patentable to C. in the interference, N. v. C. v. R., and not patentable to N. or R: HELD that the two interferences should proceed. Newell v. Rose, 119 O. G. 337.

675. Reference under Rule 126 consideration of merits of an application not postponed on account of possible erroneous decision on priority.

Newell v. Clifford v. Rose, 119 O. G. 1583.

Sobey v. Holsclaw, 119 O. G. 1922.

676. It is thought that the Commissioner should remand the case and not decide it himself.

Serrell v. Donnelly, 120 O. G. 2501.

677. The parties are therefore notified that the testimony already taken will be used as a *prima facie* case in support of the allegation of public use, and that if any one of them wishes to take testimony in explanation or rebuttal he must so notify the Office within 20 days.

Niedringhaus v. Marquard v. McConnell, 121 O. G. 337.

678. A suggestion by the Examiners in Chief referred to the Primary Examiner who agreed.

There is no conflict of opinion, because the Examiner previously thought differently, to warrant a review by the Commissioner under the practice announced in Snider v. Bunnell, 121 O. G. 338.

679. This rule does not provide for the filing of motions (as for the return of the case to the Primary Examiner to determine a question of Statutory Bar). Motion entitled under it dismissed.

Struble v. Young, 121 O. G. 340.

680. An interference will not be suspended for the purpose of considering the question of estoppel against one party where dissolution of the interference would apparently leave the way clear to the allowance of a patent to another party who may not be the first inventor. *Dunbar v. Schellenger*, 121 O. G. 687.

681. Where all the evidence is before the Office upon which to base a final determination upon priority, such final determination should in general be reached before consideration of *ex parte* rights is undertaken.

*Dunbar v. Schellenger*, 121 O. G. 687.

682. Examiners thought one party had not disclosed the invention.

The interference remanded to the Primary Examiner, to hear the parties and furnish his opinion as to the question raised, together with a statement of the reasons for his conclusions. The Examiner's opinion placed in the interference file, copies sent to the parties and the case returned to the Commissioner for decision upon the appeal. *Kilbourn v. Hirner*, 122 O. G. 729.

683. A consideration of the affidavit and testimony referred to by the protestant makes it seem probable that such bar does exist. It is not necessary to analyze that testimony to determine whether it is technically sufficient if true to prove public use.

*Ashton*, 122 O. G. 730.

*Duryea & White v. Rice, Jr.*, 122 O. G. 1395.

684. I see no reason why I should act to control the discretion of the Examiner of Interferences calling attention to matter under Rule 126 or refusing to call attention under that rule.

*Wert v. Borst & Groscop*, 122 O. G. 2062.

*Munro v. Walker*, 122 O. G. 2062.

*Andrews v. Nilson*, 123 O. G. 1667.

685. The proper practice when a case is referred to the Primary Examiner upon suggestions by the Examiners-in-Chief of lack of right of a party to make claims, and the Primary Examiner disagrees with the conclusions of the Examiners-in-Chief, is to refer the case to the Commissioner for decision.

*Duryea & White v. Rice*, 123 O. G. 2627.

686. Thought that it would be an improvement if the Examiner of Interferences in these cases would make his opinion the basis of a judgment of priority of invention instead of calling attention to the supposed facts under Rule 126.

Brown v. Hodgkinson, 123 O. G. 2973.

Cites

Podlesak & Podlesak v. McInnerney, 120 O. G. 2127.

Allen, Commissioner of Pats., v. The U. S. of America ex rel. George A. Lowry & Planters Compress Co., 116 O. G. 2253.

687. The affidavits fail to make out a *prima facie* case of public use of the invention more than two years prior to Siebert's filing date. They state the conclusions of the witnesses largely to the exclusion of the facts upon which such conclusions are based. Where facts are given they are not recited with sufficient particularity and certainty. A portion of the showing is also objectionable as hearsay. The Office should not institute a proceeding that may uselessly consume the time and labor of all parties upon such a showing.

Siebert & Bloomberg, 124 O. G. 628.

688. Petitioner has not made such a showing as would warrant institution of public use proceedings (Siebert v. Bloomberg, 124 O. G. 628.)

Barber v. Wood, 127 O. G. 1991.

689. A protest on the ground of public use was once dismissed because unaccompanied by an offer to produce witnesses and bear expenses. It is now dismissed because affidavit set up conclusions instead of facts. Applicant should present this case as well as may be done by affidavits so as to give the opponent an opportunity to intelligently oppose the institution of the proceeding and the consequent delay.

Booth, 128 O. G. 1291.

Wickers & Furlong v. McKee, 129 O. G. 1269.

690. A petition that a rule be issued against an opposing party to show cause why it should not be held that he has abandoned his invention, and that petitioner be permitted to offer testimony upon such question, will not be entertained under the Commissioner's supervisory authority where the petitioner has other remedies and is

in fact pursuing another remedy before the Examiner of Interferences.

(Cases cited) Barber v. Wood, 132 O. G. 1588.

691. A motion to take testimony as to inoperativeness of opponent's apparatus, brought in the regular course of the proceedings, affords petitioner an adequate remedy without the necessity of invoking the supervisory authority of the Commissioner, and should be determined in the first instance by the Examiner of Interferences.

Lowry & Cowley v. Spoon, 122 O. G. 2687.

Barber v. Wood, 132 O. G. 1588.

The question whether one of the parties to an interference proceeding is debarred from receiving a patent by reason of his having secured a foreign patent for the same invention is a question for *cx parte* consideration after the termination of the interference.

Gueniffet, Benoit and Nicault v. Wictorsohn, 134 O. G. 255.

**RULE 130.**

130. Where the patentability of a claim to an opponent is material to the right of a party to a patent, said party may urge the nonpatentability of the claim to his opponent at final hearing before the examiner of interferences as a basis for the decision upon priority of invention, and upon appeals from such decision. A party shall not be entitled to take such step, however, unless he has duly presented and prosecuted a motion under Rule 122 for dissolution upon the ground in question, or shows good reason why such a motion was not presented and prosecuted.

**WHAT MAY BE CONSIDERED ON FINAL HEARING.**

692. Where on final hearing before the Commissioner an interference is suspended and the case remanded to the Primary Examiner for consideration of the question of operativeness, this question will not be considered *inter partes* but will be determined by the Examiner subject to the regular course of appeals in *ex parte* proceedings. Archer, 57 O. G. 696.

693. It is the clear duty of the Office in such a case to decline to further consider the question of abandonment of Y's application until the question of priority of invention shall have been determined, when unquestionably a much fuller light will have been shed upon the whole matter.

Young v. Case, 58 O. G. 945.

694. In view of the obvious irregularities in declaring the interference, it is extremely difficult to render a decision on the question of priority.

The Examiner is directed to carefully consider the question of patentability of the issue and take such action as the case demands.

Mets v. Crane & Bloomfield, 58 O. G. 947.

695. Where the Examiner of Interferences refused to consider a motion to strike out a wife's testimony and reserved the question until final hearing, HELD, on appeal

to the Commissioner, that this was a proper subject for interlocutory action.

Crawford v. Lichenstein, 61 O. G. 1480.

696. Where an applicant copied the claims of a patent all the tribunals must pass upon the question of the right of applicant to make the claim.

Reichenbach v. Goodwin, 63 O. G. 311.

697. Priority of invention cannot be awarded to an applicant whose device is inoperative.

Glidden v. Noble, 67 O. G. 676.

698. Question of patentability refused consideration on final hearing in view of the fact that no motion was made under Rule 122.

Schnabel v. Shellabarger, 68 O. G. 658.

699. Where the question of priority has been decided without the suspension of an interference proceeding, the question of patentability of a claim involved in the interference will be considered not *inter partes* but *ex parte* by the Primary Examiner.

Pell v. Pierpoint, 76 O. G. 1573.

700. The pendency of a motion to dissolve before the Primary Examiner does not prevent the parties from bringing any other proper motion before the Examiner of Interferences.

Mechlin v. Horn, Colelazer & Munger, 92 O. G. 2507-8.

700a. To pass upon the question of whether or not the evidence should be suppressed would require such a consideration of the very voluminous record in this case as will necessarily be given at the final hearing, and for that reason a final disposition of the matter should be postponed until that time.

Talbot v. Monell, 99 O. G. 2965.

700b. In certain cases it is better to postpone the consideration of questions relating to the suppression of testimony until final hearing. The present case is not one of these. The Examiner of Interferences' decision granting motion to strike out affirmed.

Brill & Adams v. Uebelacker, 99 O. G. 2966.

701. Motions requiring the whole case to be gone into will be considered only at the final hearing.

Hall v. Alvord, 101 O. G. 1833.

701a. It has been the uniform practice not to suppress the testimony before final hearing.

Andrews v. Nelson, 111 O. G. 1038.

702. Questions of patentability raised for the first time on appeal to the Commissioner refused consideration and brief on question stricken from the files.

Hedlund v. Curtis, 114 O. G. 544-5.

703. Where the question is appealed to the Commissioner on the question of priority, a motion to transmit the interference to the Primary Examiner to consider the question of patentability will not be granted unless a clear and unmistakable error appears in the prior decision. Parker v. Lewis, 120 O. G. 323.

704. The question of the right of a party to make a claim goes to the very foundation of an interference, for if the party has not such right the interference falls. If it be incorrectly held that such a party has a right to make the claim priority may be awarded to him and his adversary be deprived of a substantial right in that he is not given a claim where he necessarily is the prior inventor, his adversary never having made the invention. Manifestly that question should not be finally determined by the Primary Examiner who originally declared the interference. Podlesak v. Podlesak v. McInnerney, 120 O. G. 2127.

705. No interlocutory appeal on decision affirming right to make claims, but an opponent's right to make claims "may" be questioned upon appeal from decisions upon priority of invention where a holding of right on the part of one party to make the claims operates to deny a patent to another party who if such holding be in error is the first inventor.

Miel v. Young, 121 O. G. 1350.

See also Noble v. Sessions, 1210 O. G. 1348.

706. The question of the right to make a claim is reviewable, if at all, with the final decision in the interference and not upon interlocutory appeal.

Zimmermann v. Lamboni, 121 O. G. 2326.

707. I am of the opinion that the question raised by this attack (sufficiency of disclosure) is one properly considered in determining the question of priority in those cases where a holding that a party is entitled to

make the claim in issue results in a judgment against a party, who, if he be the true inventor and entitled to a patent. *Kilbonrn v. Hirner*, 122 O. G. 729.

708. The consideration of the question of patentability or right to make the claims will not be considered at the final hearing, where the moving party is in no case entitled to receive a patent on the subject matter.

*Potter v. McIntosh*, 122 O. G. 1721.

709. After the present motion to dissolve is disposed of petitioner may pursue his motion for an order permitting him to take testimony under the practice announced in *Browne v. Stroud*, 122 O. G. 2687, and *Lowry & Crowley v. Spoon*, 122 O. G. 2687.

*Barber v. Wood*, 127 O. G. 1991.

710. The right of Crebbin to make the claims corresponding to the issue may be urged at the final hearing. *Locke v. Crebbin*, 124 O. G. 317.

711. The right of McKee to make the claims questioned by Wickers and Furlong will be given consideration as ancillary to the question of priority.

*Wickers & Furlong v. McKee*, 124 O. G. 908.

Cites, *Podlesak & Podlesak v. McInnerney*, 120 O. G. 2127.

*Pohle v. McKnight*, 119 O. G. 2519.

712. The Court of Appeals in the District of Columbia, in the case of *Podlesak v. McInnerney* (120 O. G. 2127) held that the question of the right of a party to make a claim may be an ancillary question to be considered in awarding priority of invention. In my decision in the case of *Pohle v. McKnight* (119 O. G. 2519) and of *Kilbourn v. Hirner* (122 O. G. 729) certain reasons are set forth why the question of the right to make the claims may be considered as a basis for an award of priority rather than a dissolution of the interference.

Under the practice indicated above it was held that one of the parties had no right to make the claim of the issue because its subject matter was not shown in the original application.

*Emmet v. Fullagar*, 124 O. G. 2179.

Cites, *Gallager v. Hien*, 115 O. G. 1330 on page 2180.

- Laas & Sponenburg v. Scott, 122 O. G. 352 on page 2181.  
Podlesak v. McInnerney, 120 O. G. 2127 on page 2182.  
Pohle v. McKnight, 119 O. G. 2519 on page 2182.  
Kilbourn v. Hirner, 122 O. G. 729 on page 2182.  
Robinson v. Seelinger, 116 O. G. 1735 on page 2182.

713. Where the operativeness of an opponent's device or his right to make the claim is material to the right of a party to a patent, said party may urge the matter at final hearing before the Examiner of Interferences as a basis for his award of priority; but as a condition precedent to such right, the party must first present the matter upon a motion for dissolution or show good reason why such motion was not made and prosecuted.

Barber v. Wood, 127 O. G. 1991.

714. Interferences are for the purpose of determining the question of priority only. That the issue is not patentable to either party has no bearing.

In cases contemplated by Rule 130, however, a decision that the issue is not patentable to one party would necessarily result in a decision of priority in favor of the other party. Dixon & Marsh v. Graves & Whitemore, 127 O. G. 1993.

715. An award of priority is also proper under Rule 130 of the Rules of Practice of the Office, where it is shown at the final hearing of an interference that the application of a party relied upon as evidence of invention at the date thereof does not warrant the claim in issue.

Martin v. Mullin, 127 O. G. 3216.

716. W's preliminary statement failed to overcome the record date of H. and W. In response to our order to show cause why judgment should not be rendered against him W. moved to dissolve the interference on the ground that H. and R. had no right to final hearing on priority under Rule 130.

This proceeding should be a part of the main case and not a separate proceeding. All relates to priority.

Hewitt v. Weintraub v. Hewitt & Rogers, 128 O. G. 1689.

717. It is believed that testimony consisting wholly of the opinions of expert patent lawyers as to the legal effect of claims should not be received.

Pym v. Hadaway, 129 O. G. 480.

718. In cases 122 O. G. 2687 and 2688, it was decided that where a party makes a reasonable showing before the Examiner of Interferences of the inoperativeness of his opponent's device, and that showing does not extend to his own structure, he may be permitted to take testimony provided that the proposed testimony is of a character to justify such action. No reason appears for making any distinction between a case where a party alleges that his opponent's device is inoperative and one where it is contended that the opponent has no right to make the claim in issue. Such testimony should be permitted only under Rule 130.

Pym v. Hadaway, 129 O. G. 480.

719. In Podlesak v. McInnerney, 26 App. D. C., 399, this Court has held that the question of the right to make a claim may sometimes be an ancillary question to be considered in awarding priority of invention.

Wickers & Furlong v. McKee, 129 O. G. 869.

720. After record judgment of priority in favor of O. and upon motion by B. the interference was reopened in order to permit him to urge under Rule 130 that O. had no right to make the claims of the issue.

Becon v. Otis, 129 O. G. 1267.

721. Rule 130 was intended to cover those cases where it was contended that one party had a right to make the claims, but the other did not, and that therefore the latter was not entitled to the date of filing of his application as a date of conception and constructive reduction to practice of the invention in issue. The reasons given must not be applicable to both cases.

Pym v. Hadaway, 129 O. G. 2073.

722. We greatly doubt whether the affidavits in this record presented for the consideration of this Court and controverting the sufficiency of disclosure found in the W. application in interference could be profitably considered by this Court. That question should come before us upon testimony taken in the interference proceeding. (A. D. C.)

Wickers & Furlong v. McKee, 124 O. G. 908.

723. A motion to suppress testimony calling for an examination of a large part of the record will be postponed to the final hearing.

Dyson v. Sand. v. Dunbar v. Browne, 130 O. G. 1690.

724. (See note to Rule 122.)

McNulken v. Bollee, 130 O. G. 1691.

725. Evidence considered (by Court of Appeals) and held to show that the application on which the patent was granted did not, as originally filed, disclose the invention in issue, and priority therefore awarded to the junior party. McKnight v. Pohle, 130 O. G. 2069.

726. The sole contention on this appeal is that the issue is not patentable to either party. The question has been before the Primary Examiner both *ex parte* and *inter partes*, and in each case he has held the issue to be patentable. Both the Examiner of Interferences and the Examiner in Chief upon appeal on priority have refused to recommend under Rule 126 that the claims be rejected as being without patentable novelty. Under these circumstances the question presented will be considered only under my supervisory authority for the purpose of correcting a manifest error.

Dixon & Marsh v. Graves & Whittemore, 130 O. G. 2374.

727. It is evident that what Rule 130 requires is that the question of the patentability of the claims to the other party shall have been duly presented and prosecuted before the Primary Examiner, and it is therefore immaterial whether this was done on a motion to dissolve or on a motion to amend.

Josley v. Hulse, 132 O. G. 844.

728. A decision of the Examiner of Interferences refusing to expunge testimony will only be reviewed at the final hearing.

Royce v. Kempshall, 119 O. G. 338.

Greene, Tweed & Co. v. Manufacturers' Belt Hook Co., 132 O. G. 680.

729. The Examiner of Interferences has jurisdiction to decide at final hearing the question raised upon this motion, namely, whether "mixed paints" and "ready mixed paints" are goods of different descriptive prop-

erties, for the trade-mark statute provides for the determination of the question of the "right of registration to such trade-mark." The trade-mark statute gives much larger jurisdiction than the patent statute, which merely provides for the determination of the question of priority.

Lewis & Bros. Co. v. Phoenix Paint & Varnish Co., 131 O. G. 361.

730. Rule 130 does not confer upon a party the absolute right to contest his opponent's right to a claim, but allows him to do so only when the objections urged against his opponents to make the claim do not apply with equal force to his own case.

Pym v. Hadaway, 131 O. G. 692.

Anderson & Dyer v. Lowry, 89 O. G. 1861.

Bechman v. Southgate, 127 O. G. 1254.

Bechman v. Wood, 89 O. G. 480.

Briggs v. Conley, 104 O. G. 1119.

Cory v. Gibhart & Martin, Jr., v. Blakey, 115 O. G. 1328.

Denton v. Parker, 98 O. G. 415.

Goss v. Scott, 96 O. G. 844.

Gally v. Burton, 120 O. G. 325.

Horne v. Somers & Co., 129 O. G. 1609.

Jenner v. Dickson v. Thibodeau, 116 O. G. 1181.

Kilbourn v. Hirner, 128 O. G. 1689.

Kempshall v. Sieberling, 110 O. G. 1427.

Locke v. Crebbin, 124 O. G. 317.

McGill v. Adams, 119 O. G. 1259.

Miel v. Yough, 121 O. G. 1350.

Read v. Scott, 101 O. G. 449.

Ruische v. Sandherr, 105 O. G. 1780.

Seeberger v. Dodge, 113 O. G. 1415.

Shallenberger v. Andrews, 1902 C. D. 246.

Sobey v. Holsclaw, 119 O. G. 1922.

Talbot v. Morrell, 99 O. G. 2955.

Weintraub v. Hewitt, 124 O. G. 2534.

731. Rule in accordance with the holding of the Court of Appeals in the decision in Podlesak and Podlesak v. McInnerney (120 O. G. 2127) and in Kilbourn v. Hirner and in Wickers and Furlong (129 O. G. 869).

Hopkins v. Newman, 131 O. G. 1161.

732. The question of the patentability of the issue will not be considered on an appeal on priority except

under such special circumstances as would warrant the exercise of the supervisory authority of the Commissioner. *Hess v. Jorriksen v. Felbel*, 131 O. G. 1419.

733. Where testimony must be considered in determining a motion to amend a preliminary statement, it is within the discretion of the Examiner to consider such testimony for the purpose of deciding the motion prior to final hearing. When in his opinion the conditions of the case justify an early adjudication of the questions raised, his decision should not be delayed.

*Smith v. Ingram*, 131 O. G. 2420.

734. Where the defeated party alleges public use, HELD that the matter will not be considered until the decision on priority becomes final.

*Doble v. Henry*, 118 O. G. 2249.

734a. If a witness refuses to answer a material question and no application is made to the U. S. Court, testimony will not be stricken out except preparatory to final hearing. *Independent Baking Powder Co v. Fidelity Mfg. Co.*, 94 O. G. 223.

735. Where the defeated party alleges public use, HELD that the matter will not be considered until the decision on priority becomes final.

*Doble v. Henry*, 118 O. G. 2249.

736. The fact that on appeal from a decision on a motion to dissolve the Examiners-in-Chief have held that a party has a right to make the claims does not prevent the question being raised before the Examiner of Interferences at final hearing under Rule 130.

*O'Brien v. Gale v. Limmer v. Calderwood*, 133 O. G. 514.

736a. A motion to suppress testimony decided at final hearing, may not be appealed separately, but may be considered by the appellate tribunal on appeal upon the main question. *Dyson v. Sand v. Dunbar v. Browne*, 133 O. G. 1679.

### RULE 153.

153. In contested cases reasonable notice of all motions, and copies of motion papers and affidavits, must be served, as provided in Rule 154 (2). Proof of such service must be made before the motion will be entertained by the Office. Motions will not be heard in the absence of either party except upon default after due notice. Motions will be heard in the first instance by the officer or tribunal before whom the particular case may be pending. In original hearings on motions the moving parties shall have the right to make the opening and closing arguments. In contested cases the practice on points to which the rules shall not be applicable will conform, as near as possible, to that of the United States courts in equity proceedings.

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### NOTICE.

737. A party cannot move to reform the declaration of interference without notice.

Gray v. Bell, 1878 C. D. 133, 15 O. G. 133.

Bell v. Gray, 15 O. G. 776, 1879 C. D. 42.

738. A concession of priority excluded as evidence by the Examiner of Interferences for want of notice.

Tucker v. Kahler, 1879 C. D. 71, 15 O. G. 966.

739. The usual rule is to exclude the first or last day of the notice, when not personally served.

Hoag v. Abbott, 1879 C. D., 15 O. G. 471.

740. If a party would be compelled to travel night and day the notice is not reasonable.

Hoag v. Abbott, 1879 C. D. 3, 15 O. G. 471.

741. As to the failure to give the name of a witness.

See Kenerson v. Brown & Brown, 779 C. D. 249, 16 O. G. 857.

Masury, 73 C. D. 110.

742. A motion based upon the same state of facts and reasons as a previous one should be refused on the ground that the matter is *res adjudicata*.

Little v. Little, Pillard & Sargent, 1876 C. D. 207, 15 O. G. 543.

Banks v. Snediker, 1880 C. D. 95, 17 O. G. 508.

743. The appearance of a party in a case and the submission of arguments on the merits of the disputed points, is a virtual waiver of the right of notice.

Keller & Olmsdahl v. Felder, 1876 C. D. 246, 10 O. G. 944.

744. A motion with notice is only necessary, when a demand is made which may be refused. When a motion is made which must be granted, it is not a motion in the sense of this rule.

Booth v. Lyman, 1880 C. D. 170, 17 O. G. 393.

745. Motions in which no proof of service upon the opposite party is made will not be entertained.

Bechman v. Johnson, 1889 C. D. 184; 48 O. G. 673; C. C. 97 O. G. 2531; 92 O. G. 1236; 1890 C. D. 125.

746. A petition that a certain application be withdrawn from issue, and a rule made that cause be shown why the order should not be made permanent.

Spielman, 1892 C. D. 1; 58 O. G. 141.

747. It is not the practice of the Office to require a party to serve upon his opponent copies of all office records referred to in a motion made by him.

Bundy v. Rumbacker, 92 O. G. 2002, 1900 C. D. 143.

748. The notice of certain named witnesses and, perhaps, others, does not warrant the taking of the testimony of any witnesses than those named, at least under the circumstances of the case. A notice one day that the testimony will be taken the next day is not sufficient where attorneys are in a distant city and only represented by an associate attorney.

Potter v. Oehs, 95 O. G. 1049, 1901 C. D. 39.

749. All parties must be notified.

Grand v. Abbott v. Grand & McGraw, 103 O. G. 662.

750. Notice of new matter in cases transmitted under Rule 126. Greenawalt v. Mark, 103 O. G. 1913.

751. It should be noted that both applications here involved are owned by the same party, and that the same attorney appears for both parties; under such circumstances the Office should be particularly on its guard to prevent unreasonable delays.

Unreasonable delays in the prosecution of interferences will not be permitted merely because the parties agree to the delay. *Sponsel v. Darling*, 105 O. G. 498.

752. An affidavit filed after the hearing relating to the merits stricken from the files, as these rules contemplate that a party shall be given notice of his opponent's case before the hearing.

*Miller*, 105 O. G. 1532-33.

753. Notice served June 16, at 12 o'clock for taking testimony in Erie, Pa., 10 A. M. June 18, is insufficient even if it contained names of witnesses.

*Tripp v. Wolff v. Ames*, 108 O. G. 563.

754. A notice that would necessitate travel on Sunday is insufficient. Counsel must be given time to prepare for a journey. *Goodfellow v. Jolly*, 111 O. G. 1940.

755. New grounds for dissolution not of record in either application and not included in the motion must be served upon the opposing party at least 5 days before the hearing. If notice of the new grounds is not served and service is not waived, these grounds will not be considered by the Primary Examiner in deciding the motion. (*Wells v. Parker*, 90 O. G. 1947; *Summers v. Hart*, 98 O. G. 2585; *Kurz v. Jackson v. Pierce*, 2586; *Whitlock v. Hudson v. Scott*, 99 O. G. 1385.)

In cases where due service of the new grounds could not have been rendered, a postponement of the hearing should be requested, and the request being accompanied by a statement of facts.

*Young v. Eick*, 113 O. G. 547.

*Fowler*, 113 O. G. 549.

756. It seems service of papers on Saturday afternoon in the District of Columbia is legal.

*Goodfellow v. Jolly*, 115 O. G. 1064.

757. A notice given at 10 o'clock that testimony was to be taken at 2, where all parties attended and the testimony was brief, testimony not stricken out notwithstanding moving party refused to cross-examine.

*Roberts v. Webster*, 115 O. G. 2135.

758. A petition to suspend an interference and declare a new one will not be considered when the opposing party was not notified.

*Hansen*, 117 O. G. 2632.

759. The time of hearing is a matter resting in the discretion of the tribunal before whom the case is pending. *Cazin v. Von Welsbach*, 119 O. G. 550.

760. It is the well settled practice of this Office, as announced in *Kletsker & Goesel v. Dodson*, 109 O. G. 1336, C. D. 1904, 100, and other decisions, that an appeal filed after the expiration of the limit of appeal will not be entertained except upon a verified showing why it was not presented in proper time.

*Thullen v. Young & Townsend*, 120 O. G. 904.

761. The petition must be denied on the merits, but it is to be noted also that copies were not served upon the opposing parties and that therefore it is informal.

*Kolb v. Hemmingway v. Curtis*, 122 O. G. 1397.

762. Where affidavits are filed by any of the parties which are not in answer to affidavits filed by opponents, they must ordinarily be served upon the opponents at least five days before the hearing. Affidavits in rebuttal may then be filed but should be served before the hearing.

*Browne v. Stroud*, 122 O. G. 2688.

763. The signature to a notice is sufficient if the party notified understands from the signature from whom or in whose interest the notice is given.

*Heyne, Haywood & McCarthy v. De Vilbliss, Jr.*,  
125 O. G. 669.

*Adams-Randall*, 125 O. G. 1700.

764. A motion to amend declaration in a trade-mark case so as to insert a statement of ten years' exclusive use, which statement had been previously withdrawn in view of testimony in an interference case, refused.

*Kenyon*, 125 O. G. 1702.

765. The rule provides that reasonable notice of all motions must be given and that a motion will not be entertained in absence of proof of service. The same reason exists for requiring notice of the renewal of a motion as of the motion itself, and the mere request at the final hearing is not such notice.

*Dyson v. Sand v. Dunbar v. Browne*, 133 O. G.  
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## EXPERT TESTIMONY.

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It seems to me that the subject of expert testimony in Patent Cases is one that may profitably be given special attention. I refer to the testimony of the expert in the general sense, as distinguished from the specialist in particular lines. While the work is laborious and involves much of detail, still one may often work for those capable of appreciating the quality of his work.

I have had very unusual opportunities for observing and applying scientific and engineering principles in practice, having generally practically complete charge of experiments, relating to engineering, electricity and chemistry, for periods covering a number of years. I keep up a small engineering and scientific library, which I am able to use with facility.

I believe I can make this special experience of use to others, and that special care and skill as an expert will be appreciated. In this connection I value my experience as a teacher in trying to present scientific and practical subjects to men not then familiar and ready with the language of the books, as well as my considerable experience in the legal application of such principles.

The necessity of an expert is generally recognized. I suppose there was never yet a case presented that was not a subject of more or less regret in the retrospect. This regret will surely be less if the case is carefully presented from the witness-stand in the first instance. If the burden of the details is assumed by the witness, a truer perspective may be presented in the brief, besides the Courts are apt to require that the points should be presented by a witness that may be cross-examined.

The following are a few *dicta* of the courts that may be interesting:

"Were the patent taken bodily from "Holy Writ" no more antagonistic dogmas and warring theories could be deduced therefrom." Bracewell v. Passaic Print Works, 107 F. R. 467.

"The explanation given by both parties seems to me purely conjectural. The little understood operation of the electric current cannot be reduced to formulae by the dicta of the Court, which must needs lag where experts run." Queen & Co. v. R. Friedlander & Co., 149 F. R. 774.

"Expert testimony is sometimes valuable, and frequently interesting, but seldom controlling—never when directed to matters capable of ocular demonstration, unscientific matters." Farmers' Mfg. Co. v. Sprinks Mfg. Co., 119 F. R. 597.

"Even were it possible to do so it is surely unnecessary to follow all the excursions of the experts into the occult realms of electrochemical science. Some of these trails seem to vanish into thin air, others are lost in a desert of technicalities, and of others still it is true that he who attempts to travel them is quite likely to find himself wandering aimlessly 'through caverns measureless to man.'" Electric Smelting & Aluminum Co. v. Pittsburg Reduction Co., 125 F. R. 926-938.

"Progress in nearly every field of mechanical activity is like the advance of the tide—the last high mark having been attained, not by a single thought thrown far in advance of the flood, but by the column of thought that the weight of the flood projects. Where one inventive mind has run far out, marking a distinct field to be thereafter covered, it is not difficult for the courts to set the stakes that give boundary to the advance. But when the advance is but an item of a similar advance, all along the line, care must be taken that the boundaries given do not include up and down the line, every character of mechanism that thereafter may bring about similar results." Motsinger Device Mfg. Co. v. Hendricks Novelty Co., 149 F. R. 995 (C. C. A.)

"And often machines which are alleged to be infringements are so unlike in their apparent construction and appearance that it would seem almost preposterous to call them the same machines, and yet when tested by men who understand the particular art to which they relate, are found to be mere changes of form." Howes v. Washburne & Washburne, 5 O. G. 491.

"A thorough understanding of the purposes which the inventor sought to accomplish, and the principles applicable thereto, in the absence of a thorough explanation by experts of both practical and scientific attainments in the art, requires a mastery of the particular science to which the patent in suit relates—the expert testimony on either side proceeds too much on the assumption that the court has special knowledge which it would not be justified in making use of, even if it thought itself possessed of it." Bradford v. Belknap Motor Co., 105 F. R. 64.

"(The Judge referred to facts within his own knowledge but not of record. The Appellate Court say:) 'That he freely stated the facts he had in mind tends no more to invalidate or impeach his decree than the fact that he had this knowledge. Extended experience in the affairs of life does not disqualify a Judge who does not seek to use it unfairly.'" Thompson Scenic Ry. v. Chestnut Hill, etc., 127 F. R. 703.

"If it had not been for the knowledge acquired by the writer in previous litigations concerning similar devices, it would have been impracticable on such hearing to satisfactorily determine the bearing of the prior art on the invention in suit." *Snow v. Sargent*, 106 F. R. 231.

"At the hearing we gathered an apprehension of the conclusions which we must reach. Our subsequent investigations have not changed that apprehension; and, although it has increased our doubts with reference thereto, yet we are satisfied that they would not be removed by further consideration of the case, and that the interest of the parties will be better advanced by a disposition of the suit which will enable an appellate tribunal seasonably to review it rather than by holding it longer under advisement." *Bradford v. Belknap Motor Co.*, 105 F. R. 64.

"It is a matter of historical curiosity, as illustrating the mysterious working of the Official Mind, that the United States Patent Office refused to grant a patent to Mr. A. Bernstein, in 1883, for the employment of transformers intended to lower pressure and increase current, and yet the same office granted a patent to Gualard and Gibbs, in 1886, for the very same thing. The application was rejected by the Officials of the United States Patent Office on the ground that applicant should demonstrate more clearly to the office the possibility of producing quantity currents from intensity currents by means of an induction coil; it is not quite apparent how applicant in any case can get more quantity from a secondary coil than he has in his primary.

"Will any say, after this, and having regard to Henry's experiments half a century before, that official wisdom is to be trusted in the matter of granting or refusing patents?" Prof. A. J. Fleming, 'The Transformer,' Vol. 2, pp. 81-82.

"In regard to the differences between the claims under consideration in the domestic and British patents, we are referred by the complainant in lump to eight printed pages of the testimony of its expert witness Bentley, without any attempt on its part to analyze that evidence. We, of course, decline to analyze it ourselves, pointing to our rules which require this to be done by the complainant itself, with proper specific references as therein stated." *Thompson-Houston Electric Co. v. M'Lean*, 153 F. R. 887.

I shall be glad to assist on the brief or with reference to the examination of specialists.

## PRESS NOTICES.

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The following notices are such as I have handy relating to matter published under the head of "Gas Engine Design," shortly after leaving the shop, and embodying some of the results of my experience, study and observation while so employed:

**Prof. Picolet kindly writes:**

"I am pleased to note that the very considerable addition of new matter in the present edition has in no way diminished the lucidity of treatment which characterized the former."

"Permit me to congratulate you for having produced \* \* \* a treatise on gas engine design embodying the latest and most improved methods of the art."

**This is what Power says:**

"This is one of the simplest and at the same time the clearest treatise on the thermodynamics which underlie gas engine design that we have seen."

\* \* \* \* \*

"The chapter on compressed air is a marvel of lucid explanation and comprehensiveness.

"The method of obtaining compression temperatures and calculating \* \* \* volumes and pressures produce formulas which almost make mental calculation possible.

"The matter on gas engine design proper shows the derivation and application of formulas used in proportioning the principal parts of the engine.

"The preface states that the work is intended for a reference by busy men, and in such a capacity it certainly is a success. It is more than this, however, and students of the subject and any interested in the subject will find it intensely practical as well as instructive."

"POWER."

Issue of September, 1903.

"Contains \* \* \* work that is of unusual merit."

"MINING AND SCIENTIFIC PRESS,"

San Francisco, Cal.

"The book is free from much of the mystery which has sometimes been made to surround the design of the gas engine, and the treatment of the adiabatic curve for gases is handled without the use of the differential calculus, which is a large advance over everything heretofore attempted."

"THE ENGINEER,"  
Chicago, October 15, 1903.

"It is not easy to suggest how the work of the author could have been better done in any respect, and all who have to do with gas or oil engines should be glad to obtain the book, and none can well fail to appreciate it."

"THE AMERICAN MACHINIST."

"The best brief treatise of the subject extant."

STANLEY H. MOORE, M. E.,  
Director Manual Training Department of the  
Manual Training High School, Kansas City, Mo.

"Really valuable work."

PROF. LUCIEN E. PICOLET,  
Department of Mechanical Engineering,  
University of Pennsylvania.

"Leading formulæ."

PARSELL & WEED,  
Gas Engine Construction.

"It is the first practical work of its kind I have been able to get."

ARTHUR C. ISBELL,  
474 Seaview Ave., Bridgeport, Conn.

I wish also to thank Mr. F. L. Faraute for the very kind notice in his book, "The How and Why of the Automobile."

Mr. Hyler T. White has also kindly given me credit for work used by him.

Professor Lucke, in his leading and standard work on "Gas Engine Design," has done me the honor to use matter that I suppose I originated, and that had previously been published over my signature.

## LETTERS.

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Law Offices of  
**Specialty,** R. A. PARKER  
PATENTS, PARKER & BURTON, C. F. BURTON  
TRADE MARKS, 603-607 Moffat Building,  
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Detroit, Mich., May 29th, 1908.

Mr. Elliott J. Stoddard,  
Detroit, Mich.

Dear Mr. Stoddard : I am pleased to express to you my high opinion of your capacity for careful, critical, and accurate analysis of the claims of patents, and of the components of mechanical devices. Also my high opinion of your knowledge and careful analyses of chemical problems, many of which problems, both mechanical and chemical, I have placed before you for solution in the last six or seven years. My experience with you has been that you are very unwilling to express an opinion until you know the facts on which it is to be founded, and that when the facts are thoroughly studied out, and are fully comprehended, your opinions have almost invariably been accurate, not only in my opinion, but, so far as I have used them, have been sustained by the judges and courts who have subsequently considered the same matters. As an Expert, I consider you a very painstaking, careful, and accurate examiner, and more than this, I have found that you have the ability to explain in very clear and comprehensible language the opinions which you have formed, making your testimony extremely valuable and useful.

Very respectfully,

CHARLES F. BURTON

From Mr. V. H. Lockwood, Lecturer on Patent Law and Trademarks, Indiana University.

V. H. LOCKWOOD,  
Counsellor at Law,  
415-418 Lemcke Building.

Indianapolis, Aug. 4th, 1906.  
Patent and Trademark Law

Mr. Elliott J. Stoddard,  
Detroit, Mich.

Dear Sir: I beg to acknowledge the receipt of your testimony with your accompanying suggestions. I also wish to express my appreciation of your services, as I never had a more satisfactory expert than you proved to be.

I enclose herewith a check from the Anderson Tool Co. for the amount of your bill.

Yours truly,  
V. H. LOCKWOOD.

To get the experience and have the benefit of instruction from one of the most experienced and skillful Chemists of the State, I recently took a course in Chemical Analysis under Professor Allen. The final clause of the following testimonial was unsolicited, and I value it as the opinion of one whose judgment I believe worthy of respect.

### Detroit School of Chemistry and Pharmacy

Detroit, Michigan

LABORATORIES:  
DETROIT COLLEGE  
OF MEDICINE BLDG.

NOW ASSOCIATION INSTITUTE

25 APRIL, '08.

To Whom It May Concern:

Mr. E. J. Stoddard studied Chemistry and Physics in the laboratories of the above School; and it gives me pleasure to say that he not only possesses a fair knowledge of these sciences, but also the power to apply his knowledge to comprehend more complex problems when presented to him.

W. H. ALLEN, Ph. G.,  
*Prof. Chemistry D. S. of Chemistry and Pharmacy.*









